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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lancome Parfums et Beaute & Cie

Serial No. 75/348,649

Russell H. Falconer and Cecil Kay of Baker & Botts, L.L.P.
for Lancome Parfums et Beaute & Cie

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Office 112 (Janice O'Lear, Managing Attorney)

Before Seeherman, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Lancome Parfums et Beaute & Cie has appealed from the
refusal of the Trademark Examining Attorney to register
VITABOLIC as a trademark for "cosmetics, namely creams,
milks, lotions, gels and powders for the face."¹ A final

¹ Application Serial No. 75/348,649, filed August 28, 1997,
claiming a right of priority pursuant to Section 44(d) based on a
French registration for which application was made on March 5,
1997. The application is based both on a bona fide intention to
use the mark in commerce (Section 1(b) of the Act), and on the
foreign registration (Section 44(e)).

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refusal of registration issued pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the basis that applicant's mark so resembles the marks VITABOLIC AM (AM disclaimed) and VITABOLIC PM (PM disclaimed), both registered by the same entity for "vitamin and mineral supplements" that, if used on applicant's goods, it is likely to cause confusion or mistake or to deceive.

The appeal has been fully briefed, and applicant and the Examining Attorney appeared at an oral hearing before the Board.

We affirm the refusal of registration with respect to both of the cited registrations.

Our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **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. **Federated Food, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to a consideration of the marks. It is well established that there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the

ultimate conclusion rests on a consideration of the marks in their entireties. **In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In this case, VITABOLIC is clearly the dominant portion of the cited marks. Although the latter marks include the disclaimed elements AM and PM, those elements merely describe the time of day during which the registrant's goods may be taken. Consumers would regard AM and PM as merely informational elements, and would view VITABOLIC as the source-identifying part of the marks. Therefore, the absence of a time-indicating element in applicant's mark, or the presence of these elements in the cited marks, is insufficient to distinguish applicant's mark from the registrant's.

The term VITABOLIC is obviously identical in appearance and pronunciation in both applicant's and the registrant's marks. Applicant argues, however, that the marks have different connotations due to their use on different goods. Specifically, applicant asserts that, with respect to the registrant's vitamin and mineral supplements, consumers would regard the VITA portion of the marks as referring to "vitamins" and the BOLIC portion of the marks as referring to "metabolic functioning." On the other hand, applicant argues that, when its mark is applied

to creams, milks, lotions, gels and powders for the face, VITA would be viewed as a "pseudonym" for "vital," "vitality," "vitalize" or "revitalize" and that BOLIC is merely a catchy suffix which is used in other adjectives such as "anabolic," "carbolic," "catabolic," "diabolic," etc. From this, applicant argues that consumers would understand applicant's mark as "symbolic of vitality." When the Examining Attorney, in her brief, pointed out that "anabolic" and "catabolic" are connected with metabolic functions, applicant engaged in a somewhat tortured semantic argument, breaking down the syllables to show that "bolic" is simply the adjective form of the word.

We think it unnecessary to engage in convoluted guesses as to how consumers might analyze the term VITABOLIC. It is not a real word, with recognized meanings, such that we could say that one meaning is more likely to be understood with respect to a particular product than is another meaning. Cf. **In re British Bulldog, Ltd.**, 224 USPQ 854 (TTAB 1984). We do not think consumers for these goods are likely to jump through the semantic hoops raised by applicant to arrive at the different meanings for VITABOLIC that applicant suggests. Certainly the VITA prefix can have the same meaning with respect to both applicant's and registrant's goods, i.e.,

the "vitality" meaning asserted by applicant is applicable to the registrant's products since vitamin and mineral supplements can provide "vitality," or the "vitamin" meaning can apply to applicant's products since, as applicant has acknowledged in both its reply brief and at the oral hearing, skin care cosmetics can contain vitamins (specifically, vitamins C and E).

As for the AM and PM elements in the cited marks, as noted before, the fact that they suggest that the products may be taken at particular times of day, does not change the connotation of the parties' marks as a whole.

Thus, when the marks are considered in their entirety, they are virtually identical in appearance and pronunciation and, insofar as the invented term VITABOLIC can be said to have a connotation, the suggestive meaning of both marks would be similar or the same.

This brings us to a consideration of the goods. Applicant points out at some length that its products are not competitive with and cannot be substituted for the registrant's identified goods. However, it is not necessary that the goods of the parties be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are

related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. **In re International Telephone & Telegraph Corp.**, 197 USPQ 910, 911 (TTAB 1978).

The Examining Attorney has made of record third-party registrations showing that eleven companies have registered their marks both for goods of the type listed in applicant's application and for goods of the type recited in registrant's registrations. For example, NEXTAR BERRY is registered for, inter alia, skin creams and lotions and for dietary supplements containing vitamins and minerals (Registration No. 2,135,249); NUWAY and design is registered for, inter alia, skin care lotions, gels, talcum powder and creams, and for nutritional supplements, namely vitamin, mineral and herbal supplements (Registration No. 2,135,241); and VITA-VISTA is registered for, inter alia, cosmetics, namely moisturizers and emollients, and for vitamins, minerals and dietary food supplements. (Registration No. 1,200,799). Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that

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the listed goods and/or services are of a type which may emanate from a single source. See **In re Albert Trostel & Sons Co.**, 29 USPQ2d 1783 (TTAB 1993).

Applicant argues that these eleven registrations are such a small number compared to the thousands of registrations in Class 3 that they do not establish that there is any real overlap between the cosmetics and nutritional supplement industries.

We do not find this argument to be persuasive. First, the Examining Attorney stated, when she made the registrations of record, that they were a representative sample, selected for the purpose of brevity, and that many more such registrations exist on the Register. This is not a situation in which the Examining Attorney has made only two or three third-party registrations of record, and we have had to presume that these were the only registrations he or she was able to find. Cf. **In re Federated Department Stores Inc.**, 3 USPQ2d 1541, 1542, ftnt. 2 (TTAB 1987). The Board has said on a number of occasions that it does not wish to have the application file burdened with every third-party registration, or every newspaper article, that the Examining Attorney can find in support of his or her position, and that it is not only appropriate, but

preferred, that the Examining Attorney make of record only a representative sample.

The second problem with applicant's argument is that it uses statistics in a way that is meaningless. Aside from the fact that the raw numbers of how many registrations which have issued in Class 3 do not reflect how many have issued to the same registrant, nor do they reflect whether a registrant may have obtained a separate registration for the same mark in Class 5, rather than multi-class registration covering both Classes 3 and 5, the question is not whether the majority of cosmetics manufacturers also sell vitamin and mineral supplements. It is only whether these are the kind of products that may be sold by the same manufacturer under the same mark, and eleven representative third-party registrations are sufficient to demonstrate that.

The goods may also be sold in the same channels of trade. Applicant and the Examining Attorney have both directed their arguments to the channels of trade in which applicant's goods are actually sold or intended to be sold, and the channels in which applicant asserts the registrant's goods are actually sold. However, the question of likelihood of confusion must be determined on the basis of the identification of goods set forth in the

subject application and cited registrations. **In re William Hodges & Co., Inc.**, 190 USPQ 47 (TTAB 1976). See also, **Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.**, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Thus, we must deem the goods to be sold in all channels of trade which are appropriate for goods of the type identified. Moreover, applicant has acknowledged that its goods are sold, inter alia, in pharmacies (affidavit of Jose Monteiro), and has also acknowledged that vitamins and minerals are usually sold, inter alia, in drugstores (response filed July 23, 1998). Thus, at least one of the channels of trade for the goods identified in applicant's application and the registrant's registrations is the same.

The purchasers for both types of products are the general public. Applicant points out that its products are sold to women, while the registrant's products are gender neutral. Even if that is the case, this still means that both parties' products would be purchased by women, a large portion of the population. Applicant argues that the products would not be purchased on impulse, basing this argument, in part, on the fact that its products are sold in high end retail outlets at relatively higher price points compared to other cosmetic products. However, as noted above, we must determine the question of likelihood

of confusion on the basis of the goods as they are identified in the application. As identified, applicant's goods are not restricted to expensive or high-end cosmetic products. Further, even if we accept applicant's argument that consumers would make careful buying decisions because they need to evaluate whether the cosmetic and vitamin products meet their requirements, the fact remains that the source-identifying feature of the marks, the term VITABOLIC, is identical in both marks, and the marks in their entireties are extremely similar. In view thereof, even careful purchasers are likely to be confused into believing that the VITABOLIC cosmetics and the VITABOLIC AM and VITABOLIC PM vitamin and mineral supplements emanate from the same source.

Applicant also argues that the registrant's mark is weak because there are numerous third-party registrations for both vitamins and cosmetic products which contain the element VITA. Preliminarily, we note that applicant submitted copies of these third-party registrations with its brief, and that these submissions would normally be considered untimely. See Trademark Rule 2.142(d). However, because the Examining Attorney has discussed the registrations in her brief, we will deem them as having been stipulated into the record. The third-party

registrations do show that VITA has a significance for vitamin and cosmetic products, and we can agree with applicant that consumers will not associate all marks beginning with VITA with a single source. However, applicant's arguments ignore the fact that its mark and the cited marks are similar not only because they have the common element VITA, but also have the identical coined term VITABOLIC. It is because of this term in both applicant's and the cited marks, and not merely on the presence of the prefix VITA, that we have based our finding of likelihood of confusion.

Applicant has discussed certain other duPont factors which in general are more appropriate to consideration in inter partes cases. For example, applicant has stated that the cited marks are not famous. Obviously, Examining Attorneys are not in a position to provide evidence regarding the fame of a registrant's mark. We cannot conclude, on the basis of this record, that the cited marks are famous, and therefore this factor has not been considered in rendering our decision. Similarly, because we have not heard from the registrant in connection with this appeal, we cannot accept applicant's assertion that the registrant will not expand into the cosmetics field. Although we treat this factor as neutral in terms of making

our decision on likelihood of confusion, the third-party registrations are evidence that companies which sell vitamin and mineral supplements also sell cosmetic products.

Applicant also asserts that there has been no apparent confusion. In its brief applicant's attorney states that applicant commenced "widespread use" of its mark in the fall of 1998, although, interestingly, the affidavit of Mr. Monteiro, which was signed on February 4, 1999, makes no mention of any sales. In any event, we cannot conclude from applicant's attorney's advising the Board "informally that no instances of apparent confusion with the cited marks have been brought to Lancome's attention", brief, p. 19, that confusion is not likely. There has been a very limited period during which applicant has used its mark (the brief asserting no actual confusion was filed on June 30, 1999) and applicant has not provided any details of its sales or advertising. Nor do we know what the registrant's experience has been. Moreover, even if there have been no instances of confusion, that may be due to the specific manner in which applicant currently sells its goods, such as in high-end stores at "readily identifiable Lancome booths or counters." Brief, p. 18. However, as

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noted previously, applicant's identification is not restricted to selling the goods in such a manner.

Decision: The refusal of registration is affirmed.

E. J. Seeherman

P. T. Hairston

B. A. Chapman
Administrative Trademark Judges
Trademark Trial and Appeal Board