

8/15/01

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 25  
**Bottorff**

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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**Mana Products, Inc.**

v.

**Black Onyx, Inc.**

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Opposition No. **112,190**  
to application Serial No. 75/330,735  
filed on **July 25, 1997**

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**A. Thomas Kammer and R. Glenn Schroeder of Hoffmann & Baron, LLP for  
Mana Products, Inc.**

**John H. Oltman and Frank L. Kubler of Oltman, Flynn & Kubler for Black Onyx,  
Inc.**

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Before **Simms, Bottorff and Drost**, Administrative Trademark Judges.

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

Black Onyx, Inc., applicant herein, seeks registration on the Principal Register of the mark depicted below for goods identified in the application as “skin conditioner and shaving lotion, both of which eliminate skin bumps.”<sup>1[1]</sup>

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<sup>1[1]</sup> Serial No. 75/330,735, filed July 25, 1997. The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a); October 1, 1984 is alleged as the date of first use of the mark anywhere, and November 1995 is alleged as the date of the first use of the mark in commerce.

Mana Products, Inc. has opposed registration of applicant's mark, alleging as grounds therefor that applicant's mark, as applied to applicant's goods, so resembles opposer's mark BLACK OPAL as to be likely to cause confusion, to cause mistake, or to deceive, and that it thus is barred from registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). More particularly, opposer alleges prior use of its BLACK OPAL mark on various cosmetic and skin care products including pre-shave daily cleansers, desensitizing clear shave gels, after-shave relief lotions and razor bump recovery solutions, all marketed for the care and treatment of razor bumps, particularly to African-American men. Opposer also has pleaded ownership of Registration No. 1,949,678, which is of the mark BLACK OPAL, in typed form, for goods which include pre-shave cleansers, shave gels, after-shave lotions, and razor bump treatment gels.<sup>2[2]</sup>

Applicant answered the notice of opposition by denying the essential allegations thereof, by arguing that the parties' respective marks are not

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<sup>2[2]</sup> Registration No. 1,949,678 issued on January 16, 1996. The goods identified in the registration also include skin retexturizing lotions, knee and elbow moisturizers, sunscreens, eyeshadows, blushes, foundation liquids, foundation cremes, foundation powders, face powders, lipsticks, eye pencils, lip pencils and mascara.

confusingly similar, and by alleging that priority rests with applicant, not opposer.<sup>3[3]</sup>

The record in this case consists of the pleadings; the file of the opposed application; status and title copies of three registrations owned by opposer, submitted by opposer via notice of reliance;<sup>4[4]</sup> encyclopedia entries for “opal”

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<sup>3[3]</sup> Applicant’s allegation of priority constitutes an attack on the validity of opposer’s pleaded registration which will not be heard in the absence of a counterclaim for cancellation of that registration. See Trademark Rule 2.106(b)(2), 37 CFR §2.106(b)(2). Applicant has not filed any such counterclaim. Accordingly, applicant’s arguments with respect to priority are irrelevant and have been given no consideration. As noted *infra* at page 7, priority is not an issue in this case because opposer has made its pleaded registration of record.

<sup>4[4]</sup> Only one of the three registrations made of record by opposer was pleaded in the notice of opposition, i.e., Registration No. 1,949,678. See *supra* at footnote 2. The other two registrations are: Registration No. 1,825,722, issued March 8, 1994, which is of the mark BLACK OPAL (in typed form) for “skin care products; namely, cleansers, toners, and moisturizing lotions; and facial treatment products; namely, beauty masks, blemish control gel and skin bleaching preparations”; and Registration No. 2,024,917, issued December 24, 1996, which is of the mark BLACK OPAL (in stylized form as depicted below)

for “skin care products, namely cleansers, toners, moisturizing lotions, and sunscreens; facial treatment products, namely beauty masks, blemish control gel, skin bleaching preparations and skin retexturizing lotions; eyeshadows, blushes, foundation liquids, foundation cremes, foundation powders, face powders, lipsticks, eye pencils, lip pencils and mascara.” Applicant did not object to opposer’s introduction of these unpleaded registrations by notice of reliance, nor to opposer’s witness’s testimony regarding opposer’s use of these registered marks (see Garment depo. at 4-8 and at Exhibit Nos. 1-2). In view thereof, and

and “onyx,” submitted by opposer via notice of reliance; the testimony deposition of Sharon Garment, opposer’s Vice-President of Marketing, and exhibits thereto; and the testimony deposition of Eddie Collins, applicant’s president, and the exhibits thereto, many of which are the subject of a motion to strike by opposer. The case has been fully briefed, but no oral hearing was requested.

We turn first to opposer’s motion to strike certain of the exhibits to the testimony deposition of applicant’s president, Eddie Collins, i.e., Exhibit Nos. 1-6, 8 and 10-15.<sup>5[5]</sup> Opposer contends that these exhibits consist of documents which should have been produced by applicant in response to opposer’s discovery requests, but were not.<sup>6[6]</sup> Applicant, for its part, argues that its failure to produce these documents during discovery is excusable due to the serious

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because applicant clearly was apprised that opposer was offering evidence of these registrations in support of its Section 2(d) claim, we find that applicant has impliedly consented to the trial of the issues raised by these unpleaded registrations, and we deem the notice of opposition to be amended to include those registrations. See Fed. R. Civ. P. 15(b); 37 CFR §2.107; and TBMP §507.03(b).

<sup>5[5]</sup> Opposer’s motion to strike was filed on April 12, 2000. By order dated January 30, 2001, the Board deferred consideration of opposer’s motion until final hearing. Cf. TBMP §718.03(c). Pursuant to the Board’s instructions, opposer and applicant, in their briefs on the case, have renewed their respective arguments with respect to the motion to strike.

<sup>6[6]</sup> Opposer excepts from its motion to strike certain documents included in applicant’s Exhibit 8, which applicant in fact had produced during discovery. Those documents are applicant’s invoice numbers 55448, 55422, 55423, 55420, 55435, 55412, 05053, 05097 and 55411.

illness and hospitalization of Mr. Collins, applicant's president, and that the documents therefore should not be stricken.

A party which fails to produce documents or information in response to its opponent's proper discovery requests will be precluded from introducing or relying on such documents or information at trial. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1677 (TTAB 1989); and *National Aeronautics and Space Administration v. Bully Hill Vineyards Inc.*, 3 USPQ2d 1671, 1672 n.3 (TTAB 1987). We find that, with the exception of a few documents included in applicant's Exhibit 8, see *supra* at footnote 6, the documents in applicant's Exhibit Nos. 1-6, 8 and 10-15 are responsive to opposer's discovery requests and that they accordingly should have been produced during discovery, but were not. Applicant has not contended otherwise.

Mr. Collins' December 1997 illness and hospitalization, which occurred some nine months prior to the institution of this proceeding and some twenty months prior to the close of the discovery period, do not excuse applicant's failure to produce these documents to opposer prior to trial. Applicant clearly was able to produce some documents in response to opposer's discovery requests; it has not explained why it could not and did not produce all of the requested documents, either initially or by supplementation as required by Fed. R. Civ. P. 26(e), nor has it explained why it did not move to extend its time to respond to the discovery requests, if such extension of time was necessary.

In view of applicant's failure to produce the documents at issue during discovery, applicant is not entitled to rely on those documents at trial. See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, *supra*, and *National Aeronautics and Space Administration v. Bully Hill Vineyards Inc.*, *supra*.<sup>7[7]</sup> Accordingly, we hereby strike and shall give no consideration to Exhibits 1-6, 8 and 10-15 to the testimony deposition of Eddie Collins, except for those documents in Exhibit 8 identified *supra* at footnote 6.<sup>8[8]</sup>

We turn next to the merits of opposer's Section 2(d) ground of opposition to registration of applicant's BLACK ONYX (and design) mark. Opposer has made of record status and title copies of its pleaded Registration No. 1,949,678 of the mark BLACK OPAL. (Opposer's Notice of Reliance, filed November 8, 1999.) In view thereof, and because opposer's likelihood of confusion claim based thereon is not frivolous, we find that opposer has standing to oppose registration of applicant's mark. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Moreover, inasmuch as opposer's pleaded registration is not the subject of a counterclaim or a separate petition to cancel by

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<sup>7[7]</sup> *Hewlett-Packard v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390 (TTAB 1992), cited by applicant, involved the untimely service of a testimony deposition transcript, not the failure to provide discovery. It thus is inapposite to the present case.

<sup>8[8]</sup> The stricken evidence was offered by applicant in support of its legally irrelevant priority claim. See discussion *infra* at page 7. Accordingly, even if the evidence had not been stricken, our decision in this case would have been the same.

applicant, priority under Section 2(d) is not an issue in this case. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our likelihood of confusion 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. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Applicant has conceded that the goods identified in its application, “skin conditioner and shaving lotion, both of which eliminate skin bumps,” are similar to the “pre-shave cleansers, shave gels, after-shave lotions, razor bump treatment gels” identified in opposer’s pleaded Registration No. 1,949,678. (Applicant’s Brief at 5.) Indeed, we find that the parties’ respective goods are essentially identical. This factor weighs in favor of finding of likelihood of confusion.

There are no limitations or restrictions as to trade channels or classes of purchasers in either applicant’s or opposer’s identification of goods, so we must presume that the parties’ respective goods are sold in all normal trade channels and to all normal classes of purchasers for such goods, regardless of what the evidence might show the parties’ actual trade channels and classes of customers to be. See, e.g., *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811

F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Because the parties' respective goods, as identified in the application and the registration, are identical or highly similar, we find that they are or could be marketed in the same trade channels and to the same classes of prospective purchasers. This factor weighs in favor of a finding of likelihood of confusion.

Applicant concedes that the parties' respective goods are inexpensive items which are purchased primarily on impulse rather than after careful deliberation. (Applicant's Brief at 7.) This factor weighs in favor of a finding of likelihood of confusion.

Opposer argues that its mark is a famous mark which is entitled to a relatively broad scope of protection. We find that the evidence of record does not support that contention. Opposer's sales and advertising figures (which have been submitted under seal pursuant to the parties' protective agreement) are not so large as to qualify opposer's mark as a "famous" mark within the meaning of the fifth *du Pont* likelihood of confusion factor. Moreover, there is no evidence as to opposer's share of the relevant market. The burden of proving fame is on opposer, and we find that opposer has failed to carry that burden. Therefore, we find that this likelihood of confusion factor is neutral in this case.

There is no evidence of record of any similar marks in use on similar goods. Applicant, in its brief, has identified an alleged third-party registration and several alleged pending intent-to-use applications. However, the registration and applications were not made of record during applicant's

testimony period, and they accordingly can be given no consideration. *See* TBMP §706.02. Moreover, even if they had been properly made of record, they would not constitute evidence that the marks depicted therein are in use or that the relevant public is familiar with them,<sup>9[9]</sup> and they thus are of no probative value in our likelihood of confusion analysis. *See, e.g., Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992). We find that the absence of any evidence of similar marks in use on similar goods belies applicant's contention that opposer's mark is weak or entitled to a narrowed scope of protection. This factor weighs in favor of a finding of likelihood of confusion in this case.

Opposer acknowledges that it is unaware of any instances of actual confusion between its mark and applicant's mark. However, we reject applicant's contention that this absence of actual confusion is weighty evidence against a finding of likelihood of confusion in this case. It is clear from applicant's own assertions regarding the differences in the parties' respective actual trade channels, and from the extremely limited nature and amount of applicant's sales and advertising, that there has been no meaningful opportunity for actual confusion to have occurred. Therefore, the absence of evidence of actual confusion is entitled to no significant weight in this case. *See Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992).

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<sup>9[9]</sup> This is especially so with respect to the third-party intent-to-use applications identified by applicant.

Finally, we turn to a determination of whether applicant's mark and opposer's mark, when compared in their entirety in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, where, as in the present case, the marks would appear on virtually identical goods, the degree of similarity between the marks which is necessary to support a finding of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ 1698 (Fed. Cir. 1992).

Comparing applicant's mark and opposer's mark in their entirety, we find that although the marks are not identical, they are more similar than

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dissimilar. The only points of distinction between the two marks are applicant's use of a background carrier design, and applicant's use of the word ONYX instead of the word OPAL as the second word of its mark. Those specific differences between the marks are insufficient to render the marks dissimilar in their entireties.

The dominant feature in the commercial impression created by applicant's mark is its wording, BLACK ONYX. It is that wording, and not the simple bisected circle design which serves merely as a background or carrier for the wording, which is likely to be recalled by purchasers in calling for the goods. *See generally In re Appetito Provisions Co., Inc.* 3 USPQ2d 1553 (TTAB 1987).

Moreover, opposer's mark in Registration No. 1,949,678 is registered in typed form, such that opposer would be free to display its mark in all reasonable manners, including with a similar basic carrier device. *See Squirtco v. Tomy Corporation*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983). In fact, the record shows that opposer has displayed its BLACK OPAL mark with such a circular carrier device on its men's product line (see, e.g., Garment depo., at Exhibit Nos. 37-39), and has registered the mark with a oval carrier design in connection with its women's product line (Registration No. 2,024,917; see *supra* at footnote 4). For these reasons, we find that the design feature in applicant's mark is entitled to relatively little weight in our comparison of the respective marks. *See In re National Data Corp., supra.*

Comparing the literal portions of the respective marks, we find that BLACK OPAL and BLACK ONYX are similar in terms of appearance and sound, and highly similar in terms of connotation. Both marks begin with the word BLACK, followed by a short four-letter word beginning with the letter "O." Although OPAL and ONYX are somewhat dissimilar in terms of appearance and sound, those dissimilarities are outweighed by the words' similarity in connotation, i.e., that of a gemstone. In their entirety, BLACK OPAL and BLACK ONYX have identical connotations, i.e., that of a "black gemstone." That connotation is arbitrary and strong as applied to these goods; as noted above, there is no evidence that any third parties use similar "gemstone" marks, much less "black gemstone" marks, on these types of goods.<sup>10[10]</sup> Purchasers, in recalling the marks, are likely to retain the general impression of "black gemstone," and perhaps not so likely to recall the particular gemstones named in each of the marks. Moreover, even if they are able to recall the difference in particular gemstones, the strength and arbitrariness of the "black gemstone" connotation is likely to lead them to mistakenly assume that BLACK OPAL and BLACK ONYX products originate from the same source.

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<sup>10[10]</sup> For this reason, *Claremont Polychemical Corp. v. Atlantic Powdered Metals, Inc.*, 176 USPQ 207 (CCPA 1972), asserted by applicant to be "directly on point," is in fact readily distinguishable from the present case. The marks involved in that case, i.e., EVERGOLD and DURAGOLD, were found to be not confusingly similar because they both were weak, highly suggestive marks as applied to the relevant goods. There is nothing in the record from which we can conclude that opposer's BLACK OPAL mark is similarly weak or otherwise entitled to a narrow scope of protection.

In short, although applicant's mark is not identical to the cited registered mark, we find that the marks in their entireties are sufficiently similar that confusion is likely to result when they are used on the identical and/or closely related goods involved in this case.

Having carefully considered the evidence of record with respect to each of the relevant *du Pont* evidentiary factors, we conclude that confusion is likely to result from applicant's use of its mark on its identified goods. To the extent that applicant, by its evidence or arguments, may have raised any doubt as to that conclusion, such doubt must be resolved against applicant and in favor of the prior registrant. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

**Decision: The opposition is sustained.**