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Paper No. 11
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Fruit of the Earth, Inc.

Serial No. 75/443,473

James J. Murphy of Winstead Sechrist & Minick, P.C.
for Fruit of the Earth, Inc.

Paula B. Mays, Trademark Examining Attorney, Law Office 102
(Thomas Shaw, Managing Attorney).

Before Hohein, Chapman and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Fruit of the Earth, Inc. has filed an application to register the mark MACRO EMULSION for "cosmetics, skin and hair care products and bath and bathing products, sun care products, namely, skin lotions, skin creams, after bath lotions, bath gels, shampoos, sun block preparations, sun screen preparations and sun tanning preparations."¹

¹ Serial No. 75/443,473, filed March 3, 1998, based on an allegation of a bona fide intention to use the mark in commerce.

Registration of the mark has been finally refused under Section 2(e)(1) of the Trademark Act on the ground of being merely descriptive, and under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the mark MINI- EMULSION, which is registered for "cosmetics for hair use - namely, hair sprays, conditioners, lotions, creams and shampoos."²

The refusals have been appealed and applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

Section 2(e)(1) Refusal

The Examining Attorney maintains that MACRO EMULSION is merely descriptive of a feature of applicant's cosmetic products, namely, that these products contain "macro emulsions." To support her argument that the term "emulsion" is widely used in the cosmetic industry, the Examining Attorney has made of record excerpts from NEXIS articles, of which the following are representative:

Since skin creams are emulsions, that is formulations comprising oil and water, one way of overcoming this problem has been to find a way of separating off the Vitamin C...

Beauty Counter (April 1998);

² Registration No. 1,262,136, issued under Section 2(f) on December 27, 1983, Section 8 and 15 affidavits accepted and acknowledged, respectively.

... share one of castor oil's principle benefits, mildness, which suggests appellation as primary emulsifiers in a broad range of cosmetic emulsions. *Manufacturing Chemist* (March 1998); and

Today's cosmetic emulsions are not simply mixtures of oil, water and emulsifier; they also contain a number of active ingredients functioning to ameliorate the condition of the skin ...

The objective of this work was to study the influence of emulsion type and structure on the penetration of vitamins as cosmetic active ingredients. An emulsion of the w/o type and two different o/w emulsions are compared with an oil solution as a standard. *Cosmetic and Toiletries* (December 1997).

To demonstrate use in the industry of the term "macro" in combination with "emulsion", as one type of emulsion, she has submitted the following excerpts:

The company offers a wide choice of silicone emulsions ranging from micro, or clear emulsions to macro, large particle size high deposition rate emulsions. *Inside Cosmetics* (February 1998); and

Emulsion technology was reviewed within some excellent papers. Modern Emulsion Systems; Macro-, Micro-, Multiple and Water free were described by ...

Droplet size distribution was of particular interest to the author who, in the case of macro-emulsions, discovered relationships between this and the emulsification work ... *Inside Cosmetics* (May 1997).

Based on this evidence, the Examining Attorney argues that MACRO EMULSION is merely descriptive of cosmetic products containing or consisting of emulsions of this nature.

Applicant insists that the term "emulsion" is a technical term used primarily in the chemical arts, and

would not be understood for its technical meaning by the average consumer of cosmetic products. Applicant argues that in order to comprehend the descriptive nature of the term "emulsion," a consumer would have to have an understanding of chemistry. Because this is not true of the ordinary consumer, according to applicant, MACRO EMULSION would simply "conjure up a favorable impression of the efficacy of Applicant's goods" and, as such, be merely suggestive of the nature of the goods. Even if widely used in the industry, applicant maintains that consumers would not understand the descriptive significance of the term as applied to applicant's goods.

A term or phrase is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a significant characteristic or feature of the goods or services with which it is being used, or is intended to be used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Whether or not a particular term or phrase is merely descriptive is determined not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the designation is being or is to be used, and the significance the designation is likely to have to the average purchaser as he or she encounters the goods or

services bearing the designation, because of the manner in which it is used. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary that the term or phrase describe all the characteristics or features of the goods or services in order to be merely descriptive; it is sufficient if the term or phrase describes one significant attribute thereof. See *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

We find the evidence provided by the Examining Attorney adequate to establish the widespread use in the cosmetic industry of the term "emulsion" as a component or type of formulation used in the manufacture of cosmetic products similar to those of applicant. If there were any doubt in our minds, this is resolved by looking to the following dictionary definition, of which we take judicial notice:

emulsion 1. *Physical Chem.* any colloidal suspension of a liquid in another liquid. 2. such a suspension used in cosmetics.
Random House Dictionary of the English Language (2d ed. 1987).

The modifier "macro" has been shown to describe a particular type of such an emulsion, namely, one of a larger particle size. Even if ordinary consumers may not be familiar with the meaning of these terms or their relation to cosmetic preparations, competitors in the

cosmetic industry would clearly be aware of their descriptive significance. Applicant has admitted as much.

The terms "emulsion" and "macro emulsion" having been shown to be terms of art in the cosmetic industry, we are convinced the terms should be available to the entire industry for descriptive use. As we recently stated in *In re Styleclick.com Inc*, 57 USPQ2d 1445, 1448 (TTAB 2000)

[t]he intent of Section 2(e)(1) is to protect the competitive needs of others, that is, "descriptive words must be left free for public use." *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382,383 (CCPA 1986). As the Internet continues to grow, merely descriptive "e-" prefix terms for Internet-related goods and/or services must be kept available for competitive use by others.

In similar manner, descriptive terms or terms of art used within the cosmetic industry must be left free for use by applicant's competitors. This holds true whether or not the average purchaser of the cosmetic products would comprehend the descriptive significance of the words. The designation "macro emulsion" falls within this category and thus is properly refused registration under the provisions of Section 2(e)(1).³

³ We note that the mark cited in the Section 2(d) refusal, MINI-EMULSION, was only registered after proof of acquired distinctiveness under the provisions of Section 2(f).

Section 2(d) Refusal

Our determination of likelihood of confusion is made on the basis of those of the *du Pont*⁴ factors which are relevant in view of the evidence of record. Two key considerations in any likelihood of confusion analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services with which the marks are being used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Looking first to the respective goods, we note that applicant's goods include the hair care products and, specifically, the shampoos of registrant. The remaining cosmetic products of applicant are likewise personal care products. Thus, for purposes of Section 2(d), the respective goods are identical in part and otherwise closely related. Applicant has in fact acknowledged the "similarity between the goods." (Brief, p. 6).

Furthermore, because there are no limitations in either the application or registration as to any particular channels of trade or types of purchaser, it is presumed

⁴ *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

that the respective goods would travel in the same channels of trade to the same class of customers. See Canadian Imperial Bank of Commerce National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d (Fed. Cir. 1987). The goods are also relatively inexpensive items which would be purchased without an undue degree of care.

Turning to a comparison of the respective marks, we are guided by the well-established principle that when the marks are to be used on virtually identical goods, the degree of similarity necessary to support a holding of likelihood of confusion decreases. See Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). Here, we are faced with the potential use of applicant's mark MACRO EMULSION and registrant's mark MINI-EMULSION on the same type of hair care products, namely, shampoos.

The Examining Attorney argues that the marks create similar overall commercial impressions in that both imply that the products contain an "emulsion," although in varying degrees. As such, she contends, consumers would be likely to believe that the products bearing the two marks emanate from the same source.

Applicant, on the other hand, argues that the term MACRO is the dominant feature of its mark, whereas MINI is

the dominant component of registrant's mark. As a result, applicant contends, the marks not only differ in appearance and sound, but create different commercial impressions. While MACRO EMULSION has the connotation of "something large, extensive or all-encompassing in nature" and thus gives the impression of "power and substance" in the goods, the mark MINI-EMULSION suggests "smallness in a compound or emulsifying products at a miniscule level" and does not give the impression of "substantial or extensive action." (Brief, pp. 4-5).

Applicant likens the present situation to that in *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 213 USPQ 597 (TTAB 1982), *aff'd* 706 F.2d 1213, 217 USPQ 986 (Fed. Cir. 1983), wherein the Board found, and the Court affirmed, that there was no likelihood of confusion between the applicant's mark SUPER LOADER for boat trailers and the opposer's marks EZ LOADER and MINI LOADER for the same goods. The Board held that, although the marks shared the highly suggestive word LOADER, the marks as a whole did not look or sound alike nor did they have similar connotations. Applicant urges that a similar resolution is appropriate here.

At the outset, we note that the mark of registrant, as sought to be registered, was not inherently distinctive.

Nonetheless, registrant has obtained a registration on the basis of acquired distinctiveness. As such, registrant's mark is entitled to full protection against the subsequent registration by another of a similar mark for goods which might reasonably be assumed to emanate from it.

Looking to the marks as a whole, we find it obvious that there are differences in sound and appearance between MACRO EMULSION and MINI-EMULSION. Nonetheless we find the general overall commercial impressions created by the marks to be similar. As has often been stated, purchasers are not infallible in their recollection of marks and frequently retain only a general or overall impression of the marks. See *Interco Inc. v. Acme Boot Company, Inc.*, 181 USPQ 664 (TTAB 1974). Here both marks consist of a word beginning with M- and the word EMULSION. The M- word in each refers to a size. Thus, it appears highly likely that purchasers would confuse or interchange the marks MACRO EMULSION and MINI-EMULSION in their memories.

Moreover, even if purchasers recognize the differences between the two marks, we are convinced that they might well assume that products bearing the two marks originate from the same source. Each mark shares the word EMULSION, even if the exact connotation of the term is not understood by the purchaser. In each mark the remaining term, MACRO

or MINI, is clearly indicative of a size or proportion. Thus, when encountered on identical products, such as shampoo, we think it highly likely that purchasers would assume that these are companion products of different size "emulsions" from a single source. This is especially true considering the nature of the products, a new formula or new ingredient often being touted in the introduction of a companion cosmetic or personal care product. Cf. In re Copytele Inc., 31 USPQ2d 1540 (TTAB 1994)(purchasers likely to assume marks SCREEN FAX PHONE and FAX PHONE identify two different facsimile devices - one with a screen and one without - emanating from a single source).

Finally, we find the present situation is not comparable to that in the *EZ Loader* case cited by applicant. It is true that here, as in that case, one of the words in the mark may aptly be viewed as descriptive of the involved goods. Here the word is EMULSION, there it was LOADER. Here, as there, the question arises of whether one mark might be thought to be a companion product from the same source as the goods bearing the other mark. But at this point the parallel ends. In that case, the Board stated:

Opposer contends that "SUPER LOADER" might be thought to be a companion product of its "MINI LOADER." We do not agree. The opposite of "MINI" is

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"MAXI." Although "MINI LOADER" is highly suggestive of a trailer for small loads, this is distinctly a different impression than that which is conveyed by "SUPER LOADER."
213 USPQ at 601.

Here the two words are MINI and MACRO, which could readily be viewed as opposites with respect to the same attribute or feature of the goods. Given the presence of the MINI-EMULSION shampoo on the market, the appearance of the MACRO EMULSION shampoo would be presumed to be a new variation or a step-up companion product with the promise of improved results emanating from the same source. There is no distinctly different impression created by the substitution of the word MACRO for MINI.

Accordingly, in view of the identical or closely related nature of the respective goods, the common channels of trade and common purchasers, the goods being purchased without an undue degree of care and the relationship found to exist between the respective marks, we find that contemporaneous use of the marks is likely to cause confusion.

Decision: The refusals under Section 2(e)(1) and Section 2(d) are affirmed.

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