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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Carolina Herrera, Ltd.

Serial Nos. 75/668,973 &
75/668,974

Robert G. Sugarman of Weil, Gotshal & Manges LLP for Carolina Herrera, Ltd.

Jeffrey C. Coward, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Simms, Hanak and Rogers, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Carolina Herrera, Ltd. (applicant) has appealed from the final refusal of the Trademark Examining Attorney to register the mark 212 CAROLINA HERRERA for "cosmetics, namely, skin lotions, skin creams, toilet and beauty soaps, body milks, talcum powder, essential oils for personal use, deodorant for personal use and preparations for the hair, namely, shampoos and gels,"[1[1]] and

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[1[1]] Application Serial Number 75/668,973, filed March 26, 1999.

for "perfumery, namely, perfumes, colognes and eau de toilet."[2][2] In each case, the Examining Attorney has refused registration under Section 2(d) of the Act, 15 U.S.C. §1052(d), on the basis of Registration No. 1,262,148, issued December 27, 1983, (Sections 8 and 15 affidavit filed) for the mark 212 for skin conditioner. For convenience, we shall treat these appeals together.

Applicant and the Examining Attorney have filed briefs and applicant submitted a reply brief. Applicant did not request an oral hearing.

At the outset, we should note that the Examining Attorney has objected to applicant's brief on the basis that it exceeds the allowable page limit of 25 pages. See Trademark Rule 2.142(b)(2). Applicant's main briefs in these two appeals run 31 and 32 pages long, respectively, counting only the pages of argument. They are 38 and 39 pages long, respectively, when the title page, table of contents and table of authorities are included. Trademark Rule 2.142(b)(2), provides that, without prior leave of the Board, a brief may not exceed 25 pages in its entirety. The Examining Attorney's objection is well taken and applicant's main briefs will not be considered.[3][3]

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[2][2] Application Serial No. 75/668,974, filed March 26, 1999. Both applications claim use since August 14, 1997. Both applications also claim ownership of several registrations.

[3][3] The Examining Attorney has also objected to applicant's submission with its briefs of third-party registration evidence. Even if we had not excluded applicant's entire briefs, the third-party registration evidence submitted therewith would have been excluded as untimely. See Trademark Rule 2.142(d) and TBMP §§1106.07(b) and 1207.01.

The Examining Attorney argues that confusion is likely. First, the Examining Attorney notes that applicant's goods, especially its skin lotions and skin creams, are closely related to registrant's skin conditioner. The Examining Attorney argues that, because the issue of likelihood of confusion must be determined on the basis of the goods as identified in the respective registration and applications, which are without limit as to the specific type of goods or as to the channels of trade and classes of purchasers, we must presume that registrant's skin conditioners encompass all types of such goods and move in all normal channels of trade for those goods to all potential customers. The Examining Attorney also contends that the more closely related the respective goods, the less similarity is required between the marks in order to support a finding of likelihood of confusion.

With respect to the marks, the Examining Attorney argues that registrant's mark 212 is an arbitrary one for skin care products, and that the addition of applicant's name CAROLINA HERRERA (applicant's house mark) is not sufficient to overcome the likelihood of confusion. Although both registrant's and applicant's marks are presented in typed form, the Examining Attorney notes that the manner of applicant's actual use (shown below) exacerbates the likelihood of confusion:

> Further, the manner in which the applicant displays the proposed mark on the specimens of
> records accentuates the prominence of the 212
> portion of the mark. Specifically, 212 is

> displayed in a much larger and bolder font, and slightly above the additional wording (i.e., CAROLINA HERRERA). Accordingly, it is highly likely that consumers will focus on the 212 portion of the mark, and may even refer to the products simply as 212 when asking for the applicant's products.

Also, even assuming that applicant's mark is famous, as applicant has argued, the Examining Attorney contends that this alleged fame may enhance reverse confusion (the belief that both goods come from applicant), or encourage consumers to believe that Carolina Herrera endorsed or was in some way associated with the registrant's 212 goods.

Applicant, on the other hand, argues that its goods and registrant's goods are specifically different, with applicant's goods being high-end cosmetics whereas registrant's actual goods are in fact therapeutic skin conditioners sold in

large quantities to factories for use in workers' washrooms. Applicant maintains that the respective goods travel in different channels of trade, applicant's goods being sold in upscale department stores and exclusive cosmetic boutiques to sophisticated, affluent purchasers, whereas registrant's goods are sold to commercial establishments. Applicant also argues that its goods are relatively expensive. Concerning the marks, applicant contends that they project different commercial impressions. In this regard, applicant states that CAROLINA HERRERA is a world-renowned mark, which distinguishes its 212 CAROLINA HERRERA mark from registrant's mark. Also, although the cited mark is for the number 212, applicant compares its 212 CAROLINA HERRERA mark to the mark NORTH 212, which apparently includes registrant's house mark NORTH, arguing that there is no possibility that these two different house marks will be confused.

Upon careful consideration of this record and the arguments of the attorneys, we conclude that confusion is likely. First, as the Examining Attorney has argued, the issue of likelihood of confusion must be determined on the basis of the goods as they are identified in the applications and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Octocom Systems, Inc. v Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *Paula Payne Products Co. v Johnson Publishing Co, Inc.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973). If the cited registration and applicant's applications list the goods broadly and there are no

limitations as to the nature, type, channel of trade or classes of purchasers, we must presume that the registrant's goods (as well as applicant's) encompass all goods of the type described, that they move in all normal channels of trade and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Applicant's skin lotions and skin creams as well as its perfume products are closely related to registrant's skin conditioners.[4][4] These goods are similar, and may be sold in the same stores to the same class of purchasers. Also, contrary to applicant's arguments, we must assume that the respective products include relatively inexpensive items which may be sold to average purchasers.

Concerning the marks, we are in agreement with the Examining Attorney that applicant's mark so closely resembles registrant's mark that, when used in connection with these closely related goods, confusion is likely. When an applicant seeks registration of its mark in unstylized capital letters, we are aided by applicant's specimens showing the mark as actually used. *Phillips Petroleum Co. v. C.J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971) and *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585 (TTAB 1992). Here, the 212 portion of applicant's mark appears above and much more prominently than the name CAROLINA HERRERA shown in much smaller print. Consumers, aware of registrant's 212 skin conditioners, who then encounter applicant's 212

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[4][4] The Examining Attorney has supported the relationship of applicant's perfume products by relying upon third-party registrations of marks covering both perfume products and skin care products. See *In re Albert Trostel & Sons Co.,* 29 USPQ2d 1783 (TTAB 1993).

CAROLINA HERRERA skin care and perfume products, wherein the number 212 is prominently used, are likely to believe that these goods come from the same source or that applicant's goods are sponsored or authorized by registrant. What the Board stated in *In re Riddle*, 225 USPQ 630, 633 (TTAB 1985), is also applicable here:

> Applicant urges that, because of the fame of Richard Petty in conjunction with automobile racing, it is the "RICHARD PETTY'S" portion of applicant's mark which dominates the mark and which would cause it to be easily distinguishable from the mark shown in the cited registration. The problem with applicant's argument is that, while the name "Richard Petty" might well be a famous one in connection with automobiles and automobile racing, this fact does not diminish the likelihood of confusion in this case. In particular, those who encounter both the "ACCUTUNE" automotive testing equipment and the automotive service centers offered under applicant's mark would likely believe that Richard Petty endorsed or was in some way associated with both the goods and the services, in that both marks contain the designation "ACCUTUNE".

Decision: The refusal of registration is affirmed in both applications.