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Paper No. 14  
JQ

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Copamex, S.A. de C.V.

Serial No. 75/501,565

Perla M. Kuhn and Anna M. DePalo of Hughes Hubbard & Reed  
for applicant.

Laura Gorman Kovalsky, Trademark Examining Attorney, Law  
Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Quinn, Hohein and Bucher, Administrative Trademark  
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Copamex, S.A. de C.V.  
to register the mark shown below



for "body soaps; disinfectant soaps; deodorant soaps;  
deodorants for personal use; body creams; lotions, namely,

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skin lotions; wax and creams for cleaning and polishing floors and furniture; shampoo, namely, hair shampoo; detergents, namely, laundry detergent; liquid cleaners, namely, all-purpose cleaners; and aromatic or scented essential oils for household purposes" (in International Class 3) and "paper towel dispensers; soap dispensers; napkin holders; brooms; mops; brushes, namely, floor brushes; and sponges, namely, sponges for household purposes" (in International Class 21).<sup>1</sup>

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods so resembles the mark COPA (in typed form) and the mark shown below



for "cosmetics and hair products, namely, nail polish, skin cleansers, skin lotions, foundation makeup, shampoos,

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<sup>1</sup> Application Serial No. 75/501,565, filed June 12, 1998, based on an allegation of a bona fide intention to use the mark in commerce. The application includes the statement that applicant is the owner of Registration No. 2,199,258 (see footnote 4, infra).

conditioners, hair color, and hair relaxers" as to be likely to cause confusion.<sup>2</sup> The cited registrations are owned by the same person.

The Examining Attorney also has refused registration based on applicant's noncompliance with a requirement to disclaim the term "Mex" apart from the mark. The Examining Attorney asserts that the term is the abbreviation of "Mexico."

When the refusals were made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. Applicant originally requested an oral hearing, but subsequently withdrew the request.

#### Likelihood of Confusion

Applicant argues, in urging that the refusal grounded on likelihood of confusion be reversed, that the marks are dissimilar. Applicant states that the marks are different in sound and appearance. As to connotation, applicant asserts that the term "COPAMEX" is fanciful, as it is intended to stand for "Mexican paper consortium,"<sup>3</sup> whereas the term "copa" in Spanish means "cup" or "treetop."

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<sup>2</sup> Registration No. 2,150,068, issued April 14, 1998, and Registration No. 2,148,554, issued April 7, 1998, respectively.

<sup>3</sup> According to applicant, the "co" is intended to stand for "consorcio" which means "partnership" or "consortium" in Spanish; "pa" is intended to stand for "papelero" which means "(of) paper" in Spanish; and "mex" is intended to stand for "Mexican."

Applicant contends that the goods are different, focusing its remarks on the differences between registrant's cosmetics and applicant's goods in Class 21. Applicant has submitted third-party registrations, excerpts from Spanish-English dictionaries, and a copy of its prior registration of the same mark as that sought herein.<sup>4</sup>

The Examining Attorney maintains that the marks contain the identical arbitrary word "COPA" and that the differences between the marks is insufficient to distinguish them. The Examining Attorney also asserts that the goods in Class 3 are, in part, identical to the goods listed in the cited registrations.

Our determination under Section 2(d) is based on an analysis of all of the 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

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<sup>4</sup> Registration No. 2,199,258, issued October 27, 1998, lists the following goods: "paper and cardboard bags, cardboard boxes, toilet paper, disposable paper napkins, disposable paper handkerchiefs, disposable paper towels; writing notebooks and memorandum-books; congratulation greeting cards and bibliographic greeting cards, adhesive and non-adhesive note cards, Bristol-boards and note cards and gift cards; note-books, printing paper, paper for making books and magazines, paper for copiers, paper for facsimile transmission, paper for printers, paper for making notebooks and memorandum-books, envelopes and folders."

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similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

An initial comment is in order regarding the fact that the involved application is a combined application. Section 1113.05 of the *Trademark Manual of Examining Procedure* provides that "[a] refusal to register or a requirement may be made with regard to less than the total number of classes in the application" and that "[i]f appropriate, the examining attorney should clearly indicate the class to which the refusal or requirement pertains and that the refusal or requirement does not pertain to the remaining classes."

Inasmuch as it is clear that a refusal may be made with regard to less than the total number of classes in the application, the following remarks made by the Examining Attorney are puzzling: "The applicant does not dispute the fact that the marks are used in connection with identical Class 3 goods. However, the applicant argued that the cosmetic products covered by the cited registrations are dissimilar to its own Class 21 goods. However, this argument is not relevant in relation to an application for both classes of goods." (brief, p. 7).

The prosecution history shows that the Examining Attorney has concentrated on the overlapping goods in Class 3, with no mention of the goods in Class 21. No indication was ever made, however, that the Section 2(d) refusal pertained to Class 3 only. Although it is unclear whether the final refusal pertains to both classes, applicant filed an appeal with fees covering both classes. We will render a decision relative to both classes.

Turning first to the marks, we find that applicant's mark and registrant's marks are similar in sound and appearance. Registrant's mark COPA is similar to the COPAMEX portion of applicant's mark, made even more so by the special form of applicant's mark showing COPA on a separate line by itself. Further, neither the other features of applicant's mark nor the stylization of one of registrant's marks serves to sufficiently distinguish the marks in terms of overall commercial impression.

The third-party registrations do not diminish the distinctiveness of registrant's COPA marks which, based on this record, would appear to be arbitrary for the types of goods involved in this appeal.

With respect to the goods, registrant's goods and applicant's goods in Class 3 are, at least in part, identical in that both include skin lotions and hair

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shampoo. See: *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) [likelihood of confusion must be found if public is confused as to any item that comes within the identifications of goods in the involved application and registration]. As to such goods, there would be a likelihood of confusion when those products are sold under the marks at issue.

We find, however, that there are sufficient differences between the goods in the cited registrations (cosmetics and hair products) and the goods in Class 21 of the involved application (paper towel and soap dispensers, napkin holders, brooms, mops, brushes and sponges). The differences are such that there would be no likelihood of confusion when the goods are sold under the respective marks.

In summary, we find likelihood of confusion between registrant's marks for its goods and applicant's mark as to its goods in Class 3, and no likelihood of confusion between registrant's marks for its goods and applicant's mark as to its goods in Class 21.

#### **Disclaimer**

Insofar as the disclaimer requirement is concerned, applicant argues that the term "Copamex" is unitary and

that, therefore, there should be no disclaimer. Applicant points to the fact that "Copamex" is applicant's name and contends that while "Copa" and "Mex" appear on different lines, consumers are likely to perceive the use as the unitary name of applicant. Applicant also disputes that even if the goods originate in Mexico (which applicant states is only the Examining Attorney's assumption with the record silent on this point), the term "Mex" is not descriptive. In saying all of this, however, applicant also concedes that "'mex' is intended to stand for Mexican." Applicant has relied upon third-party registrations to show that the term is not uniformly disclaimed.<sup>5</sup>

The Examining Attorney contends that "Mex" is an abbreviation of "Mexico," that the primary significance of

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<sup>5</sup> Applicant submitted third-party registrations during the prosecution of the application. Applicant submitted additional third-party registrations with its appeal brief. The Examining Attorney has objected to the untimely submission accompanying the appeal brief. Applicant, in its reply brief, acknowledges this untimeliness, but requests that the Board take judicial notice of these registrations.

The objection is well taken inasmuch as the evidence attached to the appeal brief is untimely. Trademark Rule 2.142(d). Further, third-party registrations are not proper subject matter for judicial notice. *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290 (TTAB 1986); and *Cities Service Co. v. WMF of America, Inc.*, 199 USPQ 493 (TTAB 1978). Accordingly, the third-party registrations submitted with applicant's appeal brief have not been considered. In any event, they are, as pointed out by applicant in its reply brief, cumulative of the several registrations properly of record. Thus, even if considered, the evidence is not persuasive of a different result.

the term "Mex" is geographic, and that applicant's goods come from Mexico. Thus, according to the Examining Attorney, this primarily geographically descriptive term must be disclaimed apart from the mark. The Examining Attorney also disagrees with applicant's contention that the term is part of the unitary term "Copamex"; rather, the Examining Attorney points out that "Copa" and "Mex" appear on different lines in the mark. In support of the refusal, the Examining Attorney has submitted third-party registrations of marks comprising, in part, the term "Mex," and which show that the registrations include either a disclaimer of "Mex" or a claim of acquired distinctiveness under Section 2(f). Also of record is a dictionary listing of "Mex" as meaning "Mexico."

We find that the disclaimer requirement, made pursuant to Section 6(a) of the Act, is proper inasmuch as "Mex" is primarily geographically descriptive under Section 2(e)(2). Applicant itself has conceded that the "Mex" portion of its mark stands for "Mexico," the country in which applicant is located and from which the goods presumably originate. The dictionary listing confirms that "Mex" is the abbreviation of "Mexico." Such facts compel a finding that the primary significance of "Mex" is geographic, and that purchasers would be likely to think that the goods originate in

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Mexico. In re Handler Fenton Westerns, Inc., 214 USPQ 848 (TTAB 1982).

We do not share applicant's view that its mark, as shown in special form in the drawing, is a unitary mark. A unitary mark is one in which the registrable and unregistrable elements are so integrated or merged together that they cannot be regarded as separable units. Although it is true that "Mex" forms part of applicant's name "Copamex," many consumers may not even be aware of this. Rather, as presented in the special form drawing, where the "Mex" portion appears on a separate line, consumers are likely to view "Mex" as the abbreviation for "Mexico." As such, the term must be disclaimed as has been done in numerous third-party registrations. See: *Trademark Manual of Examining Procedure*, §1210.09.

Decision: The Section 2(d) refusal is affirmed as to International Class 3, and is reversed as to International Class 21. The requirement to disclaim the term "Mex" apart from the mark is affirmed. Applicant may, if it wishes, submit a disclaimer of the term "Mex" within thirty days of the mailing date hereof, in which case the present decision pertaining to the disclaimer will be set aside and the application will be forwarded for publication of the mark

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insofar as the application lists goods in International  
Class 21. Trademark Rule 2.142(g).