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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Peter Thomas Roth Labs, LLC**

Serial No. 76249513

**Christine M. Baker and Thomas M. Sullivan** of Mintz, Levin, Cohn, Ferris, Glovsky & Popeo, P.C. for **Peter Thomas Roth Labs, LLC**.

**Steven Foster**, Trademark Examining Attorney, Law Office 106 (Mary Sparrow, Managing Attorney).

Before **Seeherman, Hohein and Chapman**, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

**Peter Thomas Roth Labs, LLC** has filed an application to register the mark "PETER" for "hair care preparations; cosmetics and skin care preparations, namely, facial and body cleansers, skin moisturizers, hydrating creams for the face and body, facial and body lotions, facial and body scrubs, facial toners, beauty and body masks, skin lighteners, skin cleansing gels, skin moisturizing gels, sunscreen preparations, fragrances, namely, perfumes, toilet waters, colognes, and eau de colognes, and scented nonmedicated skin care preparations and cosmetics,

namely, dusting powders, soaps, personal deodorants, after-shave, body washes, body oils, body lotions, bath gels, bath oils and bath beads" in International Class 3.<sup>1</sup>

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "PETERER," which is registered for, among other items, "cosmetics, namely skin cleansing gel, skin cleansing milk, skin lotion, namely, cell energizer, eye contour cream, throat refining skin cream, fluid skin cleanser, skin toner, skin moisturizer, skin day care concentrate lotion, skin night care concentrate lotion, skin calming balm, skin and body purifying mask, skin and body scrub mask, skin moisturizing mask, shower gel, body exfoliant preparations, body lotion, body balm, personal deodorant, eau de toilette, self-tanning cream, sun block cream, sun protection cream, after sun cream, skin nourishing cream, cellulite reduction cream, lipstick, rouge, mascara, eye shadow, powder blush, make-up, perfume, nail color remover, hand cream, nail moisturizer, eye make-up remover, [and] eye make-up" in International Class 3,<sup>2</sup> as to be likely to cause confusion, or to cause mistake, or to deceive.

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<sup>1</sup> Ser. No. 76249513, filed on May 1, 2001, which is based on an allegation of a bona fide intention to use the mark in commerce.

<sup>2</sup> Reg. No. 2,176,090, issued on July 28, 1998, which is based upon Swiss Reg. No. 433125, dated May 15, 1966. Although the cited registration also sets forth various goods and services in other International Classes, it is clear from the arguments presented by applicant and the Examining Attorney that such goods and services are not relevant to the refusal to register.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.<sup>3</sup>

Turning first to the similarity or dissimilarity in the goods at issue, applicant argues in its main brief that, while it "has not commenced use of its mark PETER yet, ... the channels of trade will not be the same as nor will they overlap with the registrant's channels of trade" because applicant "plans to sell the goods identified in the application ... to select upscale beauty spas and hair salons and direct to consumers via its web site ... and mail order catalogs ...." Applicant further asserts that "[b]ecause the Applicant's products will be priced starting at \$25, they will be purchased by sophisticated consumers and by consumers who can afford to purchase and who typically purchase

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<sup>3</sup> The court, in particular, pointed out that: "The 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."

high-end skin care, cosmetic and toiletry products." In addition, applicant contends that by contrast:

The Registrant sells its goods through different venues and to a different consumer base than the Applicant. According to the registrant's web site ..., the Registrant's products are primarily available for purchase at its drugstore in Flawil, Switzerland, and through its web site, which interestingly is in German. .... The web site also indicates that the registrant's goods do not exceed a sale price of \$19, unlike the Applicant's more expensive products. Since the registrant is situated in Switzerland and its web site is in German, it can be presumed that its products are sold to a limited consumer group consisting of Swiss citizens and consumers who most likely only speak German and who are unlikely to spend more than \$20 on skin care preparations and cosmetics. This group of consumers does not overlap with the Applicant's English speaking consumers who are sophisticated and are willing to purchase cosmetics and skin care preparations that sell for more than the drugstore price. Considering the manner in which the parties market their products and the realities of the marketplace, it is highly unlikely that the same consumers will encounter the marks and respective products in commerce and mistakenly believe that they emanate from either the Applicant or the Registrant. ....

However, as the Examining Attorney properly points out in his brief, "many of the goods offered or to be offered by the respective parties must be viewed as being identical for the purpose of this proceeding," such as "skin moisturizers, skin cleansing gels, body lotions, [perfumes,] and personal deodorants," while "[o]ther listings appear to identify overlapping products." Examples of the latter, the Examining Attorney notes, include (a) registrant's "skin and body scrub mask" and its "skin moisturizing mask," which the Examining

Attorney contends "would appear to overlap with applicant's 'facial and body scrubs' and 'beauty and body masks'"; (b) registrant's "skin toner," which the Examining Attorney asserts "would appear to overlap with applicant's 'facial toners'"; and (c) applicant's "sunscreen preparations," which the Examining Attorney maintains "would appear to overlap with registrant's 'sun protection cream.'"

Moreover, as the Examining Attorney also correctly observes in his brief, applicant's arguments that the respective goods are distinguishable because of asserted differences in channels of trade and sophistication of purchasers "are essentially immaterial herein" inasmuch as it is well settled that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the involved application and the cited registration, and not in light of what such goods are asserted to actually be. See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Because neither the identification of applicant's goods nor that of registrant's goods contains any restriction as to the channels of trade for the respective goods or any limitation as to their classes of purchasers, it is

presumed in each instance that in scope the application and registration encompass not only all goods of the nature and type described therein, but that the identified goods move in all channels of trade which would be normal for those goods, and that they would be purchased by all potential buyers thereof. See, e.g., *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Accordingly, aside from applicant's "hair care preparations," the respective goods otherwise must be considered to be either legally identical or closely related cosmetic and skin care products. Plainly, if such goods were to be sold under the same or similar marks, confusion as to the source or sponsorship thereof would be likely to occur.

Turning, therefore, to consideration of the similarity or dissimilarity of the respective marks in their entireties, applicant argues in its main brief that such marks "differ in appearance and sound and, as a result, convey entirely different meanings." Specifically, applicant urges that its "PETER" mark "consists of five letters, has two syllables and looks and sounds familiar" due to, *inter alia*, its meaning as both "a common baptismal name for a man and ... the name of a disciple of Jesus." Applicant maintains, in this regard, that "'PETER' is the first name of the chief executive officer of the Applicant, Peter Thomas Roth[, ] and [that] consumers will perceive it as such when they see it on packaging and containers for the Applicant's goods," where it appears, as shown by the record, in the format "**PETERTHOMASROTH**." By contrast, applicant insists that registrant's "PETERER" mark, with the two additional letters

"ER," "is much longer in appearance and sound because it has seven letters and ... three syllables," and is further distinguished because it has significance only as a surname of Swiss or German origin.<sup>4</sup> In particular, as shown by the record, applicant notes that its "search of the internet uncovered the following individuals with the last name PETERER: Jane Peterer, and [sic] American music distributor, Franz Peterer, an individual who lived from 1893-1961, Anton Peterer, a Swiss musician, Gedichtet von Louise Peterer, a woman born in 1905, Gabi Peterer, an individual associated with a hotel, restaurant and villa called La Silena, and Stefan Peterer, a cyclist."

Thus, according to applicant:

This evidence clearly demonstrates that the registered mark PETERER is a surname and not a first name like the Applicant's mark. Moreover, even without giving due consideration to the Applicant's surname evidence, the Registrant's mark does not look or sound like or call to mind a first name. In fact, if and when consumers encounter the mark PETERER, they will most likely perceive it as a surname or as an arbitrary word. Accordingly, the marks can peacefully coexist on the Principal Register and in commerce because they convey sharply divergent meanings ....

The Examining Attorney, on the other hand, persuasively argues in his brief that:

When marks appear on virtually identical goods, the degree of similarity necessary to

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<sup>4</sup> Although applicant's argument comes perilously close to being an impermissible collateral attack on the validity of the cited registration on the ground that the subject mark is primarily merely a surname within the meaning of Section 2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4), we have treated applicant's contention as limited to the assertion that registrant's mark would not have either the same or a similar connotation to that of applicant's mark but would instead be perceived as either a surname or an arbitrary term.

support a conclusion of likelihood of confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992)[, *cert. denied*, 506 U.S. 1034 (1994)]. Viewed in this context, the respective marks, PETER and PETERER, are sufficiently similar in appearance and pronunciation as to result in a likelihood of confusion when used on identical products. The respective marks differ only by registrant's inclusion of the letters "ER" at the end of the term "PETER". These letters are naturally capable of being pronounced identically with the identical letters "ER" that immediately precede them. Thus, the respective marks not only look much alike, but could also be pronounced quite similarly. Neither mark includes additional matter that would aid purchasers in distinguishing them from each other. Although the respective marks are not identical, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The focus is on the recollection of the average purchaser who normally retains a general rather than a specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

As to applicant's assertions concerning the differences in connotation conveyed by the respective marks, the Examining Attorney observes that while "applicant supplied some evidence indicating that there are a few people having PETERER as a surname, the number of people shown to have this surname--six--is quite small" and that "only one of these persons, Jane Peterer, appears to be from the United States." Consequently, the Examining Attorney maintains that the "evidence falls short of proving that purchasers in this country would regard PETERER" as anything other than an arbitrary mark.

To us the marks "PETER" and "PETERER" are in their entireties so substantially identical in sound and appearance that for many purchasers the difference in connotation therein, due to the presence in respondent's mark of a repetition of the "ER" suffix which is also found in applicant's mark, is simply not likely to even be noticed, particularly when such marks are used in connection with legally identical and otherwise closely related cosmetic and skin care products. To the extent, however, that some purchasers may indeed perceive the difference in connotation between the given name or Biblical personage significance of the word "PETER" and the surname or merely arbitrary significance of the term "PETERER," such difference is on the whole outweighed by the virtual identity in sound and appearance of the respective marks. Such marks, in view thereof, convey substantially the same commercial impression and their contemporaneous use in connection with identical and otherwise closely related cosmetic and skin care products would be likely to cause confusion as to the origin or affiliation thereof.

Finally, as to applicant's assertion that confusion is nevertheless unlikely inasmuch as it intends to use its "PETER" mark in connection with the name of its chief executive officer, Peter Thomas Roth, which it currently uses in the form of the mark "**PETERTHOMASROTH**," the Examining Attorney properly notes in his brief that "the appearance of the house mark PETER THOMAS ROTH on all current packaging does not ensure that such use will exist for all future packaging, much less in a fashion prominent enough to attract the attention of the consumer." Furthermore,

as the Examining Attorney correctly points out, "the full name PETER THOMAS ROTH is not part of the mark sought to be registered," and thus it cannot lend registrability to an otherwise confusingly similar mark. Section 2(d) of the statute precludes registration of "a mark which so resembles a mark registered in the Patent and Trademark Office ... as to be likely ... to cause confusion ...." Therefore, the issue of likelihood of confusion must be decided on the basis of the mark sought to be registered and the mark shown in the cited registration. The fact that in this case applicant intends to use its mark "PETER" in connection with a house mark consisting of the name of its chief executive officer is thus legally irrelevant and immaterial to a determination of the issue of likelihood of confusion. See, e.g., *Sealy, Inc. v. Simmons Co.*, 265 F.2d 934, 121 USPQ 456, 459 (CCPA 1959); *Burton-Dixie Corp. v. Restonic Corp.*, 234 F.2d 668, 110 USPQ 272, 273-74 (CCPA 1956); *Hat Corp. of America v. John B. Stetson Co.*, 223 F.2d 485, 106 USPQ 200, 203 (CCPA 1955); and *ITT Canteen Corp. v. Haven Homes Inc.*, 174 USPQ 539, 540 (TTAB 1972).

We accordingly conclude that customers who are familiar or acquainted with registrant's "PETERER" mark for its various cosmetic and skin care products would be likely to believe, upon encountering applicant's substantially identical mark "PETER" for the same and otherwise closely related goods, that such products emanate from, or are sponsored by or affiliated with, the same source.

**Decision:** The refusal under Section 2(d) is affirmed.