

**THIS DISPOSITION  
IS NOT CITABLE AS  
PRECEDENT OF  
THE TTAB**

**Mailed: September 30, 2004**

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Lancetti Cosmetics

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Serial No. 76500431

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Myron Amer, Esq. for Lancetti Cosmetics.

Hannah M. Fisher, Trademark Examining Attorney, Law Office  
111 (Craig Taylor, Managing Attorney).

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Before Hairston, Walters and Chapman, Administrative  
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Lancetti Cosmetics has filed an application to register  
the mark LIGHT RESPONSE on the Principal Register for, as  
amended, "cosmetics, namely, foundation pressed powders and  
concealers," in International Class 3.<sup>1</sup>

The Trademark Examining Attorney has issued a final  
refusal to register under Section 2(d) of the Trademark Act,  
15 U.S.C. §1052(d), on the ground that applicant's mark so

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<sup>1</sup> Serial No. 76500431, filed March 17, 2003, based on an allegation of a  
bona fide intention to use the mark in commerce.

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resembles the two marks listed below, owned by different registrants and previously registered for the goods listed below, that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

**Mark: RESPONSE**

**Goods:** "hair shampoo," in International Class 3

**Registration No.:** 800504

**Owner:** Colgate-Palmolive Company Corporation

**Status:** Registered December 14, 1965; renewed for a term of 20 years from December 14, 1985.

**Mark: SKIN RESPONSE**

**Goods:** "cosmetics, namely, a non-medicated lip conditioner," in International Class 3

**Registration No.:** 2469539

**Disclaimer:** SKIN

**Owner:** L'Oreal USA Creative, Inc.

**Status:** Registered July 17, 2001

Applicant has appealed. Both applicant and the examining attorney have filed briefs, but an oral hearing was not requested. We reverse the refusal to register.

The examining attorney contends that applicant's mark is confusingly similar to the marks in each of the two cited registrations; that the term "light" in applicant's mark suggests the weight and/or depth of color of applicant's makeup; that the term "skin" in the registered mark SKIN RESPONSE is merely descriptive in connection with the recited lip conditioner and has been disclaimed; and that applicant's identified goods and the goods identified in

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each of the cited registrations are related personal care products.

In support of her position, the examining attorney submitted copies of five third-party registrations, all based on use in commerce, that include the following goods among those listed:

- cosmetic foundation and hair shampoo (Registration No. 2802432);
- foundation makeup, lip conditioner and shampoo (Registration No. 2799152);
- foundation, concealer and shampoo (Registration No. 2776781);
- lip conditioner and foundation (Registration No. 2704654); and
- foundation cream and shampoo (Registration No. 2702632).

Although the examining attorney submitted a photocopy of a dictionary definition of the word "light" with her brief, we decline to take judicial notice of that definition because the copy thereof is unreadable. We, instead, take judicial notice of the definition in *The American Heritage Dictionary*, Second College Edition, 1985, of "light" as, *inter alia*, "not dark in color; fair: *light hair and skin*" and "of relatively little weight; not heavy."

Applicant contends that its mark is different from the marks in each of the two cited registrations because it begins with the distinguishing word LIGHT; and that applicant's goods are unrelated to those identified in the cited registrations.

Our 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 & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 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). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein. The factors deemed pertinent in this proceeding are discussed below.

We turn, first, to a determination of whether applicant’s mark and each of the registered marks respectively, when viewed in their entirety, are similar in terms of appearance, sound, connotation and commercial impression. 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 impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. 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).

In considering applicant's mark, we note from the definition of record of the word "light," it is likely that the LIGHT portion of applicant's mark, LIGHT RESPONSE, may be somewhat suggestive of the color of the identified cosmetics (light versus dark), or that use of the cosmetics lightens the skin, or that the cosmetics are light in consistency when applied to the skin. The term RESPONSE would appear to suggest that the skin will respond (presumably favorably) to use of the identified goods, foundation pressed powders and concealers. Considering the mark as a whole, LIGHT RESPONSE is likely to be perceived as a unitary phrase with LIGHT modifying RESPONSE to indicate the type of "response;" and, thus, the connotation of LIGHT RESPONSE may suggest, *inter alia*, that the user's skin will

respond favorably to a "light" application of applicant's foundation or concealer.

The cited registration for the mark RESPONSE likewise appears to be suggestive of the presumably favorable response of the user's hair to use of the identified goods, hair shampoo. Although applicant's mark encompasses this mark in its entirety, we find that applicant's mark, LIGHT RESPONSE, is a unitary phrase that has a different connotation from the mark RESPONSE and that the commercial impressions of these two marks are different.

We find a similar analysis applies to a comparison of applicant's mark, LIGHT RESPONSE, to the mark in the other cited registration, SKIN RESPONSE. The registration contains a disclaimer of SKIN, which is merely descriptive of the fact that the identified goods, lip conditioners, are applied to skin. Viewed in its entirety, the mark SKIN RESPONSE has a markedly different and suggestive connotation from applicant's mark, LIGHT RESPONSE, suggesting that the customer's skin (lips in this case) will respond to use of the product. As above, we find the commercial impressions of the marks LIGHT RESPONSE and SKIN RESPONSE to be quite different.

Turning to consider the goods involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services

recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

The only evidence in this case consists of the copies of the five third-party registrations submitted by the examining attorney. Of these registrations, two include both applicant's goods and lip conditioners, the goods in

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Registration No. 2469539 for the mark SKIN RESPONSE; and four registrations contain both applicant's goods and hair shampoo, the goods in Registration No. 800504 for the mark RESPONSE. These third-party registrations, covering a number of differing goods and/or services and based on use in commerce, are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them. However, such registrations have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

However, the total of only five registrations, of which only two relate to the goods in one cited registration, and only four relate to the goods in the other cited registration, is insufficient, alone, to establish a relationship between applicant's goods and those of each of the two cited registrants. Further, we are unwilling to conclude that the goods are closely related merely because all are in the broad category of personal care products, which would be an impermissible per se rule.<sup>2</sup>

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<sup>2</sup> While common sense could lead to the supposition that at least applicant's foundation/concealer and lip conditioner, in the cited registration for SKIN RESPONSE, are both used on the skin, most likely the face, and, thus, may be complementary products. The examining attorney could have supplemented the two third-party registrations with, for example, excerpts from catalogs, Internet web sites or LEXIS/NEXIS.

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Therefore, we find, on this ex parte record, that the examining attorney has not established that the contemporaneous use of applicant's mark, LIGHT RESPONSE, and each of the cited registered marks, RESPONSE and SKIN RESPONSE, respectively, on the goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

*Decision:* The refusal under Section 2(d) of the Act is reversed as to each of the two cited registrations.

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However, notwithstanding any possible relationship between these goods, the marks LIGHT RESPONSE and SKIN RESPONSE are sufficiently different to avoid a likelihood of confusion.