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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Winmark Concepts, Inc.
v.
Aesthetic Resources, Inc.

Opposition No. 91115343
to application Serial No. 75551555
filed on September 10, 1998

Anthony R. Masiello of Holland & Knight for Winmark
Concepts, Inc.

Aesthetic Resources, Inc., pro se.

Before Hohein, Hairston and Holtzman, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Aesthetic
Resources, Inc. to register the mark E-MALE for "cosmetics
and skin care preparations, namely, cleansers, toners, skin
moisturizers, skin lotions for the face and body, body gels,

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soaps for the hands, face and body, personal deodorants, and body powders.”¹

Registration has been opposed by Winmark Concepts, Inc. under Section 2(d) of the Trademark Act on the ground that applicant’s mark, when used in connection with the identified goods, so resembles opposer’s previously used and registered mark E-MALE for “promoting the goods and services of others directed to male consumers through a global consumer network,”² as to be likely to cause confusion.

Applicant, in its answer, denied the salient allegations of the opposition.

Before turning to the merits of this case, we must first address two evidentiary matters. The first concerns the declaration of opposer’s president Andrew A. Isen submitted under notice of reliance. This declaration was previously submitted by opposer in support of its summary judgment motion. Evidence submitted in connection with a summary judgment motion does not form part of the evidentiary record to be considered at final hearing. Moreover, a party generally may not submit testimony by way of affidavit or declaration unless the adverse party has

¹ Serial No. 75551555, filed September 10, 1998, which alleges a date of first use anywhere and a date of first use in commerce on February 13, 1998.

² Registration No. 2,007,197, issued October 8, 1996; Section 8 affidavit accepted.

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stipulated thereto. Trademark Rule 2.123. Applicant, however, has not objected to the declaration. Further, in its brief on the case, applicant lists opposer's notice of reliance as being part of the record in this case. We therefore consider applicant to have stipulated to the declaration and we will treat it as properly of record.

The second matter concerns applicant's notice of reliance which consists solely of Internet printouts. Opposer has objected to the Internet printouts on the ground that an Internet printout does not qualify as a printed publication under Trademark Rule 2.122(e). Opposer's objection is well taken and thus we have not considered these printouts in reaching our decision. See *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998).

The record, therefore, consists of the pleadings; the file of the opposed application; and opposer's notice of reliance on a certified copy of its pleaded registration, excerpts from publications, and the declaration of opposer's president Andrew A. Isen. Applicant did not take testimony or properly offer any other evidence.³ Both parties filed briefs on the case, but an oral hearing was not requested.

³ We note that in an order mailed April 3, 2002, the Board granted opposer's motion to strike the exhibits accompanying applicant's brief, and thus such materials do not form part of the record herein.

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Our determination of likelihood of confusion under Section 2(d) must be 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. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Given the sparse record in the present case, there are only two relevant factors to be considered, namely the similarities/dissimilarities between the marks and the goods/services.

Opposer's president, Andrew A. Isen, states in his declaration that opposer is a marketing company with a wide variety of clients, including companies for whom opposer markets skin care preparations and cosmetics. Mr. Isen states that opposer first used the E-MALE mark in connection with the marketing of men's cosmetics and skin care preparations in an e-mail broadcast on March 23, 1995. Submitted with opposer's notice of reliance are advertisements taken from magazines which feature various men's cosmetics and skin care preparations. Each of the advertisements includes the company or product's Internet address. For example, there is a full-page advertisement for "Tommy" cologne and the Internet address "tommy.com" appears thereon; and a full-page advertisement for "Nivea For Men" for exfoliating face scrub and the Internet address www.nivea.com appears thereon.

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Because applicant failed to take testimony or properly offer any other evidence, we have no information about applicant.

Priority of use is not in issue in view of the certified copy of opposer's pleaded registration submitted by notice of reliance, which shows that such registration is subsisting and owned by opposer. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Regarding the similarities in the marks, it is obvious that they are identical. Both parties' marks are for the identical term, E-MALE, in typed drawing form.

We now consider whether the goods and services of the parties are related. It is not necessary that the goods and/or services be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods/services are related in some manner, or that the circumstances surrounding their marketing are such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods/services. See *In re Melville Corp.*, 18

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USPQ2d 1386 (TTAB 1991); In re Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978).

It is opposer's position that its services and applicant's goods are related because "[o]pposer's registration encompasses advertising and marketing for goods of the type identified in the Application." (Brief, p. 9). Further, opposer argues that cosmetics and skin care companies who market their products over the Internet commonly include their Internet addresses in their print advertisements. According to opposer, these companies' trademarks and web site addresses are generally very similar and therefore "a consumer who sees skin care products marketed on Opposer's website in connection with the mark E-MALE, and who is later confronted with skin care products marketed with the trademark E-MALE, would readily believe that there is a connection between the product and web site." (Brief, p. 12). Opposer argues that the present case is virtually identical to *CPC International Inc. v. Skippy Inc.*, 3 USPQ2 1456 (TTAB 1987), which involved use of the identical mark SKIPPY for peanut butter and the services of promoting the goods and services of others by rendering assistance in devising advertising and merchandising programs.

Applicant, on the other hand, argues that opposer should not prevail herein because opposer is not involved in

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promoting goods or services which bear the mark E-MALE and because there is no evidence that applicant markets its cosmetics and skin care preparations over the Internet.

After careful consideration of the parties' arguments and the record in this case, we find that notwithstanding the identity of the marks, opposer has not established that its services and applicant's goods are sufficiently related that confusion is likely.

There are specific differences between opposer's services of "promoting the goods and services of others directed to male consumers through a global consumer network" and applicant's "cosmetics and skin care preparations, namely cleansers, toners, skin moisturizers, skin lotions for the face and body, body gels, soaps for the hands, face and body, personal deodorants, and body powder." In particular, opposer's services, as identified, involve activities designed to promote the goods and services of others. Applicant's goods, as identified, obviously do not involve promoting the goods and services of others, but instead are simply cosmetics and skin care preparations. We recognize that opposer's recitation of services is broadly stated such that it may encompass the promotion of men's cosmetics and skin care preparations, and that applicant's identification of goods is broadly stated such that it may encompass men's cosmetics and skin care preparations. This,

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however, does not mean that opposer's services and applicant's goods are related.

Applicant argues that there is no evidence that its goods are marketed on the Internet. In the absence of any limitations with regard to channels of trade in applicant's application, we must presume that applicant's cosmetics and skin care preparations move in all channels of trade normal for such goods. Thus, for purposes of our likelihood of confusion analysis, we must assume that applicant's cosmetics and skin care preparations are marketed over the Internet. Nonetheless, this fact does not establish that applicant's goods are related to opposer's services which involve the promotion of the goods of services of others on the Internet.

Further, it appears that opposer's services and applicant's goods would be offered to different classes of purchasers. There is no question that applicant's cosmetics and skin care preparations are the types of goods that are purchased by ordinary consumers. However, opposer's promotional services are not of a type that would be purchased by ordinary consumers, but rather by owners of companies who sell goods and services directed to male consumers. There is a very remote possibility that some customer somewhere may be confused, but based on the meager record before us, that situation amounts to only a

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speculative, theoretical possibility. *Witco Chemical Co. v. Whitefield Chemical Co.*, 419 F.2d 1403, 1405, 164 USPQ 43 (CCPA 1969). This de minimis situation does not warrant a finding of likelihood of confusion, notwithstanding the identity of the marks.

We recognize that in *CPC International Inc. v. Skippy Inc.* the Board found that contemporaneous use of the mark SKIPPY for peanut butter and promoting the goods and services of others was likely to cause confusion. However, there were two factors present in that case which are not present here. The fame of the opposer's SKIPPY mark was a significant likelihood of confusion factor in that case and there was evidence that the opposer had licensed use of the SKIPPY mark for use on various products.

In sum, we find that notwithstanding the identity of the marks, there is no likelihood of confusion in this case because opposer's services and applicant's goods are specifically different and not related.

Decision: The opposition is dismissed.