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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Light Speed Laser Health Care and Skin Spa, Inc.

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Serial No. 76499359

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James A. Sedivy of Levinson, Kaplan, Arshonsky & Kurtz for  
Light Speed Laser Health Care and Skin Spa, Inc.

Susan Leslie DuBois, Trademark Examining Attorney, Law  
Office 111 (Craig Taylor, Managing Attorney).

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Before Hanak, Holtzman and Rogers, Administrative Trademark  
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Light Speed Laser Health Care and Skin Spa, Inc.  
(applicant) seeks to register BLUE in the form shown below  
for "health spa services, namely, cosmetic body care  
services, cosmetic electrolysis." The application was  
filed on March 11, 2003 with a claimed first use date of  
February 24, 2003.



Citing Section 2(d) of the Trademark Act, the Examining Attorney refused registration on the basis that applicant's mark, as applied to applicant's services, is likely to cause confusion with the mark BLUE DOOR previously registered in typed drawing form for "professional medical services in the field of plastic, cosmetic and reconstructive surgery; spa services providing body and skin treatments, namely massages, applications of lotions and compositions including skin lighteners, skin

masks, antioxidant treatments, skin peels and salt scrubs." Registration No. 2,604,886.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant specifically waived its right to an oral hearing. (Applicant's brief page 1).

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effects of differences in the essential characteristics of the goods [or services] and differences in the marks.").

Considering first the services, we note that they are, in part, legally identical. Applicant seeks to register BLUE (stylized) for, among other services, "health spa services, namely, cosmetic body care services." The services of the cited registration include "spa services providing body and skin treatments, namely massages, applications of lotions and compositions including skin lighteners, skin masks, antioxidant treatments, skin peels and salt scrubs." Applicant's wording of certain of its services ("health spa services, namely, cosmetic body care

services") is broad enough to include the specific spa services set forth in the cited registration. Indeed, applicant does not argue to the contrary. Rather, at page 11 of its brief, applicant merely argues that its actual services are different from registrant's actual services. Moreover, at page 14 of its brief, applicant argues that its actual services and registrant's actual services are expensive, and that its actual customers and registrant's actual customers are "sophisticated."

Even assuming for the sake of argument that there are some differences in applicant's and registrant's actual services, and that furthermore that in actuality applicant's and registrant's services are expensive and are marketed to sophisticated consumers, applicant's argument overlooks the fact that in Board proceedings, we are obligated to decide the issue of likelihood of confusion based on the services set forth in applicant's application and the services set forth in the cited registration. See Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987) (It is well settled that in Board proceedings, "the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services

recited in [the cited] registration, rather than what the evidence shows the goods and/or services to be."). As set forth in its application, applicant's health spa services are not limited to expensive health spa services marketed only to sophisticated consumers. Likewise, registrant's spa services are not limited to expensive spa services marketed only to sophisticated individuals. Thus, as set forth in applicant's application and the cited registration, certain of applicant's services are legally identical to certain of registrant's services. As noted earlier, applicant does not contend otherwise.

Turning to a consideration of the marks, we note at the outset when applicant's services are in part legally identical to the services of the cited registration as is the case here, "the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Obviously, the first word of the registered mark (BLUE DOOR) is identical to applicant's mark BLUE (stylized). At page 5 of its brief, applicant argues that while its mark could be read "as one word BLUE," it could also be read as two words, namely, "BLU and E." We find that applicant's

argument is disingenuous. While it is true that as presented in applicant's stylized rendition of the word BLUE, the E is beneath the U, we find that virtually every consumer would recognize applicant's mark as the word BLUE. Thus, in terms of pronunciation, the two marks are quite similar. A consumer pronouncing registrant's mark BLUE DOOR would have to first pronounce applicant's mark BLUE (stylized).

Moreover, we note that at page 6 of its brief, applicant acknowledges that both marks are entirely arbitrary as applied to their respective services. As applicant states, "the two subject marks, BLUE (stylized design) and BLUE DOOR have no particular meaning with regard to the classes of services set forth in the respective application and registration." Given the fact that the registered mark BLUE DOOR is, as applicant admits, entirely arbitrary, it is entitled to a broader scope of protection.

Finally, during the course of this proceeding, applicant made of record a mere list of 568 applications in Class 42 incorporating the word BLUE. Applicant contends that this list demonstrates that "BLUE, alone, or in combination with other words, is clearly a weak mark." (Applicant's brief page 6).

We have two comments. First, a mere list of BLUE marks in Class 42 is of virtually no evidentiary value. Applicant has not supplied any information as to what services these purported BLUE applications seek to cover. Second, and more importantly, even if applicant had supplied a list of actual registrations (as opposed to mere applications) that detailed the precise services for which certain BLUE marks were actually registered, such registrations would be of no value in our likelihood of confusion analysis. See Smith Bros. Mfg. Co. v. Stone Mfg. Co., 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) ("But in the absence of any evidence showing the extent of use of any such marks or whether any of them are now in use, they [the third-party registrations] provide no basis for saying that the marks so registered have had, or may have, any effect at all on the public mind so as to have a bearing on likelihood of confusion.") (original emphasis).

Given the fact that certain of applicant's services are in part legally identical to certain of registrant's services, and the additional fact that the two marks are quite similar in that they both consist or contain the arbitrary word BLUE, we find that there exists a likelihood of confusion.

Decision: The refusal to register is affirmed.