

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed:
August 10, 2005

Grendel

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Parfums de Coeur, Ltd.
v.
Fanslly International Co. Ltd.

Opposition No. 91156614
to application Serial No. 78125608
filed on May 2, 2002

Tina H. (Kim) Lee of Davis Wright Tremaine LLP for Parfums de Coeur, Ltd.

Elizabeth W. King of Arnold & Ferrera, L.L.P. for Fanslly International Co. Ltd.

Before Walters, Grendel and Zervas, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant herein, Fanslly International Co. Ltd., seeks registration on the Principal Register of the mark BODY FANSLLY (in standard character form), for goods identified in the application as "cosmetics; skin care products, namely, non-medicated skin care preparations," in Class 3.¹

¹ Serial No. 78125608, filed on May 2, 2002. The application is based on applicant's asserted bona fide intention to use the mark in commerce. See Trademark Act Section 1(b), 15 U.S.C. §1051(b).

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Applicant has disclaimed the exclusive right to use BODY apart from the mark as shown.

Opposer herein, Parfums de Coeur, Ltd., has opposed registration on the ground that applicant's mark, as applied to the goods identified in the application, so resembles the mark BODY FANTASIES, previously registered² by opposer for goods identified in the registration as "women's fragrances, namely, perfume, cologne, toilet water; scented body sprays; personal deodorants; shower gels; body lotions; body powders; soaps," as to be likely to cause confusion, to cause mistake or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant filed an answer by which it denied the salient allegations of opposer's Section 2(d) claim.

The evidence of record consists of the pleadings herein, the file of applicant's involved application, certain documentary materials made of record by opposer and by applicant via their respective notices of reliance, and the testimony deposition of opposer's president Mark Laracy (and the exhibits thereto).³

² Registration No. 2104321, which issued on October 7, 1997. Affidavits under Trademark Act Sections 8 and 15 have been accepted and acknowledged.

³ By its June 17, 2005 interlocutory order (upon applicant's motion), the Board has stricken Exhibit 5 to opposer's Supplemental Notice of Reliance (consisting of two reports from Information Resources, Inc.), and those reports shall be given no consideration. We therefore also disregard the materials attached to applicant's brief on the case (consisting of evidence

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The parties have fully briefed the case, but no oral hearing was requested.

At trial, opposer submitted status and title copies of its pleaded Registration No. 2104321. The registration is extant and is owned by opposer. Because opposer has properly made its pleaded registration of record, and because opposer's likelihood of confusion claim is not frivolous, we find that opposer has established its standing to oppose registration of applicant's mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Moreover, because opposer's pleaded registration is of record, Section 2(d) priority is not an issue in this case as to the mark and goods covered by said registration. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

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. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177

of alleged third-party uses of FANTASY marks in connection with fragrances), which are irrelevant to the extent that they are offered in support of applicant's "competency objection" to opposer's now-stricken Exhibit 5. In any event, these additional materials from applicant were not made of record at trial and therefore are untimely.

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USPQ 563 (CCPA 1973). See also *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Turning first to a comparison of the parties' goods as identified in applicant's application and opposer's registration, we find that applicant's goods, i.e., "cosmetics; skin care products, namely, non-medicated skin care preparations," and opposer's goods, i.e., "women's fragrances, namely, perfume, cologne, toilet water; scented body sprays; personal deodorants; shower gels; body lotions; body powders; soaps," are highly similar. Indeed, in certain respects the goods are legally identical, inasmuch as applicant's non-medicated skin care preparations legally encompass opposer's body lotions and sprays, body powders, and soaps. Applicant concedes as much at page 8 of its brief. The second *du Pont* evidentiary factor thus weighs in favor of a finding of likelihood of confusion.

There are no restrictions or limitations in either party's identification of goods, and we therefore find that

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the parties' respective goods are or would be marketed in all normal trade channels for such goods and to all normal classes of purchasers for such goods. Given the similarity and/or legal identity of the respective goods, we presume that the parties' trade channels and classes of purchasers are or would be overlapping. Moreover, we find that the parties' respective goods are ordinary, inexpensive consumer goods, which are or would be purchased by ordinary consumers who would use only ordinary care in purchasing the goods. For these reasons, we find that the third and fourth *du Pont* evidentiary factors weigh in favor of a finding of likelihood of confusion.

Next, we find that opposer's BODY FANTASIES mark is strong, if not famous, in the marketplace. Mr. Laracy's unrefuted testimony is that opposer's BODY FANTASIES products first came on the market in 1996; that they now are marketed in some 22,000 retail outlets nationwide, including chain drug stores and mass market retailers such as WalMart, K-Mart, Target and Sears; that fifty million units of opposer's products are sold annually, with gross sales of over thirty-five million dollars in 2003 and over forty-two million dollars in 2002. In the mass market fragrance category in which opposer competes (a market category which excludes specialty retailers like Bath and Body Works, Body Shop, and Victoria's Secret), opposer's BODY FANTASIES ranks

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second in market share, behind only Coty. From 1996 through the end of 2003, opposer has expended nearly thirty-one million dollars in advertising and promoting its mark, via network television advertising and in magazines such as Marie Claire, Seventeen, Teen, YM, People and Shape.

Applicant contends that, notwithstanding opposer's apparent success in the marketplace, opposer's BODY FANTASIES mark is inherently weak, diluted and descriptive, and that it therefore is not entitled to a scope of protection which is broad enough to preclude registration of applicant's mark. We are not persuaded by this argument.

First, applicant's allegation that opposer's registered mark is merely descriptive is an unacceptable collateral attack on the registration in the absence of a counterclaim for cancellation. Furthermore, we note that opposer's pleaded registration is incontestable, and that it therefore is immune to applicant's charge that the registered mark is merely descriptive. We also find, for the following reasons, that applicant's evidence fails to support applicant's contention that opposer's BODY FANTASIES mark is diluted and weak, or deserving of only a narrow scope of protection.

Applicant has submitted printouts (from the Office's TESS database) consisting of mere listings of third-party marks (in Class 3) which include the words BODY, or FANTASY,

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or the truncated words FAN* and FANTAS*. We have given these listings no consideration, for the following reasons.

First, it is settled that third-party registrations may not be made of record merely by listing them; complete plain copies (even if non-certified) of the registrations themselves are required. See *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998); *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); and TBMP §704.03(b)(1)(B)(2d ed. rev. 2004). Second, even if applicant had properly made the third-party registrations of record, they would have had no probative value under the sixth *du Pont* evidentiary factor, i.e., "the number and nature of similar marks in use on similar goods". See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). Third-party registrations are not evidence of what happens in the marketplace or that purchasers are aware of the registered marks. See *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1798 (TTAB 2001). Finally, applicant's mere listings have little or no probative value because they reveal only the application serial numbers, the registration numbers (of registered marks), and the marks for each item on the list. The goods covered by each registration are not disclosed in

these lists of marks; we know only that the registrations are for goods in Class 3 (a class which covers many other types of goods, such as household cleaning products, in addition to cosmetics or fragrances).

Applicant's notice of reliance also includes (as Exhibit D) Internet printouts (from Amazon.com) of excerpts from what appear to be various marketing textbooks and other materials which applicant asserts are available to the general public. Applicant argues that these sources show that the evocation of "fantasy" is a common marketing motif and concept used to sell products, especially in the cosmetics and beauty field. However, even assuming (hearsay aside) that the assertions made in these excerpts are true, i.e., that a "fantasy" motif is commonly used as a marketing tool in this field, and assuming that these documents are of the type which properly may be introduced via notice of reliance, we find that these book excerpts on this subject are entitled to little or no weight. There is no evidence that the relevant purchasers of applicant's and opposer's goods, i.e., ordinary consumers, are familiar with these Internet book excerpts submitted by applicant.⁴ Likewise,

⁴ The Amazon.com excerpts are from books entitled International Marketing Research, 2d; Essential Oils: Analysis by Capillary Gas Chromatography and Carbon 13-NMR Spectroscopy; Media Research Techniques; Advertising, the Uneasy Persuasion: Its Dubious Impact on American Society; Can't Buy My Love: How Advertising Changes the Way We Think and Feel; Escape Attempts: The Theory

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there is no evidence that the relevant purchasers are aware at all that merchandisers use a "fantasy" marketing motif, or that, even assuming such familiarity, this marketing motif would have any effect on the consumer's ability to recognize opposer's BODY FANTASIES as a trademark for opposer's goods. Finally, none of applicant's textbook evidence shows that FANTASY is commonly used in trademarks in the beauty or cosmetics field.

In short, we are not persuaded by applicant's contention that opposer's mark is weak or entitled to a narrow scope of protection. Rather, we find that opposer's mark is a strong, well-known mark that is suggestive, if not arbitrary, as applied to opposer's goods.

We turn now to what appears to be the essence of applicant's argument in support of registration of its mark, i.e., that its mark BODY FANSLLY is so dissimilar to opposer's BODY FANTASIES mark that confusion is unlikely, notwithstanding the similarity of the goods, the similarity of the trade channels and classes of purchasers for the goods, and notwithstanding any strength which might be accorded to opposer's mark.

Under the first *du Pont* factor, we must determine whether applicant's mark, BODY FANSLLY, and opposer's mark, BODY FANTASIES, are similar or dissimilar when compared in

and Practice of Resistance to Everyday Life; and Representing

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their entireties in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. 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 impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, 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). Finally, in cases such as this, where the applicant's goods are legally identical to the opposer's goods, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical. *Century 21 Real Estate*

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Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

In terms of appearance, we find that applicant's and opposer's respective marks are similar to the extent that they are both composed of two words, i.e., the word BODY followed by a word which begins with the letters FAN. FANTASIES and FANSLLY obviously look different in their entirety. On balance, we find that the points of similarity between the marks outweigh the points of dissimilarity, and that when the marks are compared in their entirety, they are more similar than dissimilar.

In terms of sound, we find that the marks are similar. The word BODY sounds the same in each of the marks. FANTASIES and FANSLLY also sound similar to each other. The first syllable of FANTASIES and FANSLLY is "FAN." The letter "S" appears in the middle of each mark, and the "S" is followed by a long "E" sound. We are not persuaded by applicant's argument that the marks are dissimilar because FANTASIES in opposer's mark is in the plural, while FANSLLY in applicant's mark appears to be in the singular.

Finally with respect to the comparison of the parties' marks in terms of sound, we note Mr. Laracy's unrebutted testimony asserting that purchasers often learn about fragrances and related cosmetic products, and make their

decisions to purchase such products, by word-of-mouth advertising:

... one of the ways a woman learns about a new fragrance is smelling it on another woman. And like Betsy may be wearing Body Fantasies fresh white musk and Suzy maybe sitting next to her and say 'Boy, you smell great, what are you wearing?' And back comes the answer, 'Body Fantasies.' So it's a verbal communication.

(Laracy Depo. at 79-80.) He later testified again on this point as follows:

Q. Mr. Laracy, amongst the typical consumer who purchases a Body Fantasies product, how is amongst them the product further advertised or promoted?

A. Word of mouth.

Q. So what is your concern with the Body Fanslly trademark put in by applicant here?

A. Well, I just think when a woman tells another woman - when they talk about a fragrance, I think it's very easy to confuse Body Fantasies and Body Fanslly.

(Laracy Depo. at 105.) We agree, and find that the two marks at issue, although not identical in terms of sound, nonetheless are highly similar. Of course, there is no "correct" pronunciation of a trademark. But it is entirely reasonable to assume, as Mr. Laracy testified, that purchasers of the goods are likely to confuse these two marks aurally. BODY FANTASIES is likely be elided into, and heard as, BODY FANSLLY, and vice versa.

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Next, we must compare the marks in terms of their meanings. BODY means the same thing in both marks, i.e., that the products are designed for use on one's body. The word FANTASIES, as applied to opposer's goods, suggestively connotes that the products will evoke a fantastical or fantasized fragrance experience when they are applied to one's body.

FANSLLY, the second word of applicant's mark, is a coined or arbitrary word which would have no meaning or significance to consumers in the United States. Applicant contends that FANSLLY is a variation on the transliteration of the first two characters of the ten Chinese characters which make up applicant's company name. Applicant submitted (as Exhibit G to its notice of reliance) an affidavit from an English-Chinese translation expert (Robin Feng of Feng's Language Services) which includes a translation certificate and a transliteration certificate pertaining to applicant's mark. The "Certificate of Translation" states, in relevant part, that applicant's Chinese company name is depicted, in Chinese, as ten Chinese ideographic characters, the first two of which are translated as "fragrance and beauty." The Certificate of Transliteration states, inter alia, that "the phonetic transliteration of the first two Chinese characters of the company name [reproduction of symbols omitted here] sounds like 'Fan lly' in English."

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Not to be outdone, opposer's Supplemental Notice of Reliance includes, as Exhibit No. 7, an affidavit from its own Chinese language expert, Harry Ping Dai. In transliterating the first two Chinese characters of applicant's Chinese name in accordance with various transliteration conventions, he concludes that the two characters transliterate as "fenli," as "fenlih," or as "hunle." He concludes his affidavit by stating that "there is no evidence, according to any Mandarin transcription system, that [the first two Chinese characters in applicant's Chinese name] could be spelled as 'Fanslly.'"

We find that English-speaking consumers in the United States would not be aware that FANSLLY is based on a transliteration of applicant's company name, and that they would view the mark as a coined or arbitrary term. Even consumers familiar with the Chinese language would view the word as arbitrary or coined, since it is not a direct transliteration of the first two characters of applicant company's name. Applicant's expert says that the characters are translated as "fan lly," and opposer's expert says that the characters are translated as "fenli," "fenlih" or "hunle."⁵ In none of these transliterations does the letter

⁵ There is no stipulation in the record which would allow the parties to submit, by means of an affidavit via notice of reliance, what essentially is expert language testimony. However, because both parties have done so and neither has objected to the other party's use of affidavits in this manner,

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"S" appear. The reason applicant has inserted the "S" into the middle of the second word of its mark is not apparent on this record, but the effect of such insertion of the "S" is that it makes applicant's mark look and sound more like opposer's word FANTASIES than it otherwise would without the "S."

Thus, the meaning of applicant's mark BODY FANSLLY would not be known to consumers, even those who understand Chinese. Therefore, consumers in this country cannot utilize any such meaning as a means of distinguishing applicant's BODY FANSLLY mark from opposer's BODY FANTASIES mark. Consumers attempting to distinguish the two marks must do so on the basis of the appearance and sound of the marks, and, as we have discussed above, the marks are more similar than dissimilar in terms of appearance and sound.

We find that the similarities between the marks in terms of their appearance and sound, especially in terms of sound, outweigh the apparent dissimilarity between the marks' meanings. For these reasons, we find that the overall commercial impressions of the marks are similar rather than dissimilar.

We certainly cannot conclude, as applicant would have us conclude, that BODY FANTASIES and BODY FANSLLY are so

we find that these affidavits, and the evidence they contain, are of record in this case, and we shall give them their due probative weight.

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dissimilar that the dissimilarity of the marks under the first *du Pont* factor outweighs all of the evidence pertaining to the other *du Pont* factors which support a finding of likelihood of confusion. In other words, this is not a case like *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

As noted above, because the goods identified in applicant's application are highly similar to, and in some instances legally identical to, the goods identified in opposer's registration, the degree of similarity between the two marks which is necessary to support a finding of likelihood of confusion declines. See *Century 21 Real Estate Corp. v. Century Life of America*, *supra*. When applied to similar and identical goods, the marks BODY FANTASIES and BODY FANSLLY are sufficiently similar that confusion is likely to occur. Furthermore, as discussed above, the evidence of record does not support applicant's other main argument, i.e., that opposer's BODY FANTASIES mark is weak and entitled to a narrowed scope of protection. Rather, we find on this record that BODY FANTASIES is a strong mark, and that the scope of protection to which it is entitled is broad enough to preclude registration of

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applicant's BODY FANSLLY mark for the similar and/or legally identical goods identified in applicant's application.

On the basis of the factual findings discussed above, we find that confusion is likely to occur if applicant's BODY FANSLLY mark were to be used on or in connection with the goods identified in applicant's application. We have considered all of applicant's arguments to the contrary (including arguments not specifically addressed in this opinion), but are not persuaded. To the extent that any doubts might exist as to the correctness of our likelihood of confusion determination, we resolve such doubts against applicant. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The opposition is sustained.