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April 20, 2006
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re MBI Distributing, Inc.

Serial No. 76529025

Rakesh M. Amin of Amin Law, LLC for MBI Distributing, Inc.

Darryl M. Spruill, Trademark Examining Attorney, Law Office 112
(Janice O'Lear, Managing Attorney).

Before Hohein, Bucher and Rogers, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

MBI Distributing, Inc. has filed an application to
register on the Principal Register the mark "EARTH ESSENCE NATURE
BEAUTY HEALTH" and design, as shown below,



for "dietary supplements" in International Class 5.¹

¹ Ser. No. 76529025, filed on July 3, 2003, which is based on an allegation of a date of first use anywhere and in commerce of September 1, 2002. The words "NATURE," "BEAUTY" and "HEALTH" are disclaimed.

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 "LIVING EARTH ESSENCES," which is registered on the Principal Register in standard character form for "dietary supplements, namely, flower essences and plant essences, prepared from plant infusions in water, generally preserved with brandy, for personal dietary use" in International Class 5,² as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed. Briefs have been filed,³ 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 or services at issue and the

² Reg. No. 2,606,948, issued on August 13, 2003, which sets forth a date of first use anywhere of April 1, 1994 and a date of first use in commerce of February 10, 1995.

³ It is noted that applicant's brief is not double-spaced as required by Trademark Rules 2.126(c) and 2.142(b)(2). Nonetheless, inasmuch as the Examining Attorney has not objected thereto and it is clear that applicant's brief would not exceed the 25-page limitation imposed by Trademark Rule 2.142(b)(2) if it were properly double-spaced, such brief has been considered.

similarity or dissimilarity of the respective marks in their entireties.⁴

Turning first to consideration of the respective goods, it is well settled that the issue of likelihood of confusion must be determined on the basis of the goods as they are respectively set forth in the particular 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). Moreover, where the goods in the application at issue and in the cited registration are broadly described as to their nature and type, such that there is an absence of any restriction as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of goods encompasses not only all goods of the nature and type described therein, but that the identified goods are provided in all channels of trade which would be normal therefor, and that

⁴ 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 [or services] and differences in the marks." 192 USPQ at 29.

they would be purchased by all potential buyers thereof. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

Here, as the Examining Attorney correctly points out in his brief, applicant's and registrant's goods are identical in that both are identified as "dietary supplements." While registrant's goods are specifically limited to dietary supplements which consist of "flower essences and plant essences, prepared from plant infusions in water ... [which are] generally preserved with brandy ... for personal dietary use," applicant's goods, given their broad identification as "dietary supplements," are deemed to encompass registrant's goods. The customers and channels of trade for applicant's and registrant's goods are consequently the same, irrespective of whether, as asserted by applicant in its brief, registrant "markets its goods using minimal advertising and only one distribution method (online orders) and thus targets a limited segment of the marketplace for dietary supplements. Moreover, because--as identified in the application and cited registration--neither applicant's dietary supplements nor those of registrant contain any limitation as to classes of purchasers thereof and/or channels of trade therefor, such goods must be regarded, as the Examining Attorney properly notes in his brief, as being "marketed to the same type[s] of ... consumers without restrictions" and "available to all consumers" through "the same section[s] of pharmacies, grocery and specialty vitamin/supplement stores" as well as the Internet. Furthermore, because nothing in the identifications of the respective goods serves to indicate particular price points for such products,

applicant's and registrant's dietary supplements must be deemed to include relatively inexpensively priced goods.

Applicant argues, however, that "both parties' products lie within niche markets rather than mainstream markets" and that "therefore, customers will be more sophisticated and not prone to 'impulse buying.'" According to applicant, the related *du Pont* factor of the conditions under which and buyers to whom sales of the goods at issue are made, that is, "impulse" purchasers versus those who are careful and sophisticated in their purchasing decisions, is a factor which mitigates any likelihood of confusion because, notwithstanding the identity of the respective goods in this case:

An overwhelmingly high percentage of purchases of various health and supplement products are made only after extremely careful examination of product labeling information. As a result, customers will be more likely to look for a specific goods provider, know where to look for that goods provider and know what specific products they are looking for.

Aside, however, from the fact that applicant does not refer to any evidence in the record to support its argument, the Examining Attorney notes that, as set forth in *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1204-05 (Fed. Cir. 2003), it is by no means clear that consumer brand loyalty would preclude a likelihood of confusion, especially in instances where similar marks are used in connection with identical and relatively inexpensive goods (*italics in original*):

[E]ven if ... "common experience" shows that consumers sometimes become attached to a particular brand ... after purchasing and consuming that brand at least once, that

would say little, if anything, about whether the consumer's *initial selection* of that brand was based on studied consideration and sophistication or, alternatively, on impulse. To be sure, a side-by-side comparison of the two products' labels would probably dispel the mistake for most consumers. It is doubtful, however, that such a comparison would be undertaken prior to purchase of ... relatively inexpensive products.

In addition, we observe that even if customers for dietary supplements are regarded as sophisticated and discriminating consumers who select the products they buy with care rather than on impulse, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. See, e.g., *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962); *In re Decombe*, 9 USPQ 1812, 1814-15 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983); and TMEP §1207.01(d)(vii). Clearly, in the case of identical goods, the more similar the marks at issue, the more likely confusion becomes even for discriminating and sophisticated customers. Thus, if applicant's and registrant's dietary supplements were to be marketed under the same or similar marks, confusion as to the source or sponsorship thereof would be likely to occur, notwithstanding the care and deliberation which knowledgeable and sophisticated consumers would be expected to exercise in selecting such products.

Turning, therefore, to consideration of the marks at issue, we note as a preliminary matter that as stated by our principal reviewing court in *Century 21 Real Estate Corp. v.*

Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994), "[w]hen marks would appear on virtually identical goods ..., the degree of similarity necessary to support a conclusion of likely confusion declines." Applicant argues in its brief, however, that confusion is not likely, notwithstanding that the respective goods are identical in legal contemplation, because the marks herein, "[w]hen viewed as a whole, ... are substantially different in appearance, sound and commercial impression." Applicant contends, in particular, that:⁵

The "EARTH ESSENCE NATURE BEAUTY HEALTH" and "LIVING EARTH ESSENCES" marks are very different in spelling, number of letters and words, and pronunciation. Appearance is also clearly different based on the existence of a prominent "stylized butterfly" design within Applicant's mark. Moreover, both the Applicant and the Registrant use distinctive and totally unrelated design structures to present their marks on their respective websites

Applicant also insists that the Examining Attorney "has not given sufficient weight to the registered trademarks, both before and after Registrant's registration date, that render weak all of Registrant's [mark's] elements. Specifically, referring

⁵ Applicant also asserts that it "has consistently used its stylized butterfly design mark on each label for each product[,], typically on the top half of the bottle label and generally at a size larger than the word mark." While applicant maintains that such manner of use serves "to remove any likelihood of confusion with Registrant's word mark LIVING EARTH ESSENCES," it is pointed out that it is the spacial arrangement of the design element and words in applicant's mark--as shown in the drawing thereof--which is considered in determining whether there is a likelihood of confusion with registrant's mark rather than variants thereof.

to exhibits enclosed for the first time with its appeal brief,⁶ applicant urges that (underlining in original):

[The] Examining Attorney argues that the "dominant" features of both marks are virtually identical, specifically, EARTH ESSENCE(S). The "dominant" features argument contradicts the PTO's decision on another trademark EARTH MOTHER ESSENCES (Registration # 2510791 attached ... as Exhibit B), ... registered before Registrant's mark, contains the same "dominant" features as Registrant's mark, namely EARTH ESSENCES. In that case, the PTO never made the same "dominant" features argument used here. Consequently, Registrant's mark was not rejected in light of EARTH MOTHER ESSENCES.

Another mark, LIVING FLOWER ESSENCES (Registration # 2706701 attached ... as Exhibit C) was ... registered after Registrant's mark. In that case, the existence of identical terms between it and Registrant's mark, namely LIVING ESSENCES, did not preclude registration of LIVING FLOWER ESSENCES.

The existence of registered marks containing all the terms in Registrant's mark, specifically LIVING, EARTH and ESSENCES, shows that these are weak terms commonly used ... in the market. See *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1409, 167 USPQ 529 (C.C.P.A. 1970). In this case, the market consists of health products derived from floral or plant essences, including skin care products, cosmetics, soaps, dietary supplements and perfumes.

We agree with the Examining Attorney, however, that when considered in their entirety, the marks at issue herein

⁶ While such exhibits are untimely under Trademark Rule 2.142(d), inasmuch as the Examining Attorney in his brief has not objected to their inclusion herein and has responded to applicant's arguments with respect thereto in his brief, we have treated the evidence as being of record for whatever probative value it may have. See *In re Nuclear Research Corp.*, 16 USPQ2d 1316, 1317 n. 2 (TTAB 1990).

are highly similar in that they are substantially identical in sound, appearance, meaning and commercial impression. In particular, we concur with the Examining Attorney that, in this regard, the dominant portion of applicant's "EARTH ESSENCE NATURE BEAUTY HEALTH" and design mark is the words "EARTH ESSENCE." This is because those words, rather than the descriptive terms "NATURE," "BEAUTY" and "HEALTH," would be used by consumers in looking for or otherwise asking about applicant's dietary supplements and those words are by far the most visually prominent of the literal elements of the mark, given their stylized font and appreciably larger size than the plain block letter format and the much smaller size of the other words, which also appear in a subordinate position beneath the entirety of the word "ESSENCE." While applicant is correct that it is improper to dissect a mark, it is well settled that one feature of a mark may be more significant than other features, and that it is proper to give greater force and effect to that dominant feature. See, e.g., Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983) [permissible to give greater force and effect to a dominant feature of a mark]; and In re Appetito Provisions Co. Inc., 3 USPQ2d 1553, 1554 (TTAB 1987) [where a mark consists of a word portion and a design portion, it is the word portion which is more likely to be impressed upon a purchaser's memory and to be used in calling for or inquiring about the associated good]. Moreover, although the Examining Attorney is obviously in error in reasoning that "[t]he dominant portion of applicant's mark is closely similar to the

registrant's mark *because it appropriates the registered mark*" (emphasis added), it is clear that the registrant's "LIVING EARTH ESSENCES" mark basically incorporates the dominant portion of applicant's mark (albeit in the plural rather than the singular) while merely adding thereto the suggestive term "LIVING."⁷

In view thereof, it is clear that contrary to applicant's arguments, the marks at issue are substantially similar in their significant, source-indicative literal portions, including spelling, number of letters and words, and pronunciation. Such marks are also substantially similar in meaning or connotation since, unlike the marks "PEAK" and "PEAK PERIOD" in the *Colgate-Palmolive* case, supra, upon which applicant principally relies, the presence of the word "LIVING" in registrant's mark does not serve to convey any significantly different meanings as did the addition of the term "PERIOD" with respect to the word "PEAK." Furthermore, although visually, registrant's mark does not include any design element identical or similar to what applicant refers to as "a prominent 'stylized butterfly' design within Applicant's mark," it is nonetheless the case that registrant's mark reasonably could be displayed in the same or substantially similar stylization as the lettering utilized in the "EARTH ESSENCE" portion of applicant's mark.

Specifically, it is pointed out that while the mark "LIVING EARTH ESSENCES" is registered in standard character or typed form, such format does not constitute a basis for finding

⁷ For trademark purposes, however, there is no material difference between the singular and the plural forms of a term. See, e.g., *Wilson v. Delaunay*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957).

applicant's mark to be distinguishable therefrom in appearance, given that the lettering used for the words "EARTH ESSENCE" in the latter "is not overly stylized." See, e.g., Phillips Petroleum Co. v. C. J. Webb, Inc. 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) [a mark registered in typed or standard character form is not limited to the depiction thereof in any special form]; and Jockey International Inc. v. Mallory & Church Corp., 25 USPQ2d 1233, 1235 (TTAB 1992) ["when a drawing in an application or registration depicts a word mark in typed capital letters, this Board--in deciding the issue of likelihood of confusion--'must consider all reasonable manners' in which the word mark could be depicted," *citing* INB National Bank v. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992)]. Thus, as stated by our principal reviewing court in Squirtco v. Tomy Corp., supra at 939 (*italics in original*):

[An] argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a *difference* cannot legally be asserted by that party. Thus, ... the displays must be considered the same.

As to applicant's contention that "both the Applicant and the Registrant use distinctive and totally unrelated design structures to present their marks on their respective websites," suffice it to say that the use of such "design structures" is irrelevant unless they constitute portions of the marks at issue. Websites, like product labels, moreover, may change at anytime. Accordingly, and in light of the substantial similarities noted

previously in sound, appearance and meaning, it is apparent that the respective marks overall engender substantially similar commercial impressions. The use, therefore, of such marks in connection with legally identical dietary supplements is likely to cause confusion as to source or sponsorship.

The two third-party registrations upon which applicant relies fail to persuade us otherwise. Among other things, as the Examining Attorney properly points out in his brief (footnote omitted):

Further, applicant's argument is without merit because it references registered marks that have portions of the parties' wording, encompassed with arbitrary designs[,] rendering a different commercial impression. Additionally, the registrations that applicant referenced are for totally unrelated goods, namely, cosmetic related products, while the herein parties' goods are dietary supplements. Further, even if applicant has shown that the cited mark is "weak," such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods or services. See *Hollister Inc.[.] v. Ident A Pet, Inc.*, 193 USPQ 439, 432 [sic; 442] (TTAB 1976)

Additionally, it is well established that in any event third-party registrations do not demonstrate use of the marks which are the subjects thereof in the marketplace or that the consuming public is familiar with the use of those marks and has learned to distinguish between them. See, e.g., *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973); and *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). Finally, as our principal reviewing court noted in *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d

1564, 1566 (Fed. Cir. 2001), "[e]ven if some prior registrations had some characteristics similar to [applicant's] application, the ... allowance of such prior registrations does not bind the Board or this court." See also, In re Broyhill Furniture Industries Inc., 60 USPQ2d 1511, 1514 (TTAB 2001); and In re Pennzoil Products Co., 20 USQP2d 1753, 1758 (TTAB 1991).

We consequently conclude that customers and prospective consumers who are familiar or acquainted with registrant's "LIVING EARTH ESSENCES" mark for "dietary supplements, namely, flower essences and plant essences, prepared from plant infusions in water, generally preserved with brandy, for personal dietary use," would be likely to believe, upon encountering applicant's substantially similar "EARTH ESSENCE NATURE BEAUTY HEALTH" and design mark for "dietary supplements," that such legally identical goods emanate from, or are sponsored by or associated with, the same source. In particular, even those customers and prospective consumers who happen to notice the so-called "stylized butterfly" design within applicant's mark could still believe that such mark, when used in connection with applicant's goods, constitutes a new or expanded line of dietary supplements from the same source as registrant's "LIVING EARTH ESSENCES" line of dietary supplements.

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