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Mailed:
August 28, 2006
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bare Escentuals, Inc.

Serial No. 76569932

Kimberly G. Russell for Bare Escentuals, Inc.

Carolyn V.C. Gray, Trademark Examining Attorney, Law Office
111 (Craig D. Taylor, Managing Attorney).

Before Quinn, Bucher and Kuhlke, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Bare Escentuals, Inc. seeks registration on the
Principal Register of the mark **WIDE AWAKE** for goods
identified in the application as follows:

"cosmetics, namely, eye shadow and mascara;
cosmetics for the skin and eyes; skin creams,
lotions and gels, essential oils used as
cosmetics" in International Class 3.¹

This case is now before the Board on appeal from the
final refusal of the Trademark Examining Attorney to
register applicant's mark based upon Section 2(d) of the

¹ Application Serial No. 76569932 was filed on January 14, 2004
based upon applicant's allegation of a *bona fide* intention to use
the mark in commerce.

Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney has found that applicant's mark, when used in connection with the identified goods, so resembles the following previously registered marks, all five registrations owned by the same entity:

AWAKE

for "cosmetics and cosmetic soaps, namely, lipsticks and lip colors, eye shadows, eye pencils, mascara, cleansing creams, and gels, lotions, liquid exfoliant/moisturizer, eye cream, facial masks, foundation makeups with and without sunscreen, and face powder" in International Class 3;²

AWAKE

for a "full line of cosmetic brushes and sponges" in International Class 21;³

² Registration No. 2129738 issued to KOSE Corporation, a Japanese corporation, on January 20, 1998 claiming use anywhere and use in commerce at least as early as October 18, 1996; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

³ Registration No. 2175649 issued to KOSE Corporation, a Japanese corporation, on July 21, 1998 claiming use anywhere and use in commerce at least as early as June 17, 1997; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.



for a "house mark for a line of cosmetics" in International Class 3;⁴

A W A K E

A W A K E

for a "house mark for a line of cosmetics" in International Class 3; and

for a "house mark for a line of cosmetic brushes and sponges" in International Class 21;⁵

⁴ Registration No. 2353917 issued to KOSE Corporation, a Japanese corporation, on May 30, 2000 claiming use anywhere and use in commerce at least as early as October 18, 1996. The mark is described as follows: "The mark consists of the term 'AWAKE' and a fanciful design comprised of a swirl design inside a solid rectangle. There are eight tear-drop shapes which run along the inside of the swirl." Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

⁵ Registration No. 2387449 issued to KOSE Corporation, a Japanese corporation, on September 19, 2000 claiming use anywhere and use in commerce at least as early as October 18, 1996 as to the goods in International Class 3 and claiming use anywhere and use in commerce at least as early as June 17, 1997 as to the goods in International Class 21; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.



for "cosmetic utensils, namely, cosmetic brushes and cosmetic sponges" in International Class 21.⁶

AWAKE

as to be likely to cause confusion, to cause mistake or to deceive.

Applicant and the Trademark Examining Attorney have fully briefed this appeal, but applicant did not request an oral hearing. We affirm the refusal to register.

Preliminary matter:

In its request for reconsideration, applicant argued that there were sufficient differences in the marks and in the marketing of the involved goods to make confusion unlikely, but offered, in the alternative, to amend its application to reflect the trade channels through which its goods are offered, i.e., " ... for distribution only directly from Applicant, in Applicant's retail stores, by certain

⁶ Registration No. 2591800 issued to KOSE Corporation, a Japanese corporation, on July 9, 2002 claiming use anywhere and use in commerce at least as early as June 17, 1997. The mark is described as follows: "The mark consists in [sic] the term 'AWAKE' and a fanciful design comprised of a swirl design inside a solid rectangle. There are eight tear-drop shapes which run along the inside of the swirl."

vendors that provide interactive retail services via computer, cable and satellite television and the Internet, by certain vendors that provide computerized on-line retail stores, and through selected beauty and skin care salons." In denying the request for reconsideration, the Trademark Examining Attorney stated that such a restriction would not obviate the likelihood of confusion, and therefore did not enter it into the record. In the last section of its appeal brief, applicant re-stated that "Applicant remains willing to amend the goods description in its Application to state that the covered items are sold only via direct purchases from Applicant, in Applicant's retail stores, via QVC and Sephora, and through selected spas and salons." The proposed, alternative identification of goods in this section of the appeal brief was exactly the same as that offered earlier in the request for reconsideration.

However, applicant is advised that once the Board renders a decision on appeal, the application may not be reopened (except on order by the Director, or to enter a disclaimer). See Trademark Rule 2.142(g). Therefore, applicant may not, in a single application, obtain a decision from the Board on the issue of likelihood of confusion based upon its current identification and then, if that decision is unfavorable, have the Trademark Examining

Attorney, and then ultimately the Board, decide the same issue of likelihood of confusion with respect to a more limited identification of goods. If applicant had wished the Board to consider the registrability of its mark with its identification limited as to trade channels, it should have amended its application accordingly during the course of the prosecution of the application.⁷ Accordingly, the issue of likelihood of confusion will be decided on the basis of the original (and operative) identification of goods: "cosmetics, namely, eye shadow and mascara; cosmetics for the skin and eyes; skin creams, lotions and gels, essential oils used as cosmetics."

Analysis: Likelihood of Confusion

This brings us to the substantive issue before us in this appeal: likelihood of confusion.

Applicant argues: that the cited marks differ from applicant's mark in appearance, sound and meaning; that the cited marks should be afforded a narrow scope of protection; that the cited marks coexist with third-party marks having

⁷ For example, after receiving the Examining Attorney's denial of its request for reconsideration, applicant could have requested that its identification be amended, and submitted such request with a request for remand. In that situation, if the Examining Attorney had found the proposed identification acceptable, but still maintained the refusal of registration, the issue of likelihood of confusion would have been briefed based on the new identification of goods, and the Board would have made its determination based on that more restrictive identification.

similar terms for cosmetics and related goods; that the circumstances surrounding the marketing of registrant's goods and applicant's goods differ; and that a high degree of consumer care is afforded registrant's and applicant's respective goods - such that a likelihood of confusion between the cited marks and applicant's mark is unlikely.

By contrast, the Trademark Examining Attorney argues that the respective marks are similar as to appearance, sound and commercial impression, and that the goods of applicant and registrant are identical, complementary and/or closely related.

Our determination under Section 2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relationship of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The goods

We turn first to the du Pont factor focusing on the relationship of the goods. We agree with the Trademark

Examining Attorney that these goods are identical (e.g., eye shadow, mascara, skin creams, lotions and gels), complementary (e.g., cosmetics for the skin and eyes with cosmetic brushes and sponges) and/or otherwise closely related (the remaining cosmetic items). This factor strongly favors the position of the Trademark Examining Attorney.

Channels of trade and types of consumers

It follows that given the fact we are faced with identical, complementary and/or otherwise closely-related goods, where neither registrant nor applicant has stated any express limitations, applicant's goods and registrant's goods will move in the same channels of trade.⁸ Neither identification is limited as to price, and so we must presume that the goods could include relatively inexpensive items that may well be purchased on impulse by the same classes of ordinary consumers. The record herein does not support applicant's contentions that a high degree of

⁸ We note that even if applicant's alternative amendment were an unequivocal part of the identification of goods herein, and we were to conclude that applicant's and registrant's respective goods would never be sold in the very same store, we find that they would still both be sold in the same types of retail stores, over the Internet, etc. Consumers already acquainted with registrant's cosmetics and utensils are likely to also encounter applicant's cosmetics, and would be likely to be confused in the event that the goods were being sold under confusingly similar marks.

consumer care will be afforded applicant's and registrant's goods. Accordingly, these related du Pont factors also favor the position taken by the Trademark Examining Attorney.

The marks

We turn next to the du Pont factor focusing on the similarity of the marks in their entirety. We must consider whether the marks are similar in sound, appearance, meaning, and commercial impression. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). Applicant argues that when viewed in their entirety, its mark and registrant's cited marks differ as to appearance, sound and meaning, resulting in significantly different commercial impressions.

As to the literal elements of registrant's cited marks, applicant is correct in noting that each of the five cited marks contains only two syllables while its mark contains three syllables. Hence, when considered as a whole, the pronunciation of these marks is different.

All five of the marks in the cited registrations contain the word "Awake" as their dominant element. Moreover, we find that the marks in Reg. Nos. 2129738 and

2175649 are the most similar to applicant's mark, consisting of just the word AWAKE in a standard character format.⁹

Because they are the most similar, we have chosen to focus primarily on these two marks in assessing the likelihood of confusion herein.

As to appearance, applicant argues as follows:

Applicant's mark is a composite word mark that consists of the two words "WIDE" and "AWAKE." In contrast, the Cited Marks each consist of the single term "AWAKE." Applicant's mark simply contains a term not present in the Cited Marks. ...

Because "Wide" is the first word of applicant's mark, it does create a somewhat different appearance for applicant's mark.

However, it is the matter of connotation where applicant and the Trademark Examining Attorney disagree most strongly. As to meaning, applicant argues that its mark is quite different from the cited marks:

The word "awake" is an adjective that means conscious rather than in a state of sleep. True and correct copies of pertinent pages of the Internet websites www.m-w.com and

⁹ As a consequence of these two of registrant's marks having been depicted as a standard character drawing, registrant's AWAKE marks may be displayed in any reasonable format. See *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585, 1588 (TTAB 1992), citing *Phillips Petroleum Co. v. C. J. Webb, Inc.* 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971).

"[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display ... Thus, ... the displays must be considered the same." *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983).

www.dictionary.reference.com, containing definitions of the word "awake," are attached as Composite Exhibit C hereto. As used by the Registrant, the term "AWAKE" connotes the awakening of the user of Registrant's goods to her own unseen beauty and hidden grace. The Cited Marks suggest a slow "unfurling" and blooming of the user. See Exhibit B hereto. The Cited Marks connote a gradual and gentle awakening of the user to her own beauty. This connotation is evidenced by and reinforced by the unfurling frond design element and the elemental nature of the stylization of the marks.

In contrast, the term "wide awake" is an idiom that means fully awake or very alert. The term "wide" as used in the idiomatic phrase alludes to the eyes being wide open. True and correct copies of pertinent pages of the Internet website www.m-w.com and www.dictionary.reference.com, containing definitions of the term "wide awake," are attached ... "WIDE AWAKE" connotes an alertness and awareness, suggesting that Applicant's goods will energize the user and enable the user to face anything that may come her way. Further, the term secondarily suggests that the use of Applicant's goods will give the user an enhanced, alert or "wide-eyed" appearance. The impression of being alert and ready to take on the world is entirely different from that of slowly and gently opening to one's beauty. The commercial impressions of the respective marks are distinctive and confusion as to source is unlikely.

Applicant's brief, p. 6. By contrast, the Examining Attorney argues, "the impression presented by applicant's proposed mark WIDE AWAKE is one of gradation from AWAKE."

We agree with applicant that "wide awake" alludes to one's eyes being wide open, and the term has a strong

connotation of being "fully awake" or "very alert."

However, applicant's own dictionary definitions for the word "awake" alone also contain an entry for "to become alert," and show that "alert" is actually a synonym for "awake." Hence, we agree with the Trademark Examining Attorney that both could well create the same connotation of alertness - at most, applicant's mark suggesting comparatively more alertness. Contrary to applicant's position, we find that this very similar connotation outweighs whatever dissimilarities may exist between the sound and appearance of the marks. When compared in their entireties, we find that applicant's mark creates a similar commercial impression to the marks in the cited registrations.¹⁰

The number and nature of similar marks

As to the du Pont factor focusing on the number and nature of similar marks in use on similar goods, applicant argues that "the term 'AWAKE' and its alternative forms 'AWAKEN' and 'AWAKENING' are used to imply that cosmetics make the user aware of her inner beauty, bring that beauty to the forefront and make it visible to the external world." Applicant contends that "many companies in the cosmetics

¹⁰ In limiting our discussion to Registration Nos. 2129738 and 2175649, we do not mean to imply that there is no likelihood of confusion between applicant's mark and the remaining cited registrations. On the contrary, we find that these marks are also confusingly similar.

industry wish to cloak their goods in such positive connotations." As a result, applicant argues that the term "Awake" is diluted in the cosmetics field, and the cited marks should be afforded only a narrow scope of protection.

AWAKEN SKIN THERAPY for "skin care products, namely skin cleansers, skin cleansing cream, skin cleansing lotion, skin conditioners, skin cream, skin emollients, skin gels, skin lighteners, skin masks, skin moisturizers, skin soap, skin texturizers, skin toners, and skin exfoliants" in Int. Cl. 3;¹¹

THE GREAT AWAKENING for "skin care and face cleansing preparations, namely, exfoliator" in International Class 3;¹²

AWAKEN YOUR SIXTH SENSE! for "eau du [sic] parfum, eau du [sic] toilette, cologne, bath oil, bath lotion, bath gel, men's shaving balm" in International Class 3;¹³

AWAKENING for "skin care and hair care products, namely, shampoo, lotion, creams, soap, masks, non-medicated bath salts, and sun block" in International Class 3;¹⁴

¹¹ Reg. No. 2894382 issued to John Decorato, a USA citizen, on October 19, 2004 claiming use anywhere and use in commerce since at least as early as December 2002; no claim is made as to the word "Skin" apart from the mark as shown.

¹² Registration No. 2285856 issued to philosophy, inc., an Arizona corporation, on October 12, 1999 claiming use anywhere and use in commerce since at least as early as January 15, 1998; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

¹³ Registration No. 2056375 issued to Erox Corporation on April 22, 1997 claiming use anywhere and use in commerce since at least as early as October 14, 1994; registration was later assigned to Human Pheromone Sciences, Inc., recorded with the assignment branch of the United States Patent and Trademark Office at Reel No. 2030, Frame No. 0387; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

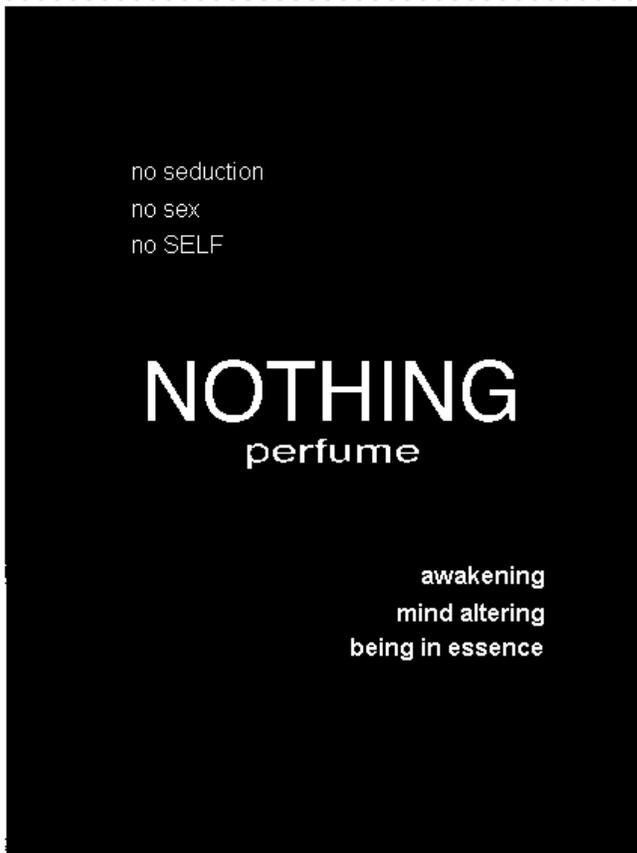
¹⁴ Registration No. 2273945 issued to Olim Industries of Israel, N.A. Ltd., a California corporation, on August 31, 1999 claiming use anywhere and use in commerce since at least as early as July

HAIKU AWAKENINGS

for "fragrance and toiletry products, namely, eau de parfum, shower gel, body lotion and body powder" in International Class 3;¹⁵

FRESH AWAKENINGS

for "bath gels; shower gels; hand lotions; and body lotions" in International Class 3;¹⁶



for "perfume oils, essential oils for personal use, natural perfume" in International Class 3;¹⁷

26, 1994; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

¹⁵ Registration No. 2837264 issued to Avon Products, Inc. on April 27, 2004 claiming use anywhere and use in commerce since at least as early as July 17, 2003.

¹⁶ Registration No. 2302368 issued to Jafra Cosmetics International, Inc., a Delaware corporation, on December 21, 1999 claiming use anywhere and use in commerce since at least as early as September 1, 1996; [no record of Section 8 having been filed].

¹⁷ Registration No. 2819687 issued to Michael Scott O'Malley, a Canadian citizen on March 2, 2004 claiming use anywhere at least as early as July 15, 1999 and use in commerce since at least as early as October 1, 2000; no claim is made as to the word "perfume" apart from the mark as shown.

In order to deal with any allegations on the part of the Office that registrations alone are not indication of whether the marks are actually used in commerce on the identified goods, applicant submitted copies of Internet websites showing that manufacturers and merchants are actually using these third-party marks in the marketplace for cosmetics:

<p>AWAKEN SKIN THERAPY</p> <p>johnw.decorato,m.d.,f.a.c.s. board certified plastic surgeon</p> <p>skin health & beauty</p> <p>non surgical treatments :: Gloria Cianj, M.A. :: Awaken Skin Therapy</p> <p>Introducing Awaken Skin Therapy® Over time, exposure to sunlight (tanning) will result in free radical formation with resulting damage to the skin. The adverse effects of sun damage can be prevented and in some cases reversed with proper antioxidant protection and treatment.</p> <p>Dr Decorato's new custom line, Awaken Skin Therapy®, is designed to correct the injuries to your skin as it improves both tone and texture.</p>  <p>18</p>	<p>THE GREAT AWAKENING</p> <p>QVC Homepage</p> <p>QVC QUALITY. VALUE. CONVENIENCE.</p>  <p>Inspired by the famous in-office medical procedure known as the micropeel, the great awakening skin rejuvenation kit helps bring radiance back to your skin. It's designed to oxygenate the skin surface; exfoliate; and make your complexion smooth, clean, and refreshed.</p> <p>19</p>
<p>THE GREAT AWAKENING</p> <p>NORDSTROM</p>	<p>AWAKENING</p> 

18 <http://www.drdecorato.com/skinhealth03.htm>

19 <http://www.qvc.com>

20 <http://www.nordstrom.com>



philosophy Peel Kit

A peel, or rapid exfoliation of the skin, is indicated for fine lines, uneven skin tone, congested pores, acne and general environmental damage. Regular in-home peels can help to buffer fine lines, minimize enlarged pores, improve skin texture and help keep your skin radiantly clear. Our peel kit includes **The Great Awakening** (10 enzyme capsules) and jar of Oxygen Cream (2 oz.) for a total of 10 treatments.
 - By philosophy; made in the USA. ²⁰

About Olim

Olim Industries offers a superior line of natural skin care products under its registered trademark "Awakening". The Awakening line includes world-class skin therapies, hand treatments, body lotions, massage creams, foot balms, facial masques, mineral crystals and patented formulations for scalp and hair health. Olim was formed in 1994 and markets its Awakening skin therapy products in North America and internationally.

The Awakening Credo All AWAKENING products are formulated from the highest quality natural ingredients, including pure mineral crystals, essential oils and botanical extracts. No AWAKENING product is ever tested on an animal. We are so confident that you will be satisfied with every AWAKENING product that we guarantee all sales. If you are ever dissatisfied with any of our products, we shall refund 100% of the price you paid. AWAKENING products are sold through discriminating retailers, catalogs, health practitioners, clinics and spas who understand the merits and unique benefits of Olim's natural skin therapies. ²¹

HAIKU AWAKENINGS

- 1  **HAIKU Awakenings Eau de Parfum Spray**
A watery-green floral of jasmine, freesia, and soft musk. 1.7 fl. oz....
- 2  **Haiku Awakenings Calming Shower Gel with Moisturizing Bath Beads**
Moisturizing shower gel scented with floral of jasmine, freesia, and soft musk gives the day a soft, luxurious start. 6.7 fl. oz....
- 3  **Haiku Awakenings Calming Body Lotion**
Commit to a day of luxury, with a few dabs of moisture, scented with freesia, jasmine, and soft musk. 6.7 fl. oz....
- 4  **Haiku Awakenings Harmonious Gift Set**
The harmonious blend of jasmine, freesia, and soft musk, makes it a fragrance no beauty should be without. The boxed collection includes: Eau de Parfum spray (.5 fl. oz.); Body Lotion (3.4 fl. oz.); S...

²²

AWAKEN YOUR SIXTH SENSE!



²³

However, we do not find these third-party uses to be all that persuasive. Although applicant has clearly buttressed the registrations with Internet evidence of extant use, there is no corroborating evidence to show the extent of that use. In addition, in the vast industry of cosmetics, this handful of third-party uses cannot serve to

²¹ <http://www.e-awakening.com/products/products.html>
²² <http://shop.avon.com/avonshop/>
²³ <http://www.naturalattraction.com/>

significantly diminish the scope of protection of registrant's marks for identical goods.

Furthermore, we find that none of these third-party uses is as close to the registered marks as is applicant's mark. These registrations and matching Internet uses are all for other forms of the word "awake," namely, "awaken," "awakening" and "awakenings." Accordingly, we find that the record is devoid of any AWAKE marks other than registrant's marks. Accordingly, these third-party uses cannot support a limited zone of protection for registrant's marks.

Conclusion

While there are some differences as to sound and appearance when comparing applicant's mark to registrant's marks, we find that the connotation and commercial impression of applicant's **WIDE AWAKE** mark are similar enough to the connotation and commercial impression of registrant's cited **AWAKE** marks to support a finding of likelihood of confusion herein. The involved goods are identical, complementary and closely related, and all presumably move through similar channels of trade. These relatively inexpensive products are purchased by ordinary consumers without extraordinary levels of care. We disagree with applicant's contention that it has demonstrated that

the word "Awake" is not particularly strong as applied to cosmetic products. Accordingly, we find that there will be a likelihood of confusion in this case. Finally, to the extent that any of applicant's points raise a doubt about our conclusion, we must resolve any such doubt in favor of registrant.

Decision: The refusal to register under Section 2(d) of the Lanham Act is hereby affirmed.