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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Avon Products, Inc.

Serial No. 78461231

Michelle M. Graham of Kelley Drye & Warren LLP for Avon Products, Inc.

Timothy J. Finnegan, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

Before Quinn, Bucher, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On August 3, 2004, Avon Products, Inc. (applicant) applied to register the mark HEALTHY BOOST (in standard character form) on the Principal Register for "skin moisturizing lotion" in Class 3.¹ The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of a

¹ Serial No. 78461231. The application is based on applicant's allegation of a bona fide intention to use the mark in commerce. The application has been amended to include a disclaimer of the word "Healthy."

Ser No. 78461231

registration (No. 2,380,248 issued August 29, 2000) for the mark BOOST, in typed or standard character form, for "skin care preparations, namely, sun tanning lotions, creams and oils" in Class 3.

Before we discuss the merits of the case, we must first address some procedural and evidentiary issues. On March 9, 2005, the examining attorney issued a first Office action by email indicating that a search of the Office records did not reveal any similar registered or pending mark that would bar registration. The Office action then required applicant to disclaim the term "Healthy." The Office action set a six-month response date. Two days later, on March 11, 2005, the examining attorney sent a second Office action with another six-month response date. This Office action began by advising applicant that the "examining attorney refuses registration" because applicant's mark resembles Registration No. 2,380,238. The second Office action did not address the disclaimer requirement or mention the first Office action or the response period associated with that Office action.

On March 18, 2005, applicant responded by providing a disclaimer of the term "Healthy," but it did not address the likelihood of confusion issue. On April 13, 2005, the examining attorney acknowledged the disclaimer of the term

"Healthy" and made the refusal to register under Section 2(d) a final refusal and noted that applicant did not respond to the likelihood of confusion refusal.

On October 21, 2005, applicant filed an appeal brief (pp. 2-3 (citations to record omitted)) in which it complained:

Two days later, on March 11, 2005, the Examiner issued a second Office Action via e-mail which contained no introductory, explanatory or other clause which would call attention to the fact that he belatedly raised a Section 2(d) refusal.

Because the examiner sent the March 11th Office Action so quickly after sending the March 9th Office Action, and there was no header or other device on the e-mail containing the March 11th Office Action to necessarily alert Applicant as to the existence of the newly raised Section 2(d) refusal, Applicant reasonably believed the March 11th Office Action to be merely a duplicate of the March 9th Office Action...

However, on April 13, 2005, the Examiner issued yet another Office Action, making the Section 2(d) refusal final, although Applicant had not even had an opportunity to present argument in response to the initial 2(d) refusal.²

The examining attorney responded by arguing that he "issued a corrective action two days after sending the first action in which he clearly explained why the Section

² Applicant's brief included as an attachment a declaration of its "Assistant Manager - Trademarks" that supported the factual statements made in the brief regarding the receipt of the Office actions.

2(d) refusal was necessary." Brief at 3 n.1 (emphasis in original).³

In its appeal brief, applicant then set out for the first time a list of registrations that it owned that contained the words BOOST or BOOSTER with some relevant information and a list of third-party registrations that contain the word BOOST. The examining attorney "objects to the applicant's reference to third party registrations with its appeal brief, which were never properly made of record." Brief at 1. In its Reply Brief, applicant provided copies of these registrations and argues that "because of the Examiner's own belated issuance of a Section 2(d) objection, and the resulting confusion stemming therefrom, Applicant never had a chance to respond to that objection or to introduce evidence of third-party registrations in support of its argument as its time to respond to the Examiner's follow-up office action was cut off by the issuance of the final refusal." Reply Brief at 3.⁴ As an alternative, applicant in its Reply Brief at 1-2

³ We clarify the examining attorney's statement by noting that the second Office action contained standard language that accompanies a likelihood of confusion refusal. As we indicated earlier, it did not address the fact that there was another outstanding Office action at the time of the issuance of the second Office action.

⁴ Applicant does not explain why it did not file a request for reconsideration in which it could have submitted evidence for the first time. TBMP § 1204 (2d ed. rev. 2004) ("During the period

requests the application be remanded to introduce "evidence of third-party registrations and other evidence into the prosecution record and seek to amend the description of goods associated with the instant application."⁵

Because of the issuance of two seemingly independent Office actions two days apart, applicant had two different response periods. Also, we cannot discount applicant's argument that it assumed that the second Office action was simply an inadvertent duplicate of the first Office action. The Trademark Manual of Examining Procedure sets forth the proper procedure for issuing a supplemental Office action:

If the examining attorney issues a supplemental Office action, a new six-month response period will begin running from the mailing date of the supplemental action. 15 U.S.C. § 1062(b). In a supplemental Office action, the examining attorney should indicate that the action is supplemental to the previous action, and should incorporate all outstanding issues by reference to the previous action. The examining attorney should also include the standard six-month response clause.

TMEP § 711.02 (4th ed. rev. April 2005).

As a result of the confusion created during the prosecution of the application, we now address the issue of

between issuance of a final action and expiration of the time for filing an appeal therefrom, an applicant may file a request for reconsideration, with or without an amendment and/or new evidence").

⁵ To the extent that applicant in its reply brief seeks a remand to amend its identification of goods, it has not shown good cause for a remand at this late date. TBMP § 1209.04 (2d ed. rev. 2004).

what evidence is before us. First, applicant has submitted evidence that consists of other registrations that it owns. The examining attorney has limited his objection to "third party registrations." Brief at 1. Inasmuch as the examining attorney has mentioned applicant's evidence in its brief, but limited his objection to only some of applicant's evidence, we deem that any objection to applicant's own registrations has been waived. Accord TBMP 1207.03 (2d ed. rev. 2004). Furthermore, we note that there is no requirement for an applicant to submit copies of its own registrations before they can be considered by the Office. See, e.g., TMEP § 812 ("The rule does not precisely define when an applicant should claim ownership of prior registration(s), and the examining attorney may exercise discretion in invoking the rule... The information does not have to be given in any specific form) and § 812.01 ("If an applicant includes a claim of ownership of a prior registration in the application as filed, the examining attorney should accept the claim without further proof of ownership..."). See also 37 CFR § 2.36. Therefore, we will consider applicant's information regarding its ownership of other registrations.⁶ These registrations

⁶ The examining attorney will need to determine if this information will be marked for printing.

Ser No. 78461231

include No. 2,855,169 (BOOST ME UP for facial skin cream), No. 2,674,839 (MULTI-BOOST for facial moisturizing cream), No. 2,809,298 (DETOXIFYING BOOSTER, "Detoxifying" disclaimed, for facial skin lotion and cream and facial skin toner); No. 2,641,099 (SOOTHING BOOSTER for facial skin lotion and facial toner); No. 2,738,942 (RETEXTURIZING BOOSTER, "Retexturizing" disclaimed, for facial skin lotion and cream and facial skin toner), No. 2,720,075 (HYDRATING BOOSTER, "Hydrating" disclaimed, for facial skin lotion and cream and facial skin lotion), and No. 2,644,600 (EQUALIZING BOOSTER for skin lotion and facial skin toner).

Regarding the information concerning third-party registrations included in applicant's opening brief, we overrule the examining attorney's objection. While applicant could have taken other steps to submit the evidence including filing a request for reconsideration, in order to make it clear that applicant had at least one opportunity to submit evidence in response to the initial likelihood of confusion refusal, we will consider the information submitted in the brief. We add that "third party registrations are of use only if they tend to demonstrate that a mark or a portion thereof is suggestive or descriptive of certain goods and hence is entitled to a narrow scope of protection," In re J.M. Originals Inc., 6

USPQ2d 1393, 1394 (TTAB 1987). Regarding the "strength of a mark, however, registration evidence may not be given any weight." Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (emphasis in original).⁷

Having resolved these initial issues, we now address the main issue in this appeal, the likelihood of confusion. In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he 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." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We first look at the marks at issue in this case to determine their similarities and dissimilarities of the

⁷ We will not, however, consider the copies of the registrations that applicant did not submit until its reply brief.

marks in the application and registration. Both marks are in typed or standard character form. Applicant's mark is HEALTHY BOOST and the cited registration is for the mark BOOST. The marks are similar to the extent that both marks contain the same word BOOST and they differ because applicant adds the disclaimed word HEALTHY to its mark. Regarding the term "Boost," we add that the term is defined as "to increase; raise." *The Random House Dictionary of the English Language (unabridged)* (2d ed. 1987).⁸ The term when applied to sun tanning lotion and skin moisturizing lotion would have a suggestive connotation to the extent that it suggests that products will provide increased efficiency concerning sun tanning and moisturizing protection. Indeed, one of the third-party registrations disclaims the word "Boost," which would indicate that the term may have a descriptive meaning. See Reg. No. 3,005,995 (BLOW OUT THERMAL BODY BOOST, "Body Boost" disclaimed, for hair care products, namely, lotions).

Next, we must consider whether the goods of the parties are related. Applicant's goods are skin moisturizing lotions and registrant's goods are sun tanning

⁸ We take judicial notice of this definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

lotions, creams and oils. The examining attorney cites to Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc. as support for his argument that the goods are related. 204 USPQ 144 (TTAB 1979). In that case, the board did find that suntan preparations and cosmetic skin lotions were closely related. The board further concluded that the marks HULA TAN and HULA HAND, when used on these goods, were confusingly similar. We note that in that case, the word HULA "has no obvious meaning as applied to the respective goods of the parties." Id. at 148. The same cannot be said for the marks in this case, in which the term "BOOST" is suggestive when applied to the goods. Furthermore, we have no other evidence in this case showing that the goods are closely related.

Based on a comparison of the marks, the differences in the goods, and the limited record we have in this case, we conclude that there is no likelihood of confusion here. See Champagne Louis Roederer S.A. v. Delicato Vineyards, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998) ("CRISTAL and CRYSTAL CREEK evoke very different images in the minds of relevant consumers"). While it is possible that some consumers may believe that there is an association between the marks, the "statute refers to likelihood, not the mere possibility, of confusion."

Ser No. 78461231

Bongrain International (American) Corp. v. Delice de France, Inc., 811 F.2d 1479, 1 USPQ2d 1775, 1779 (Fed. Cir. 1987).

Decision: The examining attorney's refusal to register applicant's mark under Section 2(d) of the Trademark Act is reversed.