

U.S. APPLICATION SERIAL NO. 87160838

MARK: NBC BEAUTILAB

CORRESPONDENT ADDRESS:

CHANGI WU
CHANGI WU LAW OFFICE
53 JERSEY AVE
EDISON, NJ 08820

87160838

CLICK HERE TO RESPOND TO THIS LETTER:

http://www.uspto.gov/trademarks/teas/response_forms.jsp

[VIEW YOUR APPLICATION FILE](#)

APPLICANT: VAL USA MANUFACTURER, INC.

CORRESPONDENT’S REFERENCE/DOCKET NO:

CWUTM16VAL05

CORRESPONDENT E-MAIL ADDRESS:

newjerseylaw@hotmail.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT’S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT’S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW. A RESPONSE TRANSMITTED THROUGH THE TRADEMARK ELECTRONIC APPLICATION SYSTEM (TEAS) MUST BE RECEIVED BEFORE MIDNIGHT **EASTERN TIME** OF THE LAST DAY OF THE RESPONSE PERIOD.

ISSUE/MAILING DATE: **9/6/2017**

On February 3, 2017, action on this application was suspended pending the disposition of U.S. Application Serial No. 87160838. The referenced prior-pending application has since registered. Therefore, registration is refused as follows.

REFUSAL CONTINUED AND MAINTAINED: The following refusal is maintained and continued:

- Section 2(d) Refusal Pertaining To U.S. Registration Nos. 4726298, 4554535, and 3735306.

SUMMARY OF ISSUES:

- Section 2(d) Refusal – Likelihood of Confusion

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 5225666. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the attached registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by-case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods. See *In re Vittera Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin’s Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Comparison of Marks

Applicant seeks registration for “NBC BEAUTILAB”. U.S. Registration Nos. 5225666 is for “BEAUTYLAB BLACK DIAMOND.”

Marks are compared in their entirety for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Profls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

When comparing marks, the test is not whether the marks can be distinguished in 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 services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Bay State Brewing Co.*, 117 USPQ2d at 1960 (citing *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)); *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015) (citing *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013)); TMEP §1207.01(b).

In the present case, both marks contain the phonetically identical wording, BEAUTILAB or BEAUTYLAB. Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. See *Crocker Nat’l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff’d sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat’l Ass’n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii).

Moreover, the dominant element of the registrant mark is phonetically identical to part of the applicant’s mark. Although marks are compared in their entirety, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Vittera Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Matter that is descriptive of or generic for a party’s goods is typically less significant or less dominant in relation to other wording in a mark. See *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824-25 (TTAB 2015) (citing *In re Chatam Int’l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004)).

In the present case, the attached evidence shows that the wording BLACK DIAMOND in the registered mark is merely descriptive of or generic for the registrant’s goods. Thus, this wording is less significant in terms of affecting the mark’s commercial impression, and renders the wording BEAUTYLAB the more dominant element of the mark.

Comparison of Goods

Applicant seeks registration for “Beauty gels; Nail gel; Nail polish; Nail polish base coat; Nail polish top coat; Nail care kits comprising nail polish; Gels for cosmetic purposes” within Class 03

U.S. Registration No. 4726298 is for in relevant part, “Retail store services featuring after shave moisturizing cream, cosmetic after-sun gels, age spot reducing creams, alcoholic solvents in the nature of cleaning preparations, anti-aging creams, anti-wrinkle cream, aroma therapy creams, artificial tanning preparations, auto-tanning creams, baby oils, base cream, bath oil, beauty masks, body cream, body mask cream, body masks, body oil, body oil spray, body scrub, body scrubs, skin bronzers, skin creams, cleaning compositions for spot removal, cosmetics for bronzing the skin, cosmetics for the treatment of dry skin, cream for whitening the skin, creams for cellulite reduction, creams for tanning the skin, cuticle cream, depilatories, essential oils for personal use, ethereal oils, exfoliant skin creams, non-medicated face cream, facial cleansers, facial cream, facial masks, facial scrubs, cosmetic facial toners, cosmetic facial washes, hair cream, hair removing cream, hand cleansers, hand washes, lip balm, lip cream, lip gloss, lip polisher, lipstick, lotions for cellulite reduction, make-up foundations, massage oil, moisturizing creams, nail cream, nail gel, nail strengtheners, non-medicated diaper rash cream, night skin cream, non-medicated foot cream, non-medicated scalp treatment cream, perfumed soap, preservative creams for leather, non-medicated scalp treatments, scouring solutions, shaving cream, skin cleansers, skin cleansing cream, skin toners, soap, spot remover, cosmetic sun barriers, cosmetic sun blocking lipsticks, cosmetic sun blocking lipsticks, sun bronzers, sun tan lotion, sun tan oil, sun-block lotions, sun-tanning oils, sun-tanning preparations, tanning creams, cosmetic tanning gels, toiletries and skin care preparations, washing creams, washing preparations for personal use, waterless soap, wipes impregnated with a skin cleanser, non-medicated wrinkle resistant cream, non-medicated soaps, perfumery, aroma therapy oils, essential oils and essential oil blends, cosmetics, anti-perspirants and deodorants, talcum powder, potpourri, bath salts, bubble bath and other bathroom products in the nature of shampoo, conditioners, shower gel, bubble bath, bath salts, soap and liquid soap; pharmaceutical acne cleansers, pharmaceutical acne creams, medicated anti-bacterial face washes, antiseptic cleansers, medicated creams for application after exposure to the sun, medicated creams for the lips, crystals for medical therapeutic purposes for the treatment of uneven skin surface texture, medicated face cream, medicated face scrubs, medicated foot creams, medicated skin care creams, medicated lip balm, medicinal oils for use in medicated skin creams, lotions and oil blends for face, skin and body, medicated night skin creams, pharmaceutical creams for the treatment of acne, blemishes, uneven skin tone and dermatitis, pharmaceutical lip salves, medicated protective creams for the treatment of dry and dehydrated skin, sanitizing wipes, medicated scalp treatments, scrub preparations for medical use, skin care creams for medical use, therapeutic medicated bath preparations, vaginal washes, disinfectant washes, dietary, food, herbal, nutritional and health supplements, medical apparatus for the therapeutic stimulation of the body for physical therapy purposes, namely, treating sagging muscles in the neck, legs, arms and abdomen, uneven skin texture, back and neck pain and abdominal fat; apparatus for the therapeutic stimulation of the muscles for medical use; bio-therapeutic facial masks for medical use; therapeutic body toner apparatus for medical use; face masks for medical use; gas laser apparatus for medical treatment; high frequency electromagnetic therapy apparatus for medical use; hot air therapeutic apparatus for medical use; heat therapy medical apparatus for medical treatment of sagging muscles in the neck, legs, arms and abdomen, uneven skin texture, back and neck pain and abdominal fat; magnets for medical therapeutic use; medical skin abraders; medical therapy instruments, namely, devices for treating skin conditions and providing aesthetic skin treatments; static electric medical therapy apparatus; therapeutic apparatus for use in medical massage; therapeutic devices for the removal of hair for medical use; visible light treatment instruments for medical use in treating skin conditions and providing aesthetic skin treatments; water therapy apparatus for medical use in treating skin conditions and providing aesthetic skin treatments; water treatment apparatus for medical use in treating skin conditions and providing aesthetic skin treatments; parts and fittings for all the aforesaid goods” in International Class 35.

U.S. Registration No. 3735306 is for in relevant part, “retail store services featuring cosmetics, hair care, skin care and nail care products, body and beauty products, fragranced and aromatherapy products and hair and beauty accessories; on-line retail store services featuring cosmetics, hair care, skin care and nail care products, body and beauty products, fragranced and aromatherapy products and hair and beauty accessories” International Class 35.

U.S. Registration No. 4554535 is for in relevant part “aftershave moisturizing cream, after-sun gels, age spot reducing creams, alcoholic solvents in the nature of cleaning preparations, anti-aging creams, anti-wrinkle cream, non-medicated skin creams with essential oils for use in aromatherapy, artificial sun tanning preparations, self-tanning creams, baby oils, foundation cream, bath oil, beauty masks, body cream, body mask cream, body masks, body oil, body oil spray, body scrub, skin bronzers, skin creams, cleaning compositions in the nature of spot remover, cosmetics, cosmetics for bronzing the skin, moisturizing preparations for the skin, cream for whitening the skin, creams for cellulite reduction, creams for tanning the skin, cuticle cream, depilatories, essential oils for personal use, ethereal oils, exfoliant creams, non-medicated face cream, facial cleansers, facial cream, facial masks, facial scrubs, facial toners, facial washes, hair cream, hair removing cream, hand cleansers, non-medicated hand washes, lip balm, lip cream, lip gloss, lip polisher, lipstick, lotions for cellulite reduction, make-up foundations, massage oil, moisturizing creams, nail cream, nail gel, nail strengtheners, non-medicated diaper rash cream, night cream, non-medicated foot cream, non-medicated scalp treatment cream, perfumed soap, preservative creams for leather, non-medicated cosmetic preparations for the scalp, scouring solutions, shaving cream, skin cleansers, skin cleansing cream, skin toners, soap, spot remover, sun block, sun blocking lipsticks, skin bronzers, sun tan lotion, sun tan oil, sun-block lotions, sun-tanning oils, sun-tanning preparations, tanning creams, tanning gels, non-medicated toiletries and non-medicated skin care preparations, body cream for use when washing the body, cleaning and washing preparations for personal use, waterless soap, wipes impregnated with a skin cleanser, wrinkle resistant cream, non-medicated soaps, perfumery, essential oils for use in aromatherapy, essential oils and essential oils blends, cosmetics, anti-perspirants and deodorants, talcum powder; potpourri; bath salts, bubble bath and bath beads in International Class 03.

Comparison to U.S. Registration Nos. 4726298 and 3735306

The use of similar marks on or in connection with both products and retail-store services has been held likely to cause confusion where the evidence showed that the retail-store services featured the same type of products. See *In re House Beer, LLC*, 114 USPQ2d 1073, 1078 (TTAB 2015) (holding the use of identical marks for beer and for retail store services featuring beer likely to cause confusion); *In re Thomas*, 79 USPQ2d 1021, 1023 (TTAB 2006) (holding the use of similar marks for jewelry and for retail-jewelry and mineral-store services likely to cause confusion); *In re Peebles, Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992) (holding the use of nearly identical marks for coats and for retail outlets featuring camping and mountain climbing equipment, including coats, likely to cause confusion, noting that “there is no question that store services and the goods which may be sold in that store are related goods and services for the purpose of determining likelihood of confusion”); TMEP §1207.01(a)(ii).

The attached Internet evidence consists of excerpts from retail stores using the same mark for various nail care items and for retail services featuring nail care items, namely, Essie, <http://www.essie.com/>, Sally Hansen, <http://ca.sallyhansen.com/>, and Ciate London, <http://us.ciatelondon.com/collection>. This evidence establishes that the same entity commonly manufactures and provides the relevant goods and/or services and markets the goods and/or services under the same mark. Therefore, applicant’s and registrant’s goods and/or services are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Comparison to U.S. Registration No. 4554535

With respect to applicant’s and registrant’s goods, the question of likelihood of confusion is determined based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Absent restrictions in an application and/or registration, the identified goods are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Vittera Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. See, e.g., *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015); *In re N.A.D., Inc.*, 57 USPQ2d 1872, 1874 (TTAB 2000).

In this case, the identification set forth in the application and registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods travel in all normal channels of trade, and are available to the same class of purchasers. Further, the application uses broad wording to describe the goods and this wording is presumed to encompass all goods of the type described, including those in registrant’s more narrow identification.

Conclusion

The overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

RESPONSE GUIDELINES

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant’s rights. See TMEP §§705.02, 709.06.

To expedite prosecution of the application, applicant is encouraged to file its response to this Office action online via the Trademark Electronic Application System (TEAS), which is available at <http://www.uspto.gov/trademarks/teas/index.jsp>. If applicant has technical questions about the TEAS response to Office action form, applicant can review the electronic filing tips available online at http://www.uspto.gov/trademarks/teas/e-filing_tips.jsp and e-mail technical questions to TEAS@uspto.gov.

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. See 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$125 per class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner’s amendment by telephone or e-mail without incurring this additional fee.

/Kara E. Jackson/
Kara E. Jackson
Examining Attorney
Law Office 120
(571)272-4358
Kara.Jackson@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For technical assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action by e-mail, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.