

<<<Date>>>

FILED ELECTRONICALLY VIA TEAS

Letter of Protest  
ATTN: Deputy Commissioner for Trademark Examination Policy  
600 Dulany Street  
Alexandria, VA 22314-5793

**RE:** Letter of Protest Regarding Serial Number <<<Application Serial Number>>>

Dear Sir/Madam:

Please accept this correspondence as a Letter of Protest (“Letter”) objecting to the attempt by <<<Applicant>>> to register the trademark <<<APPLICANT’S TRADEMARK>>> in the United States (Application Serial No. <<<Application Serial Number>>>).

As contemplated by TMEP §1715.02, I note that this Letter is being timely filed prior to the Trademark Office’s Publication for Opposition of the aforementioned application.

15 U.S.C. §1052(d) prohibits the registration of trademarks that, as used on or in connection with the specified goods or services, so resemble a mark as to be likely to cause confusion. The basic principle in determining confusion between marks is that marks must be compared in their entirety and must be considered in connection with the particular goods or services for which they are used. *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985).

I wish to alert the Trademark Office that the registration of the instant mark in connection with the applied-for products so resembles the marks of <<<Protestor>>> as to be likely to cause confusion should the instant mark be permitted to register.

**<<<Protestor>>>’s Trademark(s)**

On <<<Date of Protestor’s Filing>>> <<<Protestor>>> filed a Federal Trademark Application for the mark <<<Protestor’s Trademark>>> use in connection with the following goods: “<<<Protestor’s Goods or Services>>>.” <<<Protestor>>>’s Application was assigned Serial No. <<<Protestor’s Serial Number>>>. <<<Protestor>>> has continuously used their mark <<<Protestor’s Trademark>>> in connection with the aforementioned goods or services since as early as <<<Protestor’s Date of First Use>>>.

In sum, based upon the foregoing, <<<Protestor>>> submits that it retains significant rights in regard to the marks <<<Protestor's Trademark>>> and <<<Protestor's Trademark>>> but also the right to exclude others from entering the industry using proposed trademarks which would create a likelihood of confusion with their marks.

### <<<Applicant>>>'s Application for <<<APPLICANT'S TRADEMARK>>>

On or about <<<Applicant's Filing Date>>> <<<Applicant>>> filed an application to register the mark <<<APPLICANT'S TRADEMARK>>> for use in connection with the following goods and services: <<<Applicant's Goods or Services>>>. <<<Applicant>>>'s Federal Trademark Application received Serial No. <<<Application Serial Number>>>.

<<<Applicant>>>'s Application has yet to be initially examined by the USPTO. As such, the instant *Letter of Protest* has been timely filed.

### The DuPont Factors

In *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the Court of Customs and Patent Appeals discussed the factors relevant to a determination of likelihood of confusion. In *ex parte* examination, the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services.

In assessing the relatedness of the goods, the more similar the marks at issue, the less similar the goods or services need to be to cause a likelihood of confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). If the marks of the respective parties are identical, the relationship between the goods or services need not be as close to support a finding of likelihood of confusion as would be required in a case where there are differences between the marks. *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981).

The relevant *DuPont* factors in this matter are:

- a) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
- b) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; and
- c) the similarity or dissimilarity of established, likely-to-continue trade channels.

### The Goods and Services Are Closely Related

In the instant matter, there is an overlap and a relatedness of the goods and services as both parties' marks are used in connection with cosmetics. The goods or services being related or even competitive determine that there is a likelihood of confusion. The issue is not whether the goods will be confused with each other, but rather whether the public will be confused about their source. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975). It is sufficient that the goods or services of the parties are so related that the circumstances surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that would give rise to the mistaken belief that they originate from the same source. *See, e.g., On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080,

56 USPQ2d 1471 (Fed. Cir. 2000) (ON-LINE TODAY for Internet connection services held likely to be confused with ONLINE TODAY for Internet content); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984) (MARTIN'S for wheat bran and honey bread held likely to be confused with MARTIN'S for cheese); *In re Toshiba Medical Systems Corp.*, 91 USPQ2d 1266 (TTAB 2009) (VANTAGE TITAN for MRI diagnostic equipment held likely to be confused with TITAN for medical ultrasound device); *L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883 (TTAB 2008) (ENYCE for custom automotive accessories held likely to be confused with ENYCE for various clothing items and accessories directed to the urban lifestyle market); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM for a buffered solution equilibrated to yield predetermined dissolved gas values in a blood gas analyzer held likely to be confused with CONFIRMCELLS for diagnostic blood reagents for laboratory use); *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984) (LAREDO for land vehicles and structural parts therefor held likely to be confused with LAREDO for pneumatic tires).

As the foregoing indicates, both parties use their marks or intend to use their respective marks in connection with similar if not identical products and are therefore sufficiently related to be provided, marketed, and/or sold to consumers under the same trademarks.

This evidence establishes that the products offered in connection with <<<Protestor>>>'s trademarks and goods and services offered by <<<Applicant>>> under <<<Applicant>>>'s trademark are so related that the circumstances surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that would give rise to the mistaken belief that they originate from the same source.

### <<<Applicant>>>'s Trademark is Highly Similar to <<<Protestor>>>'s Trademark

If it appears that confusion may be likely as a result of the contemporaneous use of similar marks by the parties with the identified goods, the next step is to evaluate the marks themselves, in relation to their identical terms.

Marks may be confusingly similar in appearance despite the addition, deletion, or substitution of letters, words, or positioning of the words. See, e.g., *Weiss Associates Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (TMM held confusingly similar to TMS, both for systems software); *Canadian Imperial Bank of Commerce, N.A., v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH held likely to be confused with COMMUNICASH, both for banking services); *Ava Enterprises, Inc. v. Audio Boss USA, Inc.*, 77 USPQ2d 1783 (TTAB 2006) (AUDIO BSS USA and design for car power amplifiers, car speakers, car stereos, and home theater speakers held likely to be confused with BOSS AUDIO SYSTEMS and design for automobile audio components); *In re Lamson Oil Co.*, 6 USPQ2d 1041 (TTAB 1987) (TRUCOOL for synthetic coolant held likely to be confused with TURCOOL for cutting oil); *In re Curtice-Burns, Inc.*, 231 USPQ 990 (TTAB 1986) (MCKENZIE'S (stylized) for processed frozen fruits and vegetables held likely to be confused with MCKENZIE for canned fruits and vegetables); *In re Pix of America, Inc.*, 225 USPQ 691 (TTAB 1985) (NEWPORTS for women's shoes held likely to be confused with NEWPORT for outer shirts); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON for microprocessor used in commercial laundry machines held likely to be confused with MILLTRONICS (stylized) for electronic control devices for machinery); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL for resinous chemicals used in dyeing textiles held likely to be confused with LUTEX for non-resinous chemicals used in the textile industry).

In the instant matter, <<<Applicant>>>'s Applied-For Mark <<<APPLICANT'S TRADEMARK>>> has a similar, if not identical, sound, appearance and connotation to <<<Protestor>>>'s trademarks <<<Protestor's Trademark>>>. Moreover, the registration of such a trademark would also lead consumers to believe <<<Applicant>>>'s goods and services are an extension of <<<Protestor>>>'s goods and services. As such, given the previous and continued use by <<<Protestor>>> of its trademarks, it is respectfully submitted that <<<Protestor>>> has acquired significant rights in <<<Protestor>>>'s trademarks identified above and, as such, registration of <<<APPLICANT'S TRADEMARK>>> would create a likelihood of confusion as to the source of the <<<Applicant>>>'s goods and services in commerce.

Lastly, <<<Protestor>>> respectfully reminds the PTO that if there is any doubt as to whether there is a likelihood of confusion, that doubt must be resolved in favor of the prior registrant who began its use in commerce first. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

### Conclusion

Reviewing the evidence submitted herein, registration of the trademark at issue would create a likelihood of confusion with <<<Protestor>>>'s trademarks cited herein.

I respectfully suggest that this *Letter of Protest* sets forth a *prima facie* basis for the refusal of the above-referenced alleged trademark such that publication for opposition without consideration of the issues and evidence submitted herein would constitute clear error by the PTO. Accordingly, we respectfully request the Trademark Office to accept the attached evidence for consideration by the examining attorney reviewing <<<Applicant>>>'s application and urge the denial of the registration.

Very truly yours,

/<<<Protestor>>>]/