

This Opinion is Not a
Precedent of the TTAB

Mailed: September 23, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Huda Beauty Limited
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Serial No. 87553422
—

Michelle Mancino March of Arent Fox LLP,
for Huda Beauty Limited.

John LaMont, Trademark Examining Attorney, Law Office 123,
Susan Hayash, Managing Attorney.

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Before Taylor, Kuczma and Heasley,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Huda Beauty Limited (“Applicant”) seeks registration on the Principal Register of the standard character mark THE OVERACHIEVER CONCEALER for, as amended, “cosmetic concealers for the face and body; concealers for spots and blemishes on the face and body” in International Class 3.¹ The word CONCEALER has been disclaimed.

¹ Application Serial No. 87553422 was filed on August 2, 2017, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

The Examining Attorney finally refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that there is a likelihood of confusion with the mark OVER ACHIEVER in U.S. Registration No. 4786441, (in standard characters), for "Hair styling preparation" in International Class 3.²

Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.³

I. Evidentiary Objection

The Examining Attorney has objected to images of the marks appearing on Applicant's and Registrant's respective products included for the first time in Applicant's brief,⁴ arguing that these images were not previously made of record and accordingly are untimely.⁵ We sustain the objection to this new evidence, as Trademark Rule 2.142(d) provides that the record "should be complete prior to the filing of an appeal."⁶ 37 C.F.R. § 2.142(d). *See In re Midwest Gaming & Entm't LLC*,

² Issued August 4, 2015.

³ The TTABVUE and Trademark Status and Document Retrieval ("TSDR") citations refer to the Board's electronic docket and the electronic file database for the involved application, respectively. All citations to the TSDR database are to the downloadable .pdf version of the documents.

⁴ 11 TTABVUE 6 -7.

⁵ 14 TTABVUE 4.

⁶ The proper method for an applicant to introduce additional evidence is to request suspension of the proceeding and remand of the application for further examination. *See* Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d).

106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (new evidence submitted with brief is “untimely and therefore not part of the record for this case”). Accordingly, we give no further consideration to these untimely images or any arguments based solely on them.⁷

II. Likelihood of Confusion

A. Applicable Law

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *see also Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (“Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.” (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)); *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (even within the *du Pont* list of factors, only factors that

⁷ We add that even if we had considered the images our decision would be the same. This is so because only the drawing of the mark is relevant. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *In re Infinity Broad. Corp. of Dallas*, 60 USPQ2d 1214, 1218 (TTAB 2001) (“in Board proceedings, likelihood of confusion is determined independent of the context of actual usage”).

are “relevant and of record” need be considered). These factors, and any other relevant *du Pont* factors in the proceeding now before us, will be considered in this decision.

III. Discussion

A. The Goods

We first turn to a comparison of the goods under the second *du Pont* factor. In making our determination regarding the relatedness of the goods, we must look to the goods as identified in Applicant’s application and the cited registration. *See Detroit Athletic*, 128 USPQ2d at 1052. It is well settled that the goods of Applicant and Registrant need not be identical or competitive to support a holding of likelihood of confusion. It is sufficient that the respective goods are related in some manner, or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d. 1356, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012); *Hilson Research, Inc. v. Soc’y for Human Resource Mgmt.*, 27 USPQ2d 1423 (TTAB 1993). The issue here, of course, is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of these goods. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984).

As noted, Applicant’s goods are identified as “cosmetic concealers for the face and body; concealers for spots and blemishes on the face and body” and Registrant’s goods

are identified as “hair styling preparation.” To show that the goods are related, the Examining Attorney made of record printouts from various websites showing that the same entity commonly provides goods of the types identified in both the application and cited registration, *i.e.*, cosmetic concealers and hair styling preparations, under the same mark.⁸ “[I]t is settled that evidence of third-party use of the same mark for an applicant’s identified goods and services (or similar goods or services) on the one hand, and an opposer’s (or registrant’s) identified goods and services (or similar goods and services) on the other, may establish a relationship between those goods and services. *Detroit Athletic*, 128 USPQ2d at 1051; *see also In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1355-56 (TTAB 2015); *In re Davia*, 110 USPQ2d 1810, 1815-17 (TTAB 2014); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009).” *Ricardo Media Inc. v. Inventive Software, LLC*, 219 USPQ2d 311355, *3 (TTAB 2019).

We have focused on the evidence highlighted in the Examining Attorney’s brief, which features the following marks: Borghese (www.borghese.com⁹), Shu Uemura (www.shuueemura.com¹⁰), The Body Shop (www.thebodyshop.com¹¹), Revlon (www.revlon.com¹²), L’Oreal (www.lorealpaisusa.com¹³), Shea Moisture

⁸ We give no consideration to the evidence from the Sephora website featuring products from Rita Hazan (www.sephora.com; October 18, 2018 Denial of Request for Reconsideration, TSDR 132-33), because it does not show use of Rita Hazan to identify goods of the types recited in both Applicant’s application and the cited registration.

⁹ March 28, 2018 Office Action, TSDR 181 and 184.

¹⁰ *Id.* at TSDR 192-194.

¹¹ October 18, 2018 Denial of Request for Reconsideration, TSDR 111-114.

¹² *Id.* at TSDR 115-120.

¹³ *Id.* at TSDR 121-25.

(www.sheamoisture.com¹⁴), Pericone MD (www.sephora.com¹⁵), Tarte (www.sephora.com¹⁶), Clinique (https://shopnordstrom.com¹⁷), Sisley (https://shopnordstrom.com¹⁸) and Trish McEvoy (www.saxfifthavenue.com¹⁹).

The Examining Attorney also made of record copies of use-based, third-party registrations for marks covering items of the types identified in both Applicant's application and the cited registration. Third-party registrations that individually cover different goods and that are based on use in commerce serve to suggest that the listed goods are of a type that may emanate from a single source. *See Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations are "not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may nonetheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source"). *See also In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993). We again focus on the evidence highlighted in the Examining Attorney's brief which include, for example:

¹⁴ *Id.* at TSDR 126-28.

¹⁵ *Id.* at TSDR 129-31.

¹⁶ *Id.* at TSDR 134-35.

¹⁷ *Id.* at TSDR 136-37.

¹⁸ *Id.* at TSDR 138-39.

¹⁹ *Id.* at TSDR 140-41.

| Registration No. | Mark | Pertinent Goods ²⁰ |
|-----------------------|------------------|---|
| 4553338 ²¹ | E and design | concealers and hair styling preparations |
| 4817730 ²² | DL ROW | facial concealer and hair styling preparations |
| 5032699 ²³ | COLOR SENSE | facial make-up, namely, concealers and hair styling preparations |
| 5155145 ²⁴ | HANDMADE HEROES | cosmetics, namely, concealers and hair care and hair styling preparations, namely, finishing spray and gels |
| 5341954 ²⁵ | ENCHANTED ISLAND | concealers and hair styling preparations |
| 5465766 ²⁶ | MHB | concealers for face and skin and hair highlighting spray; hair styling fixative in the nature of hair wax |
| 5542085 ²⁷ | BEAUTYFRIZZ | concealers for use on face and body and hair styling preparations |
| 5513081 ²⁸ | ENFANTI | facial concealer and hair lotion; hair shampoos and conditioners; hair spray; hair styling gel |
| 5346555 ²⁹ | MODELLAND | concealers and hair care products, namely hair styling preparations |

²⁰ The registrations include additional goods and services that are not relevant to this appeal. We also have not considered Registration No. 4256480 because it has cancelled. A cancelled or expired registration has no probative value other than to show that it once issued and it is not entitled to any of the statutory presumptions of Section 7(b) of the Trademark Act. *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1480 (TTAB 2007). *See also Action Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“a cancelled registration does not provide constructive notice of anything.”).

²¹ *Id.* at TSDR 21-24.

²² *Id.* at TSDR 37-39.

²³ *Id.* at TSDR 40-43.

²⁴ *Id.* at TSDR 52-54.

²⁵ *Id.* at TSDR 55-57.

²⁶ *Id.* at TSDR 58-60.

²⁷ *Id.* at TSDR 64-66.

²⁸ *Id.* at TSDR 67-68.

²⁹ March 28, 2018 Office Action, TSDR 81-83.

| Registration No. | Mark | Pertinent Goods |
|-----------------------|----------------------------|---|
| 5301919 ³⁰ | GREEDYGIRL | concealers for skin, face and body and hair styling gel |
| 5330788 ³¹ | APDG (stylized) | facial concealer and hair styling gel |
| 5351885 ³² | RAINFOREST GROWN BEAUTY | concealers and hair styling preparations |

We find the third-party use and registration evidence sufficient to show that Applicant's identified goods are related and complementary to Registrant's identified goods, such goods all being beauty products that may be used together in a beauty regimen, which are often sold by the same source under the same mark.

We are unpersuaded by Applicant's argument that there is no likelihood of confusion because the "marks are applied to different products."³³ As stated, the goods need not be identical; rather, they need only be related in such a manner that they could be encountered by the same consumer under situations that would lead to the mistaken belief that they originate from the same source.³⁴ *Coach Servs.*, 101 USPQ2d at 1723. We find that the respective goods are related and complementary beauty products.

³⁰ *Id.* at TSDR 87-89.

³¹ *Id.* at TSDR 108-111.

³² *Id.* at TSDR 115-17.

³³ Applicant's brief p. 11, 4 TTABVUE 10.

³⁴ That the specimens of record (including a copy of the specimen of use filed by Registrant with its underlying application, made of record by Applicant during prosecution) "show the clear differences between the goods" does not alter our finding. As noted, even if they show a difference between the goods, an applicant may not restrict the scope of the goods covered in a cited registration by argument or extrinsic evidence. *In re Midwest Gaming & Entertainment LLC*, 106 USPQ2d 1163, 1165 (TTAB 2013); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986).

The *du Pont* factor of the relatedness of the goods thus favors a finding of likelihood of confusion.

B. Channels of Trade and Classes of Consumers

Applicant contends that the trade channels differ, arguing that Registrant's products are "narrowly targeted" toward men seeking quick styling for short hair with a cost between \$10 and \$15, and are available at national drugstore chains and discount department stores, while its goods are targeted to luxury beauty consumers, retail for \$30, and are sold by a single retailer.³⁵ The problem with this argument is there are no such limitations as to channels of trade or classes of purchasers in either Registrant's or Applicant's identifications. Accordingly, we must presume that both Applicant's and Registrant's goods move in all channels of trade usual for these goods, including online and brick and mortar drug stores and department stores, and are or will be offered to all classes of purchasers, including ordinary ones seeking beauty items. *See Detroit Athletic*, 128 USPQ2d at 1052 (citing *i.am.symbolic*, 116 USPQ2d 1406, 1412 (TTAB 2015), *aff'd*, 123 USPQ2d 1744 (Fed. Cir. 2017) ("In the absence of meaningful limitations in either the application or the cited registrations, the Board properly presumed that the goods travel through all usual channels of trade and are offered to all normal potential purchasers.")). The third-party evidence discussed above shows that the types of goods in both the application and cited registration are

³⁵ 11 TTABUE 8-9.

offered for sale on the same websites. We accordingly find that the channels of trade and the classes of consumers of Applicant's and Registrant's goods overlap.

This *du Pont* factor thus favors a finding of likelihood of confusion.

C. Sophistication of the Purchasers

Applicant contends that its concealer is “selected, sought out, purchased, and used with extreme care and discernment” and is purchased by “sophisticated and highly knowledgeable professional makeup artists and discerning women”³⁶ Applicant further contends that its “highly specialized goods” are purchased “after careful study, testing and color matching.”³⁷ We find this argument unavailing and see no reason to deem purchasers of Applicant's concealer as careful or sophisticated. There are no limitations in the identifications of goods as to costs or purchasers and, as the record shows, goods of the type identified in the application can be purchased for less than \$2, and are offered to both professionals and ordinary purchasers. The standard of care for purchasing the goods is that of the least sophisticated potential purchaser. *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018) (citing *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014)). Here, such purchasers most likely will include ordinary purchasers who will exercise no more than ordinary care in their purchasing decisions.

We therefore consider the *du Pont* factor regarding conditions of purchase and purchaser sophistication as neutral.

³⁶ 11 TTABVUE 11-12.

³⁷ *Id.*

D. The Marks

We now consider the *du Pont* likelihood of confusion factor concerning the similarity or dissimilarity of the marks. In a likelihood of confusion analysis, we compare the marks in their entirety for similarities and dissimilarities in appearance, sound, connotation and overall commercial impression. *Detroit Athletic* 128 USPQ2d at 1048. Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff'd mem.*, ___ F.3d. ___ (Fed. Cir. 2019). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong*, 127 USPQ2d at 1801 (quotation omitted).

Because similarity is determined based on the marks in their entirety, our analysis is not predicated on dissecting the marks into their various components. *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015). On the other hand, “there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety.” *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

We compare Applicant's mark THE OVERACHIEVER CONCEALER with the cited mark OVER ACHIEVER and initially find that the term OVERACHEIVER dominates Registrant's mark. The definite article “THE” at the beginning of

Applicant's mark has no trademark significance and fails to distinguish it from the cited mark. *See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) ("The addition of the word 'The' at the beginning of the registered mark does not have any trademark significance."). Similarly, the generic, and disclaimed, word CONCEALER merely denotes the identified goods and, as such, is not source-identifying. *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) ("DELTA," not the disclaimed generic term "CAFE," was the dominant portion of the mark THE DELTA CAFE).

We further find Applicant's mark THE OVERACHIEVER CONCEALER and Registrant's mark OVER ACHIEVER similar in appearance, sound and connotation in that each includes, or consists of, the phrase OVERACHIEVER or the words OVER ACHEIVER. That Applicant displays the words without a space between them does not alter the fact that they are legally identical. That is, the presence or absence of a space does not significantly distinguish the commercial impression of these terms because consumers will still recognize the individual components. *See, e.g., Stock Pot, Inc., v. Stockpot Rest., Inc.*, 220 USPQ 52, 52 (TTAB 1983), *aff'd* 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) ("There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical."); *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016) (MINI MELTS essentially identical to MINIMELTS). As further regards connotation and commercial impression, the Examining Attorney submitted dictionary evidence from the

AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE and MERRIAM-WEBSTER Dictionary showing that the wording OVERACHIEVER is the nominal form of the verb “overachieve,” which means “to perform better or achieve more success than expected.”³⁸ He also made of record dictionary evidence showing that separating OVERACHIEVER into its two components does not create a different meaning; “over” is defined, in relevant part, as “so as to exceed or surpass”³⁹ and “achieve” is defined, in relevant part, as “perform at a standard or above standard level.”⁴⁰ When the marks are viewed in connection with the respective goods, they convey the same meaning and commercial impression, i.e., that Applicant’s concealers for the face and body and Registrant’s hair styling preparations exceed performance expectations.

With respect to Applicant’s arguments concerning actual use of the marks on packaging by it and by Registrant,⁴¹ such comparisons are immaterial to this appeal. Because both Applicant’s and Registrant’s marks are in standard characters, their display is not limited to any particular font style, size, or color. Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a); *Mighty Leaf Tea*, 94 USPQ2d at 1260.

We recognize that in comparing the marks, we must consider Registrant’s mark in its entirety. Thus, we have taken into account the differences in appearance and

³⁸ (<https://ahdictionary.com>); October 18, 2018 Denial of Request for Reconsideration, TSDR 69.

³⁹ (www.merriam-webster.com); *Id.* at TSDR 78

⁴⁰ (<https://ahdictionary.com>); *Id.* at TSDR 72

⁴¹ 11 TTABVUE 6-8.

sound between them. We nonetheless find that despite these differences, given the similarities between the marks in sound, appearance and meaning due to the shared term OVER ACHIEVER (OVERACHIEVER), the marks engender similar commercial impressions.

The factor of the similarity of the marks thus favors a finding of likelihood of confusion.

E. Conclusion

We have carefully considered all of the arguments and evidence pertaining to the relevant *du Pont* factors. In view of the similarity of the marks, the related and complementary nature of the goods and the overlapping trade channels and classes of consumers, we conclude that confusion is likely between Applicant's mark THE OVERACHIEVER CONCEALER for the identified concealers and Registrant's mark OVER ACHIEVER for hair styling preparations.

Decision: The refusal to register Applicant's mark under Section 2(d) of the Act is affirmed.