

**I. POTENTIAL SECTION 2(D) REFUSAL – LIKELIHOOD OF CONFUSION**

The Office has cited the pending application for LUV BEAUTY (Serial No. 87/659,884) for “cosmetic preparations for eyelashes; cosmetics; false eyelashes,” owned by JJP Enterprise,



as a potential obstacle to registration of the mark in International Class 3 on the basis of a possible likelihood of confusion. The Applicant’s identification of goods, as amended, reads as follows:

Non-medicated soaps; non-medicated liquid soaps; non-medicated hand washing preparations; bath and shower preparations, namely, bath foam and shower gels; perfumery, essential oils; cosmetics; colognes, eau de toilette; aftershave; perfume body sprays; deodorants for personal use; anti-perspirants; shaving foam, shaving gel, pre-shaving and after-shaving lotions; talcum powder; pre-shave and aftershave preparations; cosmetic oils, creams and lotions for the skin; aromatherapy preparations, namely, essential oils and non-medicated skin creams with essential oils for use in aromatherapy; massage preparations, namely, massage oils, massage creams, massage lotions, massage gels, other than for medical purposes, massage waxes; non-medicated skin care preparations; depilatory preparations; sun-tanning and cosmetic sun protection preparations; make-up and make-up removing preparations; petroleum jelly for cosmetic purposes; non-medicated lip care preparations; cosmetic cotton wool and cotton sticks for cosmetics purposes; cosmetic pads; wipes impregnated with cosmetic lotions; pre-moistened cosmetic cleansing pads, cosmetic tissues and cosmetic wipes; cosmetic cleansing pads, tissues or wipes impregnated with non-medicated preparations for cleansing the skin and removing makeup; beauty masks, facial packs, namely, facial masks; non-medicated preparations for the care of hair and scalp; shampoos and hair conditioners; hair colorants; hair dyes; hair lotions; hair waving preparations; hair sprays; hair powder, namely, hair-washing powder; hair dressings, namely, hair dressings for men and women, cosmetic hair dressing preparations; hair lacquers; hair mousses; hair glazes; hair gels; hair moisturizers; hair liquid in the nature of hair styling preparations; non-medicated hair preservation treatments; non-medicated hair desiccating treatments in the nature of hair tonic and hair creams for use in removing excess oil from the hair; hair oils; hair tonic; hair creams; dentifrices; non-medicated mouthwashes; cosmetic preparations for the care of the mouth and the teeth; tooth powder; toothpaste; non-medicated toiletry preparations.

In evaluating a likelihood of confusion, the Office must consider all of the *DuPont* factors which pertain to a given examination based on the facts of the case. *Application of E. I. DuPont De Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). The Applicant respectfully submits that the pending application for LUV BEAUTY does not create an obstacle to registration of the Applicant's mark because a careful examination of the *DuPont* factors as they apply to this case clearly demonstrates the absence of any likelihood of confusion between the parties' marks.

**1. The Parties' Marks Create Dissimilar Commercial Impressions in the Minds of Prospective Buyers**

The marks at issue, the Applicant's LOVE BEAUTY AND PLANET in stylized form and JJP Enterprise's LUV BEAUTY, create distinct commercial impressions when considered in their entireties. The visual, aural, and semantic distinctions between the marks are sufficient to obviate any likelihood of confusion, particularly in light of the other *DuPont* factors discussed below.

In comparing the marks' appearance, sound, and meaning, the emphasis should lie on the overall impression created by the marks in the marketplace. 5-5 GILSON ON TRADEMARKS § 5.03. *See also Sports Authority, Inc. v. Prime Hospitality Corp.*, 89 F.3d 955, 962 (2d Cir. 1996) ("In deciding whether the marks are similar as used, we do not look just at the typewritten and aural similarity of the marks, but how they are presented in the marketplace"). There are prominent differences between the Applicant's LOVE BEAUTY AND PLANET in stylized form and JJP Enterprise's LUV BEAUTY word mark.

The Office's conclusion that the parties' respective marks are confusingly similar appears to be predicated solely on the fact that both the Applicant's and JJP Enterprise's marks possess the term "BEAUTY" and a formative of the term "LOVE" in common. By focusing solely upon this single shared feature of the marks, as opposed to considering the overall commercial

impressions created by the marks *in their entirety*, by excluding the other wording in the Applicant's mark from consideration, and by disregarding the distinctive design elements of the Applicant's mark, the Office has contravened the well-established anti-dissection rule.

The anti-dissection rule, as enunciated by the federal courts and the Trademark Trial and Appeal Board, requires that, in comparing the marks' appearance, sound, and meaning, one must look to the *overall impression* created by the marks and not merely compare their individual features. *Duluth News-Tribune v. Mesabi Publ. Co.*, 84 F.3d 1093 (8th Cir. 1996) (citing *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987)). This is true even when the marks comprise identical elements, and even where the shared elements may be dominant (which is not the case here). *Id.* Indeed, it is a clear violation of the anti-dissection rule to isolate any single element present in the respective marks and conclude that a likelihood of confusion exists solely upon that element, while ignoring all the other elements that comprise each mark as a whole. *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005 (C.C.P.A. 1981). As stated by the U.S. Supreme Court, "[t]he commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason, it should be considered in its entirety..." *Estate of P. D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 545-546 (1920). In other words, it is the overall impression created by the totality of the elements in the Applicant's mark that must be compared to the totality of the overall impression of JJP Enterprise's mark.

When compared in their entireties, the Applicant's *four-word* design mark



and JJP Enterprise's *two-word* LUV BEAUTY are readily distinguishable and create distinct commercial impressions in the minds of the parties' customers. While it is true that both marks incorporate the descriptive and disclaimed term "BEAUTY," as well as a formative of "LOVE," "the mere commonality" of these terms is insufficient to support a finding of likelihood of confusion. *See CareFirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 U.S.P.Q.2d 1492 (T.T.A.B. 2005). Quite to the contrary, the obvious and prominent differences in appearance, pronunciation, and meaning significantly reduce the likelihood of confusion in this case. The Applicant's mark is composed of six syllables, whereas JJP Enterprise's comprises only three. The presence of the non-shared wording "AND PLANET" in the Applicant's mark distinguishes the two marks in appearance, sound, and meaning. Moreover, the distinctive design elements in the Applicant's mark render the two marks even more dissimilar.

In *Little Caesar Enterprises, Inc. v. Pizza Caesar, Inc.*, 834 F.2d 568, 572 (6th Cir. 1987), the U.S. Court of Appeals confronted a very similar situation. The court found no likelihood of confusion between LITTLE CAESAR and PIZZA CAESAR USA for restaurant services, notwithstanding the dominant shared identical term "CAESAR" and the parties' directly competing commercial activities. The court reasoned that the "differences in sound and appearance between 'Little Caesar' and 'Pizza Caesar' [were] obvious, and the addition of the acronym 'USA' to the latter mark almost double[d] the number of syllables and heighten[ed] the

distinction.” *Little Caesar*, 834 F.2d at 572. The Applicant’s LOVE BEAUTY AND PLANET in stylized form is at least as different from JJP Enterprise’s LUV BEAUTY as LITTLE CAESAR is from PIZZA CAESAR.

Finally, the two marks evoke very different images in the minds of the potential consumers, which greatly reduces likelihood of confusion. *See* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:28 (4th ed. 2015) (“If two conflicting marks have an aura of suggestion, but each suggests something different to the buyer, this tends to indicate a lack of likelihood of confusion”) (citing *Smith v. Tobacco By-Products & Chemical Corp.*, 243 F.2d 188 (C.C.P.A. 1957)). When considered in its entirety, LOVE BEAUTY AND PLANET connotes the suggestion that the Applicant’s products help to enhance the users’ beauty, while at the same time giving a little love to our planet. This highlights the holistic, environmentally friendly theme of the Applicant’s sustainably sourced and recyclably packaged products. In contrast, JJP Enterprise’s LUV BEAUTY has no such connotation, suggesting, at the most, that its customers “luv” looking beautiful.

In summary, when compared in their entireties, the Applicant’s and JJP Enterprise’s marks create distinct commercial impressions in the minds of the purchasing public. Not only are these marks distinguishable in appearance and sound, but they also conjure very different images in the consumers’ minds. The likelihood of confusion between the marks therefore is reduced, particularly in light of the other *DuPont* factors relevant to the instant case.

## **2. Potential Purchasers Exhibit a Significant Degree of Care**

It is well established that the more costly the goods or services, the more careful and discriminating will be the potential buyers’ purchasing behavior. In turn, more discriminating purchasers are less likely to be misled or confused by any similarities of the parties’ marks. *See DuPont*, 476 F.2d at 1361; *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d

1202, 1206 (1st Cir. 1983) (“there is always less likelihood of confusion where the goods are expensive and purchased after careful consideration”).

Both the Applicant and JJP Enterprise sell personal care and cosmetics products. Selection of such goods is a highly personal matter, and their quality is of great concern to consumers because they directly impact customers’ appearance and the image that customers project around them at social events, in the workplace, among friends, and in society at large. Moreover, low-quality personal care and cosmetics products have been known to harm users’ health and emotional well-being.

Given that background, it is hard to imagine the parties’ customers making such a personal and important purchase impulsively and without significant research and a substantial degree of care. The substantial level of investigation that would be undertaken by a customer before purchasing the Applicant’s or JJP Enterprise’s goods thus greatly reduces the likelihood that he or she would be confused about their origin. Considering all of the above, confusion between the parties’ marks is very unlikely.

## **II. IDENTIFICATION OF GOODS**

In Office Action No. 1, the Office contends that the wording “hair moisturizers” in the Applicant’s identification of goods is unacceptable because it “is indefinite and must be clarified because applicant must specify the type of goods.” Office Action No. 1 at 2. The Office’s ACCEPTABLE IDENTIFICATION OF GOODS AND SERVICES MANUAL comprises a listing of identifications of goods and services that are acceptable as written. One such identification, classified under Term ID 003-1489, reads {“Specify area of use, e.g., face, body, hand, etc.} moisturizers.” The Applicant’s proposed wording “hair moisturizers” meets the standard of this acceptable identification because the term “hair” appropriately identifies the area of use of the Applicant’s “moisturizers.” The Applicant thus respectfully requests that it be accepted.

### **III. CONCLUSION**

In light of the differences between the parties' marks and the high degree of care exercised by the parties' potential purchasers, confusion with JJP Enterprise's LUV BEAUTY mark is unlikely. The citation of JJP Enterprise's LUV BEAUTY application as a potential obstacle to registration of the Applicant's LOVE BEAUTY AND PLANET in stylized form should therefore be withdrawn.

Moreover, because the Applicant's proposed identification "hair moisturizers" meets the standard of Term ID 003-1489 of the Office's ACCEPTABLE IDENTIFICATION OF GOODS AND SERVICES MANUAL, the Applicant respectfully requests the Office to accept that proposed identification.