

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:
Drunk Elephant, LLC

Filed: April 24, 2019

International Class: 3

Atty. Dkt. No.: DUNK048US

Mark: THE TRUNK

Serial No.: 88/400,891

Trademark Law Office: 104

Examining Attorney: Seth Willig Chadab

RESPONSE TO LETTER OF SUSPENSION

In response to the Suspension Letter issued July 3, 2019, Applicant presents the following arguments supporting registration of its mark THE TRUNK and respectfully requests that the Examining Attorney reconsider the suspension.

Drunk Elephant, LLC (“Applicant”) is seeking to register the mark THE TRUNK (“Applicant’s Mark”) in Class 3 for skin care kits comprised of an assortment of non-medicated skin care preparations. The Examining Attorney issued a Suspension Letter citing U.S. Application No. 88/119,700 for the mark SCENT TRUNK (the “Cited Mark”), owned by Product Innovations Research LLC (“Prior Applicant”) and covering Class 3 “fragrances; perfumes and colognes; custom fragrances and perfumes” and Class 35 “online subscription-based order fulfillment services in the field of fragrances or perfumes” as grounds for the suspension of action on Applicant’s application under Trademark Act Section 2(d). Applicant respectfully submits that there is no likelihood of confusion between the marks because (1) courts have repeatedly found consumers of cosmetics to be highly sophisticated, lessening the potential for confusion; (2) the marks differ in appearance, sound, connotation, and overall commercial impression; and (3) the products covered by the marks are different and travel in differing trade channels.

1. Consumers of cosmetics are highly sophisticated, lessening the potential for confusion.

Cosmetics consumers are unlikely to confuse Applicant's Mark with the Cited Mark because they are sophisticated and selective. Consumer sophistication often dispositively weighs against likelihood of confusion, *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 718 (Fed. Cir. 1992), and courts have found that cosmetics consumers are sophisticated and selective, lessening their likelihood of confusion in encountering similar marks within the cosmetics field. *Faberge, Inc. v. Dr. Babor GmbH & Co.*, 219 U.S.P.Q. 848, 851 (T.T.A.B. 1983) (“[W]e believe that most purchasers of cosmetics, which are to be used for cleanliness and the enhancement of one's appearance, are aware of the products in this line which they prefer and the companies from which those products emanate.”). This level of sophistication makes consumer confusion between the Cited Mark and Applicant's Mark unlikely.

Indeed, courts have found trademarks that share certain elements and cover cosmetics to be distinguishable largely based on the sophistication of cosmetics consumers. *Jean Patou Inc. v. Jacqueline Cochran, Inc.*, 201 F. Supp. 861, 133 USPQ 242 (SDNY 1962), *aff'd*, 312 F.2d 125, 136 USPQ 236 (2d Cir. 1963) (holding JOY for perfume was not infringed by JOY OF BATHING for bath products, with the Court relying substantially on consumer sophistication) (“[t]he women who buy plaintiff's and defendant's products are apt to make an individual choice. There is a vast array of cosmetics on the market varying greatly in price and in the claims made by their products. The products are not all alike; their potential customers realize this, and tend to be selective.”); *Lucien Lelong Inc. v. Lenel, Inc.*, 181 F.2d 3, 4 (5th Cir. 1950) (holding that the sophistication of cosmetics consumers weighed greatly in favor of finding no likelihood of confusion between the marks BELAIZA and BELEZZA for cosmetics, stating: “[t]he pronunciation of these names might

bring about a sounding of similarity; but buyers of such commodities are meticulous and do not depend solely on pronunciation. They rely on the reputation of the makers of these various brands.”). As such, while the Examiner may be concerned that the shared element of the Cited Mark and Applicant’s Mark would be likely to cause confusion between the two, Applicant respectfully argues that the sophistication of cosmetics consumers has been shown to negate the potential for such confusion even in situations where the relevant marks were more alike than Applicant’s Mark and the Cited Mark. Thus, cosmetics consumers are unlikely to be confused when confronted with Applicant’s Mark and the Cited Mark.

In addition to the high level of sophistication exhibited by cosmetics consumers, the circumstances under which consumers purchase the product covered by the Cited Mark indicate that such a purchase is done with a high degree of care, making consumer confusion unlikely. Circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion. TMEP § 1207.01(d)(vii) (citing *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985)). The Cited Mark’s coverage includes “fragrances; perfumes and colognes; custom fragrances and perfumes,” and it is clear from the Prior Applicant’s website that all of these items are custom-created. *See Exhibit A* for printouts of Prior Applicant’s website. Indeed, Prior Applicant’s business under the Cited Mark is described on its website as a “creative platform for designing uniquely personalized fragrances” and its mission is “To create a new standard in fragrance by offering *uniquely crafted* fragrances that are formulated by Independent Perfumers with transparent formulas and interactive ingredient learning” (emphasis added). *See Exhibit A*. The site further states that: “Here we unite your ideals of fragrance with the flexibility and independence of an artisan perfumer to create a scent that allows you to smell like no one else.” *See Exhibit A*. The process for creating a unique fragrance includes (1) ordering a

“scent palette” in order to “[s]niff the six fragrance families to discover what you love – and what you don’t”; (2) doing the “Scent Test to tell our lab which families of ingredients to use or to avoid”; and (3) opting in to a subscription service wherein the fragrance is shipped to the consumer monthly. *See Exhibit A.* Thus, the purchasing process in the case of the products covered by the Cited Mark constitutes a multi-step, complex process that involves a fair amount of consumer care in order to collaborate with Prior Applicant to create a custom fragrance. As such, it is unlikely that sophisticated cosmetics consumers will confuse the source of the product covered by the Cited Mark with the source of the product covered by Applicant’s mark.

2. The marks differ in appearance, phonetic effect, connotation, and overall commercial impression.

The marks THE TRUNK and SCENT TRUNK have distinct connotations, especially considering that Applicant’s mark THE TRUNK is a deliberate play on Applicant’s house mark DRUNK ELEPHANT (i.e., the “TRUNK” of an “ELEPHANT”). Even marks that are identical in sound and/or appearance (which these are not) may create sufficiently different commercial impressions when applied to the respective parties’ goods or services so that there is no likelihood of confusion. TMEP § 1207.01(b)(v). (citing *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies’ sportswear not likely to cause confusion, noting that the term "CROSS-OVER" was suggestive of the construction of applicant’s bras, whereas "CROSSOVER," as applied to registrant’s goods, was "likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which "crosses over" the line between informal and more formal wear . . . or the line between two seasons"); *In re British Bulldog, Ltd.*, 224 USPQ 854, 856 (TTAB 1984) (holding PLAYERS for men’s underwear and PLAYERS for shoes not likely to cause confusion, agreeing

with applicant's argument that the term "PLAYERS" implies a fit, style, color, and durability suitable for outdoor activities when applied to shoes, but "implies something else, primarily indoors in nature" when applied to men's underwear); *In re Sydel Lingerie Co.*, 197 USPQ 629, 630 (TTAB 1977) (holding BOTTOMS UP for ladies' and children's underwear and BOTTOMS UP for men's clothing not likely to cause confusion, noting that the wording connotes the drinking phrase "Drink Up" when applied to men's clothing, but does not have this connotation when applied to ladies' and children's underwear)). The meaning or connotation of a mark must be determined in relation to the named goods or services. *Id.* In the case of Applicant's Mark for skin care kits, the connotation of THE TRUNK is two-fold; the mark refers to (i) a container/luggage in which objects are placed, transported, and/or stored and (ii) an elephant's nose and upper lip. Thus, Applicant's Mark is a play on words that harkens to both the "kit" form in which the product comes—analogue to a container/luggage—and the Applicant's house mark DRUNK ELEPHANT. Conversely, the Prior Applicant states in its earlier Response to Office Action that the Cited Mark, SCENT TRUNK, covering fragrance, refers to "odor of woods, which belongs to one of the classic fragrance families." See **Exhibit B** for Prior Applicant's Response to Office Action. Thus, the connotations of these two marks are quite distinct; Applicant's Mark is a playful pun on elephants, while the Cited Mark may conjure images of trees accompanied by woody scents. Given these distinct connotations, sophisticated cosmetic consumers are not likely to confuse the marks.

Furthermore, the marks differ in appearance due to their differing initial elements. While the Examiner's concerns regarding confusion may stem partly from the shared TRUNK element of Applicant's Mark and the Cited Mark, the average consumer will pay most attention to the *first* terms of the relevant marks, *see Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895

(TTAB 1988) (noting “it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”); *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 73 USPQ2d 1689, 1692 (“veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark). The first terms differ in this case, and consumers will focus on those distinct terms when encountering each mark, namely, “THE,” in the case of Applicant’s Mark, and “SCENT,” in the case of the Cited Mark, making confusion between the two marks unlikely. In fact, in a Response to Office Action filed by the Prior Applicant regarding refusal of the Cited Mark based on a prior registration for TRUNK for “[r]etail store services in the field of general merchandise; namely, men's, women's and children's clothing,” the Prior Applicant argued that SCENT TRUNK and TRUNK were distinguishable, and stated that the “dominant word in [the Cited Mark] is SCENT.” See **Exhibit B**.

Moreover, the dominant terms of the two marks likewise differ. As stated above, and as the Prior Applicant stated in its earlier Response to Office Action, “SCENT” is not only the initial but also the dominant element of the Cited Mark, whereas “TRUNK” is the dominant term of Applicant’s Mark. Prior Applicant argued in its earlier Response to Office Action that the words SCENT and TRUNK are “are totally different in their spellings and meanings.” See **Exhibit B**. The same reasoning is applicable here.

3. The products covered by the marks are different and travel in differing trade channels.

While the goods covered by Applicant’s Mark and the Cited Mark may be broadly placed under the category of “personal care” or some similar grouping, the fact that some goods exist in the same broad category does not mean that confusion is likely. As the Board has stated, it is not sufficient that a particular term may be found which may broadly describe the goods. *In re The*

W.W. Henry Co., L.P., 82 U.S.P.Q.2d 1213 (Trademark Tr. & App. Bd. 2007). In fact, it is well established that “a broad general market category is not a generally reliable test of relatedness of products.” *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 1376 (Fed. Cir. 2002). Thus, the goods covered by Applicant’s Mark and the Cited Mark cannot be said to be similar due to their falling under a broad category of products. On the contrary, Applicant’s goods are entirely distinct from Prior Applicant’s, as Applicant’s products are completely fragrance-free. As stated on Applicant’s website and shown in **Exhibit C**, “Drunk Elephant products are fragrance-free and do not smell like anything other than what they are.” Moreover, the products under the marks travel in different trade channels. The similarity or dissimilarity of established, likely-to-continue trade channels is a factor in determining likelihood of confusion. TMEP 1207.01. The products/services description for the Cited Mark reveals that Prior Applicant offers the products under the Cited Mark through “online subscription-based order fulfillment services in the field of fragrances or perfumes.” This channel of distribution differs markedly from that of those through which Applicant’s products are to be distributed under Applicant’s Mark, namely, through retail stores and online retail stores. Indeed, as explained above, consumers of Prior Applicant’s products under the Cited Mark must order a scent palette, take a scent test, and then get a subscription. These very different channels of distribution—collaborative creation of a customized order and subscription service only available through Prior Applicant’s website vs. purchase of a ready-made product through brick-and-mortar and online retail stores—indicate that confusion on the part of cosmetics consumers is unlikely, especially given their high level of sophistication.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the suspension of Applicant’s Mark be withdrawn, and that this application be allowed to proceed to registration.

The present Response is intended to address all issues outlined by the Examining Attorney in the Letter of Suspension. If there is an issue that can be resolved by an Examiner's Amendment, the Examining Attorney is invited to contact Applicant's attorney.