#1639738

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.:	88324422
Applicant:	Australian Gold, LLC
Filing Date:	March 4, 2019
Law Office:	104
Examiner:	Dominic Fathy
Attorney Docket No.:	8406-661
Mark:	VERSUS

RESPONSE TO OFFICE ACTION

BOX RESPONSE NO FEE
Commissioner for Trademarks
P.O. Box 1451
Arlington, VA 22313-1451

Dear Sir:

In response to the Office Action emailed April 5, 2019, reconsideration is respectfully requested in view of the following amendment and remarks.

AMENDMENT

Please amend the recitation of goods to the following:

"indoor non-medicated skin tanning preparations marketed for sale in indoor tanning salons, in International Class 3."

REMARKS

Likelihood of Confusion

The Office Action preliminarily rejects the present application alleging there is a likelihood of confusion between the present mark for VERSUS and prior registration No. 4123563 on the mark VERSUS for "Cosmetics, namely, night and day creams, cleaning preparations, namely, soaps for face and body care." Applicant submits that the differences

between Applicant's mark and the cited mark are sufficient to show that there is no reasonable likelihood of confusion and requests that the rejection be withdrawn.

In the present comparison, as a starting point the respective goods are not the same. The cited registration is for "Cosmetics, namely, night and day creams, cleaning preparations, namely, soaps for face and body care." It does not include skin tanning preparations. Instead, the Office Action argues that the goods are "highly related", asserting that:

> This evidence shows that the goods listed therein, **namely "tanning preparations" and "cosmetics",** are of a kind that may emanate from a single source under a single mark.

(emphasis added)

Applicant respectfully submits that the approach of asserting a general or broad characterization of the goods in the cited registration as "cosmetics" is improper. *Edwards Lifesciences Corporation v. VigiLanz Corporation,* 94 USPQ2d 1399, 1410 (TTAB 2010) (precedential) ("a finding that the goods are similar is not based on whether a general term or overarching relationship can be found to encompass them both,") *citing, Harvey Hubbell Inc. v. Tokyo Seimitsu Co., Ltd.,* 188 USPQ 517, 520 (TTAB 1975) ("In determining whether products are identical or similar, the inquiry should be whether they appeal to the same market, not whether they resemble each other physically or whether a word can be found to describe the goods of the parties").

> At the outset we note that the mere fact that both types of goods at issue here emit and provide light is not a sufficient basis for us to conclude that the goods are related. The goods, as identified, are sufficiently different in their uses to require proof that they are related. Nor can we conclude by intuition that both types of goods would be sold through common trade channels.

In re Princeton Tectonics, 95 USPQ2d 1509, 1510 (TTAB 2010).

By virtue of the term "namely" the cited mark is limited to the goods of "night and day creams" and "soaps for face and body care." The proper comparison is between a) Applicant's goods (as amended), "indoor non-medicated skin tanning preparations distributed and marketed for sale and use in indoor tanning salons" and b) night and day creams and/or soaps for face and body care. Applicant respectfully disagrees that the respective goods are "highly related" for likelihood of confusion purposes. Night and day creams and/or soaps for face and body care are considered to be substantially different from indoor tanning preparations by most consumers.

When the goods are not the same, as is the case here, the analysis considers the circumstances in which the respective goods are sold and the relevant purchasers. The Office must show, "that circumstances surrounding the marketing of the respective goods would result in relevant purchasers mistakenly believing that the goods originate from the same source when the same mark is used on both types of goods." *In re Princeton Tectonics*, 95 USPQ2d at 1511. "The burden is on the Trademark Examining Attorney to prove that there in fact is an overlap or similarity in purchasers and trade channels." *In re Band-it-IDEX, Inc.* 2009 TTAB LEXIS 659 *16 (TTAB 2009). The inquiry should focus on the evidence to see whether the respective goods appeal to the same market.

The Office Action relies on ten third-party registrations as evidence to support the premise that the respective goods may emanate from a single source under a single mark. Applicant respectfully disagrees and submits that the evidence does not support such a conclusion. Applicant submits the Declaration of Matt Cotton as further evidence.

Indoor Tanning Preparations and Sunscreen Are Different Products

To advance prosecution, Applicant has amended it description of goods to specify that Applicant's mark is intended to be used to sell (as amended), "indoor non-medicated skin tanning preparations marketed for sale and use in indoor tanning salons." To explain the proper context, indoor tanning preparations are a specialized product. To the extent the Office Action relies on third party registrations that only list "sunscreen" or "sun tanning" preparations which are legally categorized as drugs, those registrations are not related to Applicant's goods which are legally categorized as cosmetics. As explained in the declaration of Matt Cotton filed herewith, indoor tanning preparations are primarily designed for and used with indoor tanning equipment, i.e., an ultraviolet tanning bed or booth, where a user is seeking artificial ultraviolet exposure. Indoor tanning preparations do not contain a sun protection factor ("SPF") and do not protect persons from ultraviolet rays. (Declaration, ¶ 5)

In contrast, "sunscreen" products typically refer to variations of: "sunblocks," "sunscreens," and "cosmetic preparations against sunburn," which products are sold as *sun protection* products for use in the outdoor market. Suntan products have an "SPF" rating to rate their efficiency at blocking ultraviolet rays. *Suntan/sunblock products are legally and statutorily categorized by the FDA as "drugs"* which have substantially different regulatory requirements than indoor tanning preparations which are categorized as "*cosmetics*." (Declaration, ¶ 6) For

example, sunscreen products must follow all drug labelling requirements. (21 C.F.R. §201.327) In contrast, the FDA requires that indoor tanning preparations (that do not have an SPF rating) must alert consumers to this important difference by carrying the following Warning:

> **"This product does not contain sunscreen and does not protect you from sunburn."**

(21 C.F.R. §740.19)

Few of the Registrations are Relevant

None of the cited registrations specifically recite "night and day creams." Some list other types of creams, but it is not clear if the listed creams are related to "night and day creams." *See, In re Vafiadis*, 2007 TTAB LEXIS 344 *5 (TTAB 2007) (applicant amended its goods to mineral water distributed in the dental field – "None of the third-party registrations includes 'mineral water distributed in the dental field.' Therefore, we do not find the examining attorney's evidence persuasive on this point.") Thus, as a starting point, all of cited registrations should be discounted.

Next, seven of the ten cited registrations[1] mention sun block, sunscreen, or suntan preparations, but they do not mention indoor tanning preparations. As explained above, sunscreen products are different from indoor tanning preparations. The TTAB has previously ruled directly on this point:

> on close inspection, we find that the third-party registrations submitted into the record by the examining attorney cover goods that are distinctly different from (or not sufficiently clear that they are the same as) those at issue in this case. For example, none of the identifications in the third-party registrations contains the clear limitation present in applicant's identification of "indoor" tanning preparations or even "tanning preparations" generally. A number mention "sun tanning preparations," but the identification in the cited registration is clearly not intended to included "preparations" for "tanning" in the "sun."

In re Coty, 2012 TTAB LEXIS 92 *5-6 (TTAB 2012) (emphasis added) (comparing "indoor tanning preparations" to "perfumery, namely, perfume, perfumed soaps, eau de toilette, perfumed body wash, and perfumed shower gel".) Accordingly, those seven registrations do not support a conclusion that Applicant's indoor tanning preparations are similar to night and day creams and/or soaps for face and body care.[2]

[1] 5656993; 5622211; 5632382; 5647371; 5655085; 5660874; and 5691098.

[2] Two of the seven registrations, Reg. Nos. 5,655,085 and 5,660,874 also do not list creams or soaps. Registrations that do not list any of the relevant products are not entitled to any weight.

Two of the remaining three registrations do not clearly specify if they are for indoor tanning preparations or suntanning preparations. Further, of those, Registration No. 5,451,925 does not recite any creams or soaps. It lists "body and beauty care cosmetics" however, reciting a broad term or the generic class 3 heading such as "cosmetics," does not mean that the goods are automatically related to every type of good in class 3. *In re Fiat Group Mktg & Corp. Comms. S.p.A.*, 109 USPQ2d 1593, 1598 (TTAB 2014).

Applicant submits that the cited registrations do not support the premise that *indoor* tanning products and night and day creams and/or soaps for face and body care commonly emanate from the same source.

Applicant's Goods and the Cited Goods Travel in Different Channels of Trade

Indoor tanning preparations are not only different goods, but goods that typically travel in substantially different channels of trade than night and day creams and/or soaps for face and body care. Applicant's amendment clarifies that its indoor tanning preparations are marketed for sale in indoor tanning salons (See also Cotton Declaration, ¶ 4).

Indoor tanning salons are a specialty niche market where the salons have a primary emphasis of providing indoor tanning services, i.e., providing ultraviolet tanning beds or booths in which a customer obtains a tan. The sale of indoor tanning preparations is a complimentary product to promote and facilitate these services (Cotton Declaration, ¶ 7).

The consumers purchasing indoor tanning products in a salon are sophisticated and are purchasing such products in the specific environment for intended use with indoor tanning services. Further, such consumers are knowledgeable and receive the input and guidance of a trained tanning consultant (Cotton Declaration, ¶¶ 8 and 9).

As explained by Mr. Cotton, indoor tanning salons are not a normal channel of trade for night and day creams and/or soaps for face and body care (Cotton Declaration, ¶¶ 10 and 11). Consumers do not typically look for night and day creams and/or soaps for face and body care in a tanning salon. Night and day creams and/or soaps for face and body care are often sold through other mass-market or retail non-tanning-salon outlets, such as retail department stores or mass merchandise stores. In contrast, Applicant's distributors and salon customers are prohibited from selling online or at mass market retail outlets (Cotton Declaration, ¶ 12).
The TTAB recognized the specialty market of indoor tanning in the *In re Coty* case. The TTAB considered the conditions of sale for indoor tanning preparations for example as compared to

those for "perfumed soap," and concluded that there was not any reasonable likelihood of confusion. *In re Coty*, 2012 TTAB LEXIS 92 *7. Comparably here, Applicant's restriction to, "marketed for sale and use in indoor tanning salons," which identifies a specialty channel of trade removes support for the allegation that the respective products may be found in the same of trade.

Consumers for Applicant's Goods and Consumers for the Cited Goods are Sophisticated

Further, night and day creams and/or soaps for face and body care as well as tanning services and products are intended to enhance a person's image and looks. The respective consumers in these fields pay substantial attention to their appearance. Correspondingly, such consumers take care when purchasing products that affect their appearance. For instance tanning consumers are typically purchasing indoor tanning preparations specifically for use in indoor tanning equipment. This degree of care and sophistication further minimizes if not eliminates any likelihood of consumer confusion.

The TTAB case of *In re Coty* compared consumers of indoor tanning preparations to consumers for soaps, among other goods, i.e., "perfumery, namely, perfume, perfumed soaps, eau de toilette, perfumed body wash, and perfumed shower gel." The TTAB concluded that the sophistication and care taken by indoor tanning consumers weighed *against* a finding that there was a likelihood of confusion. *In re Coty*, 2012 TTAB LEXIS 92 *6-7 ("circumstances suggesting care in purchasing may tend to minimize likelihood of confusion." … "In this case, we find that this *du Pont* factor weighs against finding a likelihood of confusion.")

Coexisting Third-Party Registrations Suggest That The Same Mark Can be Registered For The Respective Goods

Finally and for consistency, the Applicant respectfully submits that the Trademark Office has previously accepted that differences in the goods and channels of trade between tanning preparations and other goods in class 3 are sufficient to avoid any reasonable likelihood of confusion. Applicant directs the Examining Attorney to the enclosed sets of registrations which coexist for the same mark in Class 3 and where the goods could broadly be considered "cosmetics." These include sets of registrations for the marks AMBROSIA, AXIS, BLACK LABEL, COAST, BOMBSHELL, DUCHESS, FEARLESS, QUEEN, STUNNING, TIARA and VELOCITY. More specifically, the AMBROSIA, COAST and VELOCITY marks coexist for

registrations which include tanning preparations and for registrations which include soap. *In re G.B.I. Tile and Stone Inc.*, 92 USPQ2d 1366, 1369-70 (TTAB 2009) ("applicants may submit sets of third-party registrations to suggest the opposite, i.e., that the Office has registered the same mark to different parties for the goods at issue."); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 16 (TTAB 2009) ("On the other hand, applicant has submitted copies of 13 sets of registrations for the same or similar marks for different types of trailers owned by different entities arguing, in essence, that the third-party registrations serve to suggest that the listed goods are of a type which may emanate from different sources"). Applicant respectfully submits that this is persuasive authority to allow the present application.

Conclusion

Applicant respectfully requests withdrawal of the rejection. Applicant accordingly submits that the mark is in condition for publication and allowance, and action towards such is respectfully requested. If there are any questions with regard to the application or this response, the Examining Attorney is invited to telephone the undersigned to expedite this application.

Respectfully submitted

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