From: Donegan, Daniel

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Subject: U.S. TRADEMARK APPLICATION NO. 87496907 - LESS IS MORE BY BRANDHUBER & - 311168-00001 - Request for Reconsideration Denied - Return to TTAB - Message 1 of 8

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Attachment Information:

Count: 56

Files: 74177615P001OF003.JPG, 74177615P002OF003.JPG, 74177615P003OF003.JPG, 74186540P001OF002.JPG, 74186540P002OF002.JPG, 74431390P001OF003.JPG, 74431390P002OF003.JPG, 74431390P003OF003.JPG, 77257593P001OF003.JPG, 77257593P002OF003.JPG, 77257593P003OF003.JPG, 77324452P001OF006.JPG, 77324452P002OF006.JPG, 77324452P003OF006.JPG, 77324452P004OF006.JPG, 77324452P005OF006.JPG, 77324452P006OF006.JPG, 77796328P001OF004.JPG, 77796328P002OF004.JPG, 77796328P003OF004.JPG, 77796328P004OF004.JPG, 77979191P001OF003.JPG, 77979191P002OF003.JPG, 77979191P003OF003.JPG, 85091207P001OF003.JPG, 85091207P002OF003.JPG, 85091207P003OF003.JPG, 85716435P001OF004.JPG, 85716435P002OF004.JPG, 85716435P003OF004.JPG, 85716435P004OF004.JPG, 86025887P001OF006.JPG, 86025887P002OF006.JPG, 86025887P003OF006.JPG, 86025887P004OF006.JPG, 86025887P005OF006.JPG, 86025887P006OF006.JPG, 86304727P001OF007.JPG, 86304727P002OF007.JPG, 86304727P003OF007.JPG, 86304727P004OF007.JPG, 86304727P005OF007.JPG, 86304727P006OF007.JPG, 86304727P007OF007.JPG, 86369672P001OF003.JPG, 86369672P002OF003.JPG, 86369672P003OF003.JPG, 86374671P001OF003.JPG, 86374671P002OF003.JPG, 86374671P003OF003.JPG, 86531375P001OF004.JPG, 86531375P002OF004.JPG, 86531375P003OF004.JPG, 86531375P004OF004.JPG, 86971840P001OF004.JPG, 87496907.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 87496907

MARK: LESS IS MORE BY BRANDHUBER &

CORRESPONDENT ADDRESS:
CHRISTINA D FRANGIOSA

ECKERT SEAMANS CHERIN & MELLOTT LLC

50 SOUTH 16TH STREET

PHILADELPHIA, PA 19102-2516

GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

VIEW YOUR APPLICATION FILE

APPLICANT: LIM Cosmetics GmbH

CORRESPONDENT'S REFERENCE/DOCKET NO:

311168-00001

CORRESPONDENT E-MAIL ADDRESS:

ipdocket@eckertseamans.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 5/5/2019

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The Section 2(d) refusal for likelihood of confusion with Registration No. 5197421, made final in the Office action dated September 14, 2018 is maintained and continues to be final. *See* TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issues, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues.

Applicant's request for reconsideration includes both an amendment to the identification of goods as well as arguments and evidence in opposition to the Section 2(d) likelihood of confusion refusal. In response to the final Office action issued September 14, 2018, applicant has deleted goods Class 5 in its entirety from the instant application. Applicant thus seeks registration of its mark **LESS IS MORE BY BRANDHUBER & TRUMMER** in stylized form for the following goods in Class 3:

> Perfumery, especially extracts of flowers for perfumes, body deodorants, oils for perfumes and scents, fumigation preparations, namely, room fragrances; essential oils, especially aromatic oils, ethereal essences; cosmetics, especially make-up removing preparations, astringents for cosmetic purposes, bath salts not for medical purposes and non-medicated baths preparations, shower gel, greases for cosmetic purposes, hair dyes and hair colours, hair spray, shampoos, hair lotions, hair wax, hair mousse, hair gel, hair conditioners, hair tonics, non-medicated hair balm, non-medicated cosmetic preparations for skin care, lotions for cosmetic purposes, gel for cosmetic purposes for hair care, hair styling spray, hair styling gels, hair styling waxes, hair styling creams, skin care products, namely, non-medicated serums and creams for hands, face, body, beauty serums for cosmetic purposes, cosmetic creams, make-up, mouth washes not for medical purposes, oils and cleansing milk for cosmetic purposes, pomades for cosmetic purposes for hair care, hair styling gels and waxes; make up, make-up powder, beauty masks, skin soaps and body cream soaps, skin care preparations in the nature of peeling preparations, namely, skin peels, body scrubs; cosmetics for animals, shampoos for pets; dentifrices.

Registrant's mark remains **LESS IS MORE** in standard character form for goods in Class 5:

> Vitamin, mineral, nutritional, and dietary supplements

Applicant argues that the applied-for and registered marks are different in sound, appearance, and commercial impression because of the addition of applicant's house mark (*i.e.*, "BY BRANDHUBER & TRUMMER) and because registrant's mark is weak and should not be afforded a broad scope of protection. These arguments are not persuasive. While it is true that applicant's mark contains several additional words not appearing in the cited registration, here the addition of a house mark to an otherwise confusingly similar mark will not obviate a likelihood of confusion under Section 2(d). *See In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366-67 (TTAB 2007) (finding CLUB PALMS MVP and MVP confusingly similar); *In re Christian Dior, S.A.*, 225 USPQ 533, 534 (TTAB 1985) (finding LE CACHET DE DIOR and CACHET confusingly similar); TMEP §1207.01(b)(iii). It is likely that goods sold under these

marks would be attributed to the same source. *See In re Chica, Inc.*, 84 USPQ2d 1845, 1848-49 (TTAB 2007). Consumers are likely to perceive applicant's mark as either a form of registrant's mark with a house mark, or believe registrant's mark is a shortened form of applicant's mark. The wording "BY BRANDHUBER & TRUMMER" is also not inherently distinctive because the attached evidence from applicant's website and Instagram pages indicate these words are surnames of two of applicant's founding members. Alongside the fact that the phrase "LESS IS MORE" appears in larger, more prominent font than the subsequent wording in the mark would be considered subordinate and less distinctive than the shared wording, "LESS IS MORE".

Applicant's reliance on *Knight Textile Corp.* is inapposite; there, the house mark appeared before the common matter at issue (*i.e.*, "ESSENTIALS"). Here, applicant's house mark does not appear until after the common wording. Applicant's argument that the applied-for mark contains a "design" is also unconvincing. Registrant's mark appears in standard character form: A registrant is entitled to all depictions of a standard character mark regardless of the font style, size, or color, and not merely "reasonable manners" of depicting such mark. *See In re Viterra Inc.*, 671 F.3d 1358, 1364-65, 101 USPQ2d 1905, 1910 (Fed. Cir. 2012). Insofar as applicant's "design" is really just stylization of the wording appearing in the mark, registrant's right extend to depicting its "LESS IS MORE" wording in exactly the same design, which would likely lead to consumer confusion upon the marks appearing side-by-side in the same stylization.

Applicant's argument that the wording "LESS IS MORE" is weak is also not persuasive. In support of this argument applicant has submitted electronic copies of third-party registrations for marks containing the wording "LESS IS MORE" to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. These registrations, however, appear to be for goods wholly unrelated to those identified in applicant's application.

The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods. *See Nat'l Cable Tel. Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Evidence of widespread third-party use of similar marks with similar goods "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection" in that particular industry or field. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); *see In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1062-63 (Fed. Cir. 2003).

Further, evidence comprising third-party registrations for similar marks with different or unrelated goods, as in the present case, has "no bearing on the strength of the term in the context relevant to this case." *See Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1058 (TTAB 2017) (citing *In re*

i.am.symbolic, llc, 866 F.3d at 1328, 123 USPQ2d at 1751). Thus, these third-party registrations submitted by applicant are insufficient to establish that the wording "LESS IS MORE" is weak or diluted.

Applicant next argues that the goods in the respective marks are sufficiently unrelated such that contemporaneous use of the marks is unlikely to lead to consumer confusion. Applicant submits that the cosmetic goods to be used with the applied-for mark bear no relation to the vitamin and supplement goods used in conjunction with the cited registration. This argument is not persuasive. The fact that the goods of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source or sponsorship of those goods. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); TMEP §1207.01.

The examining attorney has attached supplementary evidence establishing the relatedness of the goods appearing in the application and cited registration. The attached Internet evidence, consisting of third-party websites from retail enterprises, establishes that the same entity commonly manufactures and provides the relevant goods and markets the goods under the same mark and the relevant goods are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use. This marketplace evidence clearly shows that consumers are accustomed to finding dietary and nutritional supplements and vitamins appearing alongside various make-up and cosmetic goods, including hair care products, oils, and skin care products. Thus, applicant's and registrant's goods are considered related for likelihood of confusion purposes. *See, e.g.*, *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

See the following attached third-party website evidence:

The Honest Co.

https://www.honest.com/health-and-wellness/prenatal

https://www.honest.com/health-and-wellness/gummy-calcium-vitamin-d3

https://www.honest.com/beauty-products/heat-defense-spray

https://www.honest.com/beauty-products/truly-restored-shampoo

https://www.honest.com/beauty-products/makeup-remover-wipes

https://www.honest.com/beauty-products/acne-clearing-cleanser

https://www.honest.com/beauty-products/beauty-balm

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