

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: March 1, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Spatz Laboratories*  
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Serial No. 86720827  
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Christine C. Washington for Spatz Laboratories.

Roger T. McDorman, Trademark Examining Attorney, Law Office 109,  
Michael Kazazian, Managing Attorney.

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Before Kuhlke, Cataldo and Coggins, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Spatz Laboratories (Applicant) seeks registration on the Principal Register of the standard character mark SUPER SHOCK SHADOW for “Eye shadow, eye shadow pigments, pigment powders for cosmetic use,” in International Class 3.<sup>1</sup>

The Trademark Examining Attorney has refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, when used in connection with the identified goods, so resembles

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<sup>1</sup> Application Serial No. 86720827, filed on August 11, 2015, based upon Applicant’s allegation of first use and use in commerce on May 1, 2014 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

the mark SUPERSHOCK in standard characters registered on the Principal Register for “mascara,” in International Class 3,<sup>2</sup> as to be likely to cause confusion, mistake or deception.

In addition, the Examining Attorney refused registration under Trademark Act Section (6), 15 U.S.C. § 1056, based on Applicant’s failure to comply with a requirement to disclaim the word SHADOW, which the Examining Attorney maintains is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), when used in connection with Applicant’s goods, and therefore must be disclaimed apart from the mark as shown.

When the refusals were made final, Applicant appealed and filed a request for reconsideration. Subsequently, the Examining Attorney denied the request for reconsideration, the Board resumed the appeal, and the Examining Attorney and Applicant filed briefs. We affirm the refusals to register.

### **Disclaimer Requirement**

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. 15 U.S.C. § 1056. This section of the statute was amended in 1962 to allow the exercise of greater discretion by examining attorneys in determining whether a disclaimer is necessary. *See* TMEP § 1213.01(a) (October 2017). *See also In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262 (Fed. Cir. 2015). Merely descriptive or generic terms are unregistrable under

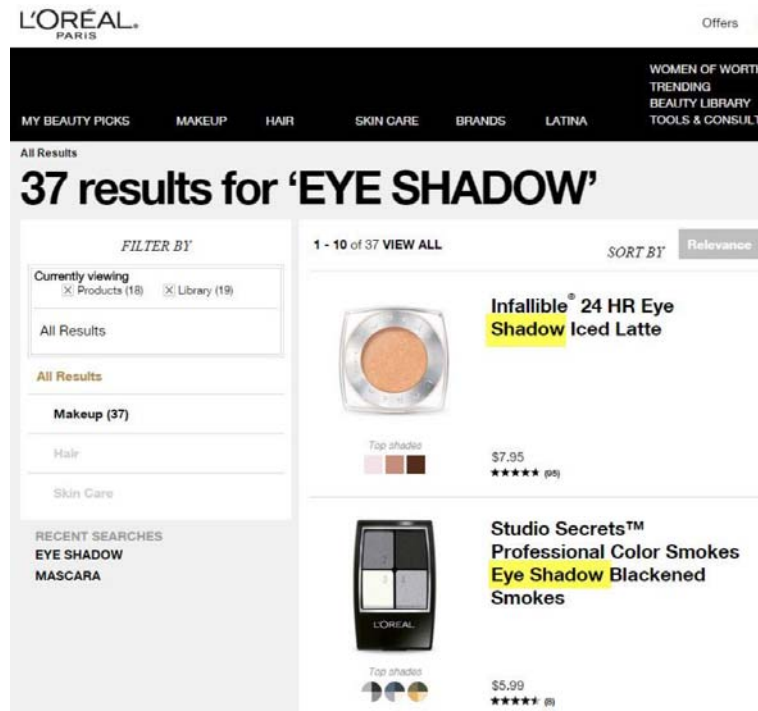
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<sup>2</sup> Registration No. 3481656, issued on August 5, 2008, Sections 8 & 15 Combined Declaration accepted and acknowledged.

Section 2(e)(1), and therefore are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. *La. Fish Fry*, 116 USPQ2d at 1264 (citing *In re Stereotaxis, Inc.*, 429 F.3d 1039, 77 USPQ2d 1087 (Fed. Cir. 2005)) (“The PTO can condition the registration of a larger mark on an applicant’s disclaimer of an ‘unregistrable component of a mark otherwise registrable.’ 15 U.S.C. § 1056(a)”). *See also In re Omaha Nat’l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).

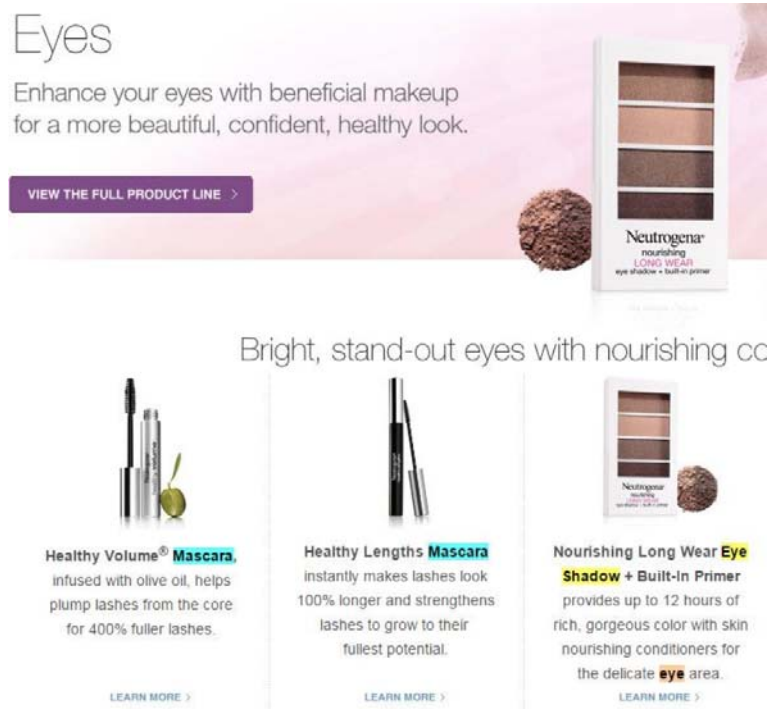
A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it immediately conveys information of a quality, feature, function, or characteristic of the goods or services in connection with which it is used, or intended to be used. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). *See also In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015). The determination of whether a term is merely descriptive must be made “in relation to the goods for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use.” *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)). It is not necessary, in order to find a term merely descriptive, that the term describes each feature of the goods or services, only that it describes a “single feature or attribute” of the goods or services. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987).

The Examining Attorney contends that SHADOW is “commonly used in connection with similar goods to mean ‘a cosmetic available in various colors or tints and applied especially to the eyelids to enhance the eyes.’” 11 TTABVUE 17. In support of his position that the term SHADOW is merely descriptive of the applied-for goods, the Examining Attorney relies on the dictionary definition of “eye shadow” as being “[a] cosmetic available in various colors or tints and applied especially to the eyelids to enhance the eyes.”<sup>3</sup> In addition, the Examining Attorney submitted evidence in the form of third-party webpages using the word SHADOW to describe a cosmetic applied to the eyes. Examples are set forth below:<sup>4</sup>



<sup>3</sup> THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (www.ahdictionary.com), November 25, 2015 Office Action at 11.

<sup>4</sup> November 25, 2015 Office Action at 4-11.



Additional examples include web pages from third-party websites attached to the May 2, 2016 Office Action and July 4, 2016 Request for Reconsideration from a variety of cosmetic companies including KIKO, MAC, Mary Kay and NARS.

The Examining Attorney also submitted examples of third-party use of the word SHADOW in online articles to describe a cosmetic for use on the eyes:<sup>5</sup>

How to Apply 3 Color Eyeshadow ... Strategically applying three eye shadow colors to your eyes helps shape and define the eye so that the areas you want to enhance pop out, while muting the areas you don't want to enhance... If you don't have an eye shadow trio, pick three shadows that are similar in color but have varying shades. (<https://www.leaf.tv/articles>);

19 Eyeshadow Basics Everyone Should Know ... Cream eyeshadows work best as a base color for powder eye shadow, or for solid, single color coverage. ... Pressed eyeshadows are the most common type of shadow, because they blend easily without being too messy. ... You can use a slightly lighter color and skip the gold glitter shadow for an everyday take on this look. ([www.buzzfeed.com](http://www.buzzfeed.com)); and

Eye Makeup Trends by Decade: The Shadow, Mascara, and More That Ruled the Last 100 Years ... Inspired by the increased distribution of movies, expanded reach of cinema stars ... rings of dark shadow became the chic evening look of the era. ([www.elle.com](http://www.elle.com)).

In response, Applicant argues “that the word SHADOW, in the context of Applicant’s product line, which, on information and belief, includes names like ‘Going Rogue,’ ‘Let Me Explain,’ ‘Liar, Liar,’ connotes a sense of mystery or that which is hidden, not obvious – in the ‘shadows.’” 9 TTABVUE 8. In the alternative, Applicant accepts “the requested disclaimer if doing so will result in the approval of the application for publication.” *Id.*

In our analysis of the proposed term SHADOW we must consider “the context in which it is being used, and the possible significance that the term would have to the

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<sup>5</sup> July 4, 2016 Request for Reconsideration 54-81.

average purchaser of the goods because of the manner of its use or intended use.” *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219. The fact that “a term may have other meanings in different contexts is not controlling.” *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1087 (TTAB 2012); *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984). Here, the direct connection of the word SHADOW to eye shadow is not lost in the context of the mark SUPER SHOCK SHADOW as a whole and does not present a double entendre that creates a unique or incongruous commercial impression. As seen in Applicant’s specimen of use, the word SHADOW is below the wording SUPER SHOCK which serves to underscore its merely descriptive meaning, i.e., the goods are eye shadow. Applicant’s specimen of use is displayed in figure 1 below:<sup>6</sup>



Figure 1.

The record establishes that the word SHADOW when used in connection with the applied-for goods immediately, without doubt, describes a feature of the goods, namely, that they are “eye shadow, eye shadow pigments, pigment powders for

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<sup>6</sup> August 11, 2015 Application.

cosmetic use.” In view of our finding that SHADOW is merely descriptive of Applicant’s goods, the disclaimer requirement is appropriate.

### **Likelihood of Confusion**

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., Inc.*, 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 or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

#### *Similarity of the Goods/Channels of Trade/Consumers*

With regard to the goods, channels of trade and classes of consumers, we must make our determinations under these factors based on the goods as they are identified in the application and cited registration. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). “This factor considers whether ‘the consuming public may perceive [the respective goods of the parties] as related enough to cause confusion about the source or origin of the goods and services.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting



*Hewlett Packard*, 62 USPQ2d at 1004). In other words, we must consider not whether the actual goods are literally the same or similar, but rather whether the public will be confused as to their source. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).

Applicant argues that “the only thing that the Applicant’s goods share in common with the cited goods are that they are cosmetics and, as demonstrated in several previous Board and court decisions ... that is simply not enough to support a finding of likelihood of confusion.” 9 TTABVUE 6 (emphasis in original). However, the record clearly demonstrates the close relationship between “mascara” and “Eye shadow, eye shadow pigments, pigment powders for cosmetic use.” It is common for the same entity to produce and sell these items under the same mark in the same channels of trade to the same classes of consumers. The record includes many examples from third-party websites demonstrating this. *See, e.g., L’Oreal*,<sup>7</sup> *Maybelline*,<sup>8</sup> *Neutrogena*,<sup>9</sup> *KIKO*<sup>10</sup> and *MAC*<sup>11</sup> all showing eye shadow and mascara offered under the same mark. In addition, the Examining Attorney provided fifteen use-based third-party registrations where marks are registered for use in connection with mascara and eye shadow. *See* July 4, 2016 Denial of Request for Reconsideration at 2-49.

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<sup>7</sup> November 25, 2015 Office Action at 4-5.

<sup>8</sup> *Id.* at 6-8.

<sup>9</sup> *Id.* at 9.

<sup>10</sup> May 2, 2016 Office Action at 13-15.

<sup>11</sup> *Id.* 16-19.

Third-party registrations that cover a number of different goods or services may have some probative value to the extent that they may serve to suggest that goods or services are of a type that may emanate from a single source, if the registrations are based on use in commerce. *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to the relatedness analysis”); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB), *aff’d per curiam*, 864 F.2d 149 (Fed. Cir. 1988).

The cases relied upon by Applicant are infringement cases where the courts take into account all aspects of the specific goods and marks as used in the marketplace. However, as noted above, in our analysis for trademark registration we are bound by the marks and goods as identified in the application and cited registration. In this case, there are no restrictions as to channels of trade or classes of consumers in the cited registration or the application.

Based on this record we find that the *du Pont* factors of the relatedness of goods, channels of trade and consumers weigh in favor of likelihood of confusion.

In addition, products such as cosmetics may be relatively inexpensive and the subjects of impulse purchases. *See L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1441 (TTAB 2012); *Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629, 1640-41 (TTAB 2007). “When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.” *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54

USPQ2d 1894, 1899 (Fed. Cir. 2000). Because the identification of goods in the application and cited registration contain no limitations as to price points, we must presume that the recited cosmetics include lower cost make-up items that may be purchased without a high degree of care.

Applicant's unsupported argument that the purchasing decision for cosmetics "involves substantial contemplation and forethought" is not persuasive. 9 TTABVue 8. While some care may be taken in purchasing cosmetics, it does not rise to the level to obviate likely confusion where, as here, the goods are closely related and the marks, as discussed *infra*, highly similar. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993) (indicating that "even sophisticated purchasers can be confused by very similar marks").

#### *Similarity/Dissimilarity of the Marks*

We consider Applicant's mark SUPER SHOCK SHADOW and Registrant's mark SUPERSHOCK and compare them "in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). The marks "must be considered ... in light of the fallibility of memory ...." *St. Helena Hosp.*, 113 USPQ2d at 1085 (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Indus.*,

*Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

The first part of Applicant's mark incorporates the entirety of Registrant's mark and is identical save for the space in Applicant's mark, which has no effect in distinguishing them. *Stock Pot, Inc. v. Stockpot Rest., Inc.*, 220 USPQ 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."). *See also Seaguard Corp. v. Seaward Int'l, Inc.*, 223 USPQ 48, 51 (TTAB 1984) ("[T]he marks 'SEAGUARD' and 'SEA GUARD' are, in contemplation of law, identical [internal citation omitted].") Moreover, consumers are generally more inclined to focus on the first word or wording in a trademark. *Palm Bay v. Veuve Clicquot*, 73 USPQ2d at 1692; *In re Integrated Embedded*, 102 USPQ2d 1504, 1513 (TTAB 2016).

The only other difference between the marks is the addition of the descriptive term SHADOW to Applicant's mark. "[I]n articulating reasons for reaching a conclusion on the issue of confusion, 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 entireties." *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985); *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 110 USPQ2d at 1161. Although there is no mechanical test to select a "dominant" element of a compound word mark, consumers would be more likely to perceive a fanciful or arbitrary term, rather than

a descriptive or generic term, as the source-indicating feature of the mark. *See, e.g., In re Dixie Rests., Inc.*, 41 USPQ2d at 1533-34 (affirming TTAB's finding that "DELTA," not the disclaimed generic term "CAFE," is the dominant portion of the mark THE DELTA CAFE); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (finding that "BINION'S," not the disclaimed descriptive wording "ROADHOUSE," is the dominant portion of the mark BINION'S ROADHOUSE). Accordingly, if two marks for related goods or services share identical or similar dominant features and the marks, when viewed in their entireties, create similar overall commercial impressions, then confusion is likely. *See, e.g., In re Cynosure, Inc.*, 90 USPQ2d 1644 (TTAB 2009) (holding CYNERGY for medical lasers for, *inter alia*, treatment of the face and skin, and SYNERGIE PEEL for medical devices for microdermabrasion, likely to cause confusion, noting that "SYNERGIE" is the dominant portion of the cited mark and "PEEL" is insufficient to distinguish the marks).

Applicant asserts that "inclusion of the word SHADOW creates an overall commercial impression that negates a finding of confusing similarity." 9 TTABVUE 7. However, the word SHADOW in Applicant's mark does not alter the connotation or commercial impression to sufficiently distinguish SUPER SHOCK SHADOW from SUPERSHOCK. *Cf. Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (THE RITZ KIDS for gloves conveys different commercial impression from RITZ for barbeque mitts). It simply describes what the goods are. The addition of SHADOW to Applicant's mark, as used for "Eye shadow, eye shadow pigments, pigment powders for cosmetic use" could lead consumers to believe that

SUPERSHOCK has expanded its product line of mascara to include eye shadow. We find that, viewed as a whole, the similarities between the marks in appearance, sound, connotation and commercial impression, due to the common and dominant elements SUPERSHOCK and SUPER SHOCK, outweigh the dissimilarities. *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 110 USPQ2d at 1161. In view thereof, the *du Pont* factor of the similarity of the marks also favors a finding of likelihood of confusion.

*Balancing the Factors*

In conclusion, because the marks are similar, the goods are related, and the channels of trade and consumers overlap, we find that confusion is likely between Applicant's mark SUPER SHOCK SHADOW and the mark SUPERSHOCK in the cited registration.

**Decision:** The refusal to register based on likelihood of confusion under Section 2(d) of the Trademark Act is affirmed.

The refusal to register absent a disclaimer for SHADOW under Section 6 of the Trademark Act is affirmed. However, if Applicant submits the required disclaimer within 30 days of the mailing date of this decision, the decision as to the disclaimer requirement will be set aside, but the application will not be passed to publication in view of the decision under Section 2(d). If the disclaimer is submitted, the wording will read as follows: No claim is made to the exclusive right to use "SHADOW" apart from the mark as shown. *See* TMEP § 1213.08(a)(i).