

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Clinique Laboratories LLC

v.

Absolute Dental, LLC

Opposition No. 91181263
against Serial No. 76663928

Barbara A. Solomon and Jason D. Jones of Fross Zelnick Lehrman
& Zissu, P.C. for Clinique Laboratories LLC.

Jacque M. Ramos of J. Ramos Law Firm P.L.L.C. and Bradley L.
Booke of Moriarity Badaruddin & Booke for Absolute Dental,
LLC.

Before Quinn, Bucher and Kuhlke, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Absolute Dental, LLC seeks registration on the
Principal Register of the mark **CLINIQUE DENTIQUE** (*in
standard character format*) for "restorative, cosmetic and
family dentistry services" in International Class 44.¹

¹ Application Serial No. 76663928 was filed on August 1, 2006 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The application as filed misidentified applicant as "Absolute Dental Cheyenne, Inc.," when it should have been simply "Absolute Dental, Inc." As a result of a subsequent reorganization (in 2008), applicant was reorganized by dissolution and merger into "Absolute Dental, LLC," the current applicant and party defendant in this proceeding.

Clinique Laboratories LLC (hereinafter Clinique or opposer) opposed this application on the grounds that, as applied to applicant's services, the mark so resembles opposer's previously used and registered famous **CLINIQUE** marks used on related goods and services, as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. § 1052(d). In addition, opposer alleges that applicant's mark dilutes and/or is likely to dilute the distinctive quality of opposer's marks under Trademark Act Section 43(c), 15 U.S.C. § 1125.

By its answer applicant denies the salient allegations.

EVIDENTIARY ISSUES

As a preliminary matter, we note that several of applicant's earlier motions to strike Internet documents² as being irrelevant, cumulative, misleading and hearsay, objections to two printed publications on hearsay grounds, and an objection to the testimony of Mr. Ortiz and the attached documents on hearsay grounds, have been deferred until final decision.³ The parties fully briefed these

² The Board has already clarified that opposer's submission of Internet Documents is permitted under the Trademark Rule of Practice and *Safer Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010).

³ See Board order of July 14, 2010 [TTABVUE #70] at 6-8.

substantive issues in earlier submissions. (See TTABVUE ##44-49, 52-54).

All of these submissions are relevant to *du Pont* factors assessing the nature of applicant's services and the relatedness of the parties' goods and services. As to any hearsay objections, we find that the involved documents are being offered for "what they show on their face," not for the truth of the statements contained therein. TBMP § 704.08 (2d ed. rev. 2004). As to the documents attached to Mr. Ortiz's declaration, these same documents have also been timely submitted pursuant to opposer's Notice of Reliance on Internet documents, filed on March 26, 2010. As to Mr. Ortiz's declaration, he certainly has knowledge of how he searched for the web pages and printed them out. He was not presented as an expert on exactly how the Google search engine produced his search results, and did not testify about the actual operations of the third-party, website owners. Hence, all of this evidence has been considered in making our final determination.

EVIDENCE OF RECORD

The evidence of record consists of the pleadings herein and the file of the subject application. The parties stipulated that documents produced in discovery from their respective files should be deemed authentic business records,

and that the parties could submit direct trial testimony by declaration, subject to the opposing party's right to take oral cross-examination. Accordingly, the combined trial record includes the following:

- (1) The March 10, 2010, trial declaration of Agnes M. Landau, opposer's Senior Vice President for Global Marketing, with Exhibits PX 1- PX 26 as referenced therein;
- (2) The March 8, 2010, trial declaration of Lesley Moradian, opposer's Vice President and Senior Trademark Counsel, with Exhibit PX 27 as referenced therein;
- (3) The March 9, 2010, Trial Declaration of Mario Ortiz, a paralegal with the firm of Fross Zelnick Lehrman & Zissu, P.C., with Exhibits PX 28(a)-PX 28(o) and PX 29 as referenced therein;
- (4) The March 4, 2010, Trial Declaration of Dr. Gerald L. Ford, a named partner in the marketing research firm of Ford Bubala & Associates, with Exhibits A-D referenced therein, and the June 30, 2010, Rebuttal Trial Declaration of Dr. Ford, with new Exhibits A-D as referenced therein;
- (5) Opposer's March 26, 2010, Notice of Reliance on Applicant's deposition and discovery responses, printed publications, registrations, official records and Internet documents, as well as the May 3, 2010,

Corrected Notice of Reliance of printed publications and Internet documents with Exhibits PX 30-46 as referenced therein;

- (6) Opposer's July 13, 2010, Rebuttal Notices of Reliance on applicant's deposition and discovery responses, printed publications, official records, Internet documents, with Exhibit PX 47-52 as referenced therein;
- (7) The May 15, 2010, Trial Declaration of Michael Alterman, DDS, applicant's co-owner and managing dentist, with applicant's Exhibits DX 8 as referenced therein;
- (8) The May 15, 2010, Trial Declaration of Dr. Bruce Isaacson, owner and President of MMR Strategy Group, with his Exhibits 1-3 as referenced therein; and
- (9) Applicant's May 31, 2010, Notices of Reliance on Official Records, Opposer's Deposition and Discovery Responses, and additional excerpts of applicant's depositions and discovery responses, with Exhibits DX 9-15 as referenced therein.

STANDING / PRIORITY

Opposer made of record its pleaded registrations, all of which are in full force and effect and owned by opposer. The most relevant registrations are summarized as follows:



for "cleansing cream" in International Class 3;⁴

CLINIQUE

for "facial soap" in International Class 3;⁵



for "cosmetic creams, lotions and oils-namely, cleansing creams, lotions and oils; moisturizing lotions and creams; make-up-namely, face powder, foundation make-up bases; rouges; eye make-up preparations-namely, mascara, eye liner, eye shadow, eyebrow pencil, and eye makeup remover; lipsticks; antiperspirants; hair sprays" in International Classes 3 and 5;⁶

CLINIQUE

for "astringent" in International Class 3;⁷



for "skin beauty consulting services" in International Class 42;⁸

⁴ Registration No. 0859445 issued on October 29, 1968; second renewal.

⁵ Registration No. 0878877 issued on October 14, 1969; second renewal.

⁶ Registration No. 0892987 issued on June 16, 1970; third renewal.

⁷ Registration No. 0904834 issued on December 22, 1970; third renewal.

⁸ Registration No. 1417809 issued on November 18, 1986; renewed. The word "Clinique" means "clinical" in French. The mark is registered under Section 2(f) of the Act.

CLINIQUE SKIN SUPPLIES FOR MEN	for "face soap, skin lotions, shave cream, bronzers, face scrubs, blemish touch stick, shampoos and anti-perspirant deodorants" in International Class 3; ⁹
CLINIQUE WRAPPINGS	for "personal fragrances, namely, cologne and perfume" in International Class 3; ¹⁰
CLINIQUE	for "cosmetics - namely, cleansers, moisturizers, face tonics, face masks, face powder, foundation, blushers, mascara, eyeshadow, eyeliner, eyemakeup remover, lipstick, lip pencil, nail enamel, nail treatment, sun block, after sun balm, hair spray, deodorant and anti-perspirant, perfume and cologne" in International Class 3; ¹¹
<u>chemistry</u> CLINIQUE	for "colognes" in International Class 3; ¹²
CLINIQUE	for "retail stores featuring cosmetics, toiletries, perfumes, and beauty treatment" in International Class 35; "consultation in the selection and use of cosmetics, toiletries, perfumes, and beauty treatment" in International Class 42; ¹³
CLINIQUE HAPPY	for "perfumes, perfume sprays, colognes" in International Class 3; ¹⁴
CLINIQUE MOISTURE IN CONTROL	for "skin care lotions" in International Class 3; ¹⁵

⁹ Registration No. 1548810 issued on July 25, 1989; renewed. No claim is made to the exclusive right to use the words "skin supplies for men" apart from the mark as shown.

¹⁰ Registration No. 1589615 issued on April 3, 1990; second renewal.

¹¹ Registration No. 1626589 issued on December 11, 1990; second renewal.

¹² Registration No. 1921399 issued on September 26, 1995; renewed.

¹³ Registration No. 2165411 issued on June 16, 1998; renewed.

¹⁴ Registration No. 2191594 issued on September 22, 1998; renewed.

CLINIQUE BROW KEEPER	for "cosmetics, namely, brow pencil" in International Class 3; ¹⁶
CLINIQUE MOISTURE SHEER	for "cosmetics" in International Class 3; ¹⁷
CLINIQUE DEWY SMOOTH	for "cosmetics" in International Class 3; ¹⁸
CLINIQUE HAPPY	for "toiletries, namely body creams, lotions, body washes and aftershave" in International Class 3; ¹⁹
CLINIQUE HAPPY HEART	for "perfumery, namely cologne, eau de parfum, eau de toilette, essential oils for personal use and perfume; toiletries, namely, body cleansers, body creams, body exfoliating preparations, body lotions, body washes" in International Class 3; ²⁰
CLINIQUE CX	for "non-medicated skin care preparations" in International Class 3; "medicated skin care preparations" in International Class 5; ²¹
CLINIQUE SUPERBALANCED	for : "cosmetics" in International Class 3; ²²

¹⁵ Registration No. 2203237 issued on November 10, 1998; renewed.

¹⁶ Registration No. 2307979 issued on January 11, 2000; renewed. No claim is made to the exclusive right to use the word "brow" apart from the mark as shown.

¹⁷ Registration No. 2650608 issued on November 12, 2002; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

¹⁸ Registration No. 2707917 issued on April 15, 2003; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

¹⁹ Registration No. 2734904 issued on July 8, 2003; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

²⁰ Registration No. 2783299 issued on November 11, 2003; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

²¹ Registration No. 2886914 issued on September 21, 2004; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

CLINIQUE HAPPY TO BE

for "perfumery, namely cologne, *eau de parfum, eau de toilette*, essential oils for personal use and perfume; toilettries namely, bath oils, bath powders, bath salts, body cleansers, body creams, body exfoliating preparations, body lotions, body washes, body powders, body scrubs, body toners, body washes, hair conditioners, hair revitalizing treatments, hair shampoos, hand creams, personal soaps, salt scrubs for the skin and shaving foams, creams, lotions and gels" in International Class 3;²³

CLINIQUE SIMPLY

for "perfumery, namely, perfume, after shave lotions, gels, and balms, cologne, *eau de perfume, eau de toilette*, essential oils for personal use, fragranced body creams, gels and lotions; skin care preparations, namely, bath powders, body cleansers, body creams, body lotions, and body washes" in International Class 3;²⁴

CLINIQUE QUICKLINER

for "color cosmetics, namely lip liners and eye liners" in International Class 3;²⁵

clinique happy
holiday.



for "perfumery, namely cologne, *eau de parfum, eau de toilette*, essential oils for personal use and perfume" in International Class 3;²⁶

²² Registration No. 2916548 issued on January 4, 2005; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

²³ Registration No. 2979695 issued on July 26, 2005.

²⁴ Registration No. 3071667 issued on March 21, 2006.

²⁵ Registration No. 3156540 issued on October 17, 2006.

²⁶ Registration No. 3225758 issued on April 3, 2007.

**CLINIQUE HAPPY IN
BLOOM**

for "perfumery, namely cologne, eau de parfum, eau de toilette, essential oils for personal use and perfume; toilettries namely, body creams, body exfoliating preparations, body lotions, body washes" in International Class 3;²⁷

**CLINIQUE DERMA
WHITE**

for "cosmetics, namely, compacts containing makeup, concealers, cover-up cream, face powder, foundation makeup, skin care preparations, namely cleansing lotions, cleansing creams, eye creams, eye gels, face creams, face lotions, face masks, facial cleansers, facial emulsions, facial exfoliating preparations, facial moisturizers, facial soaps, hand creams, skin brighteners, skin lighteners, cosmetic sun-protecting preparations" in International Class 3;²⁸ and

CLINIQUE

for "online retail store services offered via a global communication network featuring personal care products, cosmetics, toilettries, perfumery, bath and body products, skin care products and hair care products; retail store services featuring personal care products, cosmetics, toilettries, perfumery, bath and body products, skin care products, hair care products and beauty treatments; Mail order services featuring personal care products, cosmetics, cosmeceuticals, toilettries, perfumery, bath and body products, medicated and non-medicated skin care preparations and hair care products" in International Class 35; "beauty consultation services regarding the selection and use of personal care products, cosmetics, cosmeceuticals, toilettries, perfumery, bath and body products, medicated and non-medicated skin care preparations, hair care products and beauty treatments, color analysis and personal appearance; provision of beauty information

²⁷ Registration No. 3259254 issued on July 3, 2007.

²⁸ Registration No. 3276902 issued on August 7, 2007.

concerning color analysis, personal care products, cosmetics, cosmeceuticals, toiletries, perfumery, bath and body products, medicated and non-medicated skin care preparations, hair care products, beauty treatments and personal appearance; online provision of beauty information via a global communication network regarding the selection and use of personal care products, cosmetics, cosmeceuticals, toiletries, perfumery, bath and body products, medicated and non-medicated skin care preparations, hair care products and beauty treatments, color analysis and personal appearance" in International Class 44;²⁹

Because opposer has made its registrations of record and has shown that the registrations are valid and subsisting and owned by opposer, opposer has established its standing to oppose registration of applicant's mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

Opposer's priority is not in issue as to the marks and goods and services covered by opposer's registrations made of record. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

We turn then to the issue of likelihood of confusion. Our determination of likelihood of confusion must be based upon our analysis of all of the probative facts in evidence

²⁹ Registration No. 3415334 issued on April 22, 2008.

that are relevant to the factors bearing on the issue of likelihood of confusion. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

Opposer has presented argument and evidence on the *du Pont* factor involved with the fame of its marks, and we begin with this factor because fame "plays a 'dominant' role in the process of balancing the *du Pont* factors." *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). "[T]he fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). However, "[b]ecause of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it." *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901 (TTAB 2007).

The **CLINIQUE** marks have been used in the United States since 1968. Opposer has used this mark continuously on every product, advertisement, marketing and promotional item, press release, retail location that sells **CLINIQUE** branded products, point of purchase material at Clinique counters, and business card for Clinique employees. Landau Decl. ¶¶ 8-10. Opposer has used and registered its marks in connection with a wide variety of skin care products, make-up, color cosmetics, and fragrances for consumers of all ethnicities and skin types, including a line of **CLINIQUE** products for men. *Id.* ¶ 11. As shown through the testimony and other evidence, opposer has had and continues to have extensive sales under and advertising expenditures in connection with its **CLINIQUE** marks.³⁰ Suffice it to say that since 2005, **CLINIQUE** has been ranked #1 in sales in the prestige skin care market in terms of units and dollar sales - more than double the combined sales of #2 Estee Lauder and #3 Lancôme. *Id.* ¶¶ 11 and 21. Moreover, opposer's advertising and sales statistics are presented in the context of a broad, organized and aggressive marketing strategy that places its marks in front of consumers in a variety of ways (e.g., national magazines and newspapers with wide circulation, television and feature films, celebrity endorsements, celebrity photographs in magazines, on the

³⁰ The exact figures were submitted under seal.

Internet and outdoor media). *Id.* ¶¶ 46-56, 69-71. In addition, inasmuch as opposer's marks are the subject of significant "unsolicited placements, that create over [one] billion media impressions per year, the **CLINIQUE** mark receives even broader exposure and extremely high levels of commercial awareness." *Id.* ¶ 59. The record also includes a 2002 article published in "Women's Wear Daily" (WWD), the fashion industry trade magazine, which ranked **CLINIQUE** as the #1 brand in both categories of prestige makeup and prestige skin care products. See Exhibit PX 23.

As part of its regular course of business activity, in 2008, opposer commissioned the Ipsos Marketing research firm to conduct a brand awareness survey relating to facial skin care and make-up products, including **CLINIQUE**. While the exact levels of unaided and aided awareness of the **CLINIQUE** brand on the part of relevant consumers were submitted under seal, both numbers are quite impressive. In its August 2009 publication, among a WWD survey of buyers in this prestige market, Clinique placed first with 14.3% of respondents having purchased **CLINIQUE** products during the first six months of 2009. See Exhibit PX 25. In fact, other than quibbling about whether opposer's made for litigation survey shows fame among dental patients (applicant's brief at 16-17), we note that applicant does not dispute or rebut opposer's evidence of fame as outlined above.

On this record, we find that opposer has more than fulfilled its duty to establish that its **CLINIQUE** marks are extremely famous and have been a fashion fixture for decades in the United States. Based upon this finding, we accord the **CLINIQUE** marks a very wide scope of protection.

We turn then, to consider the *du Pont* factors of the relatedness of the goods and services, channels of trade and classes of purchasers. We must make our determinations under these factors based on the goods and services as they are identified in the respective registrations and application. See *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ["The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed."]

We agree with opposer that both parties are offering goods and services that are intended to enhance a person's appearance. Opposer's **CLINIQUE** mark is registered for a wide variety of goods and services relating to enhancing a person's appearance, namely cosmetics, lotions and soaps, and

consultation services concerning beauty treatments and personal appearance. Undeniably, applicant's services of "restorative, cosmetic and family dentistry" to be offered under its **CLINIQUE DENTIQUÉ** mark, such as teeth whitening services, for example, have a "cosmetic" purpose.

Applicant is correct in noting that opposer is not a dental company, but that does not negate the fact that the parties are offering services and/or goods that can serve similar functions. In fact, opposer notes that it is offering a low-cost, competitive alternative to applicant's intended **CLINIQUE DENTIQUÉ** branded teeth whitening services. In 2008, opposer teamed up with a dentist to identify which of its existing lipstick shades had the effect of making teeth appear whiter. Since 2009, opposer has offered, under the **CLINIQUE** mark, its "Lip Collection for Whiter Teeth," a collection of lipsticks that are designed to enhance a person's smile by making the user's teeth appear whiter. To the extent that these lipsticks give the appearance of whiter teeth, **CLINIQUE** considers these lipsticks to be, or to be related to, a "dental service." (Landau Decl. ¶ 27). In fact, in the January 2010 issue of *In Style*, the magazine profiled opposer's Lip Collection for Whiter Teeth, stating: "Don't tell your *dentist*, but the secret to a gorgeous grin could be in your make-up bag." Exhibit PX 48. Clearly both

parties are offering (or intend to offer) products or services under their respective **CLINIQUE** and **CLINIQUE DENTIQUÉ** marks that have the same end goal - enhancing a person's smile and enhancing a person's appearance.

Furthermore, the record shows that cosmetic companies are branching out and partnering with medical and dental services, as opposer has done with its **CLINIQUE MEDICAL** product line. Other third-party evidence in the record shows that, for example, Elizabeth Arden has branched out to provide consumers with cosmetic medical treatments such as Botox, Restylane, and Juvéderm injections at its Red Door Spas. Exhibit PX 46(j). Medi-Spas offer one-stop shopping where consumers can, at a single facility, buy cosmetics and skin care products, receive skin care services (such as facials), and also receive cosmetic medical services ranging from Botox injections to cosmetic dental services such as teeth whitening. Landau Decl. ¶ 80. Various BriteSmile Brite Skin Med Spas advertise that patients can receive cosmetic dentistry and teeth whitening services, cosmetic medical services such as Botox and Restylane injections, cosmetic services such as facials and also purchase skin care products from the PRIORI skin care product line. Exhibit PX 46(d); and Ortiz Decl. ¶ 2(a). The Essence MediSpa in Highland, New York, advertises European facials,

eye treatments, and massages, as well as teeth whitening services and Botox injections. Exhibit PX 46(e) and Ortiz Decl. ¶ 2(b). The Re:vive Salon & Spa in San Diego, California, advertises cosmetics from the prestige skin care and make-up brand BARE ESCENTUALS and dentist-performed cosmetic teeth whitening services. Exhibit PX 46(f) and Ortiz Decl. ¶ 2(c). According to advertisements for the Platinum Skin Care & Medi Spa in Chesterfield, Michigan, customers can get Botox injections, can get their teeth whitened using the Brite White system, can receive facials, and can purchase skin care products from the Platinum Skin Care line of cosmeceuticals. Exhibit PX 46(g) and Ortiz Decl. ¶ 2(d). The Spa at Monmouth Beach in Monmouth Beach, New Jersey, advertises that consumers can receive facials and skin care services, have make-up applications, and have their teeth whitened. Exhibit PX 46(g) and Ortiz Decl. ¶ 2(e). The New Image Med Spa in Columbus, Georgia, promotes in its ads both JANE IREDALE cosmetics, and Beyond WhiteSpa laser teeth whitening. Exhibit PX 46(h) and Ortiz Decl. ¶ 2(f).

We agree with opposer that the above evidence shows that consumers have come to expect that cosmetic companies such as Clinique will branch out into other fields and services that are complementary to their current product offerings. This logic is demonstrated by opposer's

likelihood of confusion survey, when a respondent explained why she thought the **CLINIQUE DENTIQUE** mark was associated with opposer: "**Clinique** ... That is the name of a cosmetics company [and] they are probably branching out."

Applicant's recitation of services does not limit its services to the high end of the market. In fact, its testimony emphasizes that its purchasers would include ordinary members of the general public. The applicable standard of care is that of the least sophisticated purchaser of the goods or services. *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020 (TTAB 2009); *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301 (TTAB 2004). Thus, the conditions of sale include less sophisticated consumers exercising a lower level of care. Additionally, the record shows that even some of opposer's prestige products are available online at fairly low price points.

This compelling evidence of relatedness surpasses that found in many cases that appear before this Board. Hence, all of these related factors favor opposer.

Against this backdrop, specifically, the extreme fame of opposer's marks and the related nature of opposer's goods and/or services to applicant's services, we consider the similarities and dissimilarities of the marks. *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350,

22 USPQ2d 1453, 1456 (Fed. Cir. 1992) ["A strong mark ... casts a long shadow which competitors must avoid. ... Thus, the Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark's fame increases, the Act's tolerance for similarities in competing marks falls."]; *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1904 (Fed. Cir. 1989), quoting, *Planter's Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962) [" ... there is 'no excuse for even approaching the well-known trademark of a competitor'"].

We examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods or services offered under the respective marks is likely to result.

It is applicant's contention that the respective marks have radically different connotations and convey significantly different commercial impressions. Applicant argues that opposer overemphasizes the dominance of the word

"Clinique" while underplaying the role of the word "Dentique." While the word "Clinique" in its mark merely describes a dental "clinic" location, and should be deemed descriptive or non-distinctive, applicant argues that the word "Dentique" is a fanciful element of the mark coined by Dr. Alterman because applicant's specialized dental services are offered in a "boutique environment." From this brief postulation, applicant concludes that **CLINIQUE DENTIQUE**

... conjures images of a mood lit, private, clinical atmosphere with ultra-comfortable dental chairs and stylish dentists aimed at providing relaxing and invigorating dental services. It evokes the image of a place where one doesn't clench in fright at the piercing sound of drilling or the stark white walls of a surgical suite, but rather, a welcoming place where anxiety melts away and a patient emerges with cleaner and whiter teeth from dental treatments and services.

Applicant's two word mark, as filed, contains, as its first word opposer's famous and inherently distinctive **CLINIQUE** mark. While applicant has added the word "Dentique" to opposer's **CLINIQUE** mark, opposer contends that this does not create a sufficiently dissimilar mark so as to avoid a likelihood of confusion. Indeed, our case law states that "[i]f a junior user takes the entire arbitrary mark of another, addition of a suggestive or descriptive element is generally not sufficient to avoid confusion." 4 *McCarthy* § 23:50 at 23-214. Yet, here applicant has appropriated the inherently distinctive and famous **CLINIQUE**

mark *in its entirety* and merely added the word **DENTIQUE** – a word that is certainly suggestive or descriptive of the dental services applicant intends to offer in a *boutique* environment. (Alterman Decl. ¶ 3). See *Palm Bay Imps.*, 73 USPQ2d at 1692 [**VEUVE ROYALE** likely to be confused with **VEUVE CLIQUOT** because the presence of the “strong distinctive term [**VEUVE**] as the first word in the parties marks renders the marks similar.”]

Consistent with this black letter law, the survey results opposer has placed into the record (more about that later) make it clear that these marks are considered similar by prospective consumers, and that applicant’s addition of the term **DENTIQUE** to the end of opposer’s **CLINIQUE** mark does *not* serve to alleviate confusion. In fact, these overwhelming survey results suggest that applicant’s adopted mark may create *more* confusion by suggesting that opposer may have affiliated itself with a company that provides these cosmetic dentistry services. Accordingly, the *du Pont* factor involving the similarity of the marks weighs heavily in favor of opposer.

Moreover, as noted above, famous marks are “entitled to a broader scope of protection than one which is relatively unknown ... because the issue in a trademark registration conflict such as this is the likelihood that, because of the

marks used on the involved goods, there will be confusion, mistake or deception as to the source of those goods and confusion is more likely to occur where a mark is very well known or even famous because there is a propensity of consumers to associate a little-known mark with one which is familiar to them." *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1900 (TTAB 1989).

Although applicant has attempted to narrow the protection of opposer's mark based upon two third-party registrations,³¹ we find no probative evidence supporting such a conclusion, and this *du Pont* factor is, at best for applicant, a neutral factor.

As to the factor of actual confusion, inasmuch as the record shows that there has not been a meaningful opportunity for such confusion to have occurred between opposer's and applicant's marks, we consider this factor, as well, to be neutral.

Finally, in support of its case, opposer submitted a likelihood of confusion survey conducted for the **CLINIQUE**

³¹ In addition to the fact that we cannot know whether either of these registered mark were actually in use or whether any consumers were exposed to them, Registration No. 2829861 for the mark **MK DENTAL CLINIQUE** registered in 2004 in connection with general and cosmetic dentistry, but has been cancelled under Section 8 of the Act. Registration No. 3212028 for the mark **CLINIQUE LA PRAIRIE**, which registered in 2007 in connection with real estate development and management services, has no relevance to the goods and services involved herein.

DENTIQUE mark for use in connection with restorative, cosmetic and family dentistry services. Based on the results of this survey, opposer asserts that it strongly supports a finding of likelihood of confusion.

We accept, and applicant has not disputed, the competence of opposer's survey expert, Dr. Gerald L. Ford, a recognized expert in the field of marketing and market research who has testified frequently in likelihood of confusion cases in federal district courts all across the nation. In this case, Dr. Ford designed a mall intercept survey involving interviews with four-hundred thirty-two respondents at shopping malls in eight geographically dispersed metropolitan areas. According to Dr. Ford, the survey indicates that "the net measured likelihood of confusion of approximately thirty-six percent (35.64%) is attributable solely to the presence of the **CLINIQUE** portion of Applicant's proposed **CLINIQUE DENTIQUE** mark." Ford Amended Test. Dep. ¶ 41.

In understanding the relevance of a particular percentage, courts and the Board find likelihood of confusion when a "substantial" or "appreciable" number of consumers are likely to be confused. In analyzing percentage numbers then, courts will extrapolate a percentage to the actual number of potentially confused

consumers. In any case, thirty-six percent represents a substantial number of potential consumers, based on the class of consumers being those members of the public interested in enhancing their personal appearance, or even, based on opposer's annual sales. *James Burrough, Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 192 USPQ 555, 565 (7th Cir. 1976) ["We cannot agree that 15% is 'small.' Though the percentage of likely confusion required may vary from case to case, we cannot consider 15 percent, in the context of this case, involving the entire restaurant-going community, to be *de minimis*."] See also *Humble Oil & Refining Co. v. American Oil Co.*, 405 F.2d 803, 160 USPQ 289, 299 (8th Cir. 1969), cert. denied, 395 U.S. 905 (1969) ["Despite all this, the surveys, singly and as a group, do not dispel the existence of a percentage of confusion which we may not dismiss as *de minimis*. The percentage figure varies from 11% to as high as 49%. The lower figure itself is not an insignificant percentage. The record discloses that the number of motorists in the Midwest is in the millions. Eleven percent of a figure in the millions is a large number."]

Dr. Ford explains the significance of the survey results when compared to the results of the control group:

Specifically, the survey results make clear that the causal nexus for likelihood of confusion is Applicant's use of **CLINIQUE** in Applicant's **CLINIQUE DENTIQUE** mark and

is not due to any other alternative explanation. Because the control cell, using the **BOUTIQUE DENTIQUÉ** mark, also employed the same list of services (restorative, cosmetic and family dentistry services) and asked the same survey questions, and resulted in less than six percent (5.56%) likelihood of confusion with opposer's Clinique, it is certain that the measured likelihood of confusion is attributable solely to the presence of the **CLINIQUE** portion of Applicant's proposed **CLINIQUE DENTIQUÉ** mark. Conversely, the survey results also make clear that the use of a dissimilar mark in conjunction with the list of Applicant's specified services is not likely to cause confusion. Ford Amended Test. Dep. ¶ 13.

Applicant has retained its own survey expert to attack the probative value of opposer's made-for-litigation survey, contending that Dr. Ford's work product suffers from several flaws in methodology and administration, including utilizing a suggestive and leading research design, numerous vague questions, a questionable control, and problematic coding methods.

However, we find that opposer's survey was carefully constructed to mirror the so-called *Ever-Ready*³² survey format. See *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125, 1132 (TTAB 1995); and *Miles Laboratories, Inc. v. Naturally Vitamin Supplements, Inc.*, 1 USPQ2d 1445 (TTAB 1986). This survey is consistent

³² In *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 188 USPQ 623 (7th Cir. 1976), cert. denied, 191 USPQ 416 (1976), the plaintiff conducted a survey to determine whether there was a likelihood of confusion between defendant's EVER-READY lamps and plaintiff Union Carbide's EVEREADY batteries, flashlights and bulbs. The survey asked: "Who do you think puts out the lamp shown here? [showing a picture of defendant's EVER-READY lamp and mark]," and "What makes you think so?" *Id.* at 640.

with those accepted in our established precedent on *Ever-Ready* type trademark surveys.

Specifically, we find that Dr. Ford's 6- and 7-series of questions³³ parallels the precise formats approved in *Ever-Ready* and *Carl Karcher*. The survey was conducted well within the parameters of the likelihood of confusion survey formats previously accepted by this Board. See *Starbucks U.S. Brands LLC v. Ruben*, 78 USPQ2d 1741 (TTAB 2006). Thus, we find that it is reliable and has probative value on the issue of likelihood of confusion as to the **CLINIQUE DENTIQUE** mark used in connection with restorative, cosmetic and family dentistry services. *Id.* at 1753.

Although applicant criticizes Dr. Ford for making the word "cosmetic" continuously visible on the stimulus card to the interviewee, we note that opposer's survey expert merely adopted verbatim applicant's recitation of services. This is entirely consistent with Board practice and the progeny of the *Ever-Ready* decision over more than three decades.

The parties are also at odds over the question of whether the fictitious mark used on the control cell card, **BOUTIQUE DENTIQUE**, was an appropriate choice. While applicant's expert criticized Dr. Ford's choice, we find it

³³ (Question 6.0) [On seeing the test cell card or control cell card]: "Who, or what company, do you believe owns or operates this business?"
(Question 6.1) "Why do you say that?"
(Question 6.2) "What, if anything, can you tell me about INSERT RESPONSE TO Q6.0 ?"

an appropriate choice to eliminate any noise from the survey, and certainly find greater weaknesses in the alternatives thrown out by applicant's expert and counsel.

Next, we note that consistent with *Ever-Ready*, opposer's 8- and 9-series questions were designed to elicit responses concerning authorization/approval and affiliation/connection. While these types of questions were not expressly addressed in *Ever-Ready*, a leading commentator³⁴ suggests, and court opinions have found,³⁵ that authorization and affiliation queries are appropriate in light of the specific language of the Lanham Act.

Additionally, each series of the survey questions contain the follow-up question: "Why do you say that?" (e.g., 6.1, 7.1, 8.2 and 9.2). The answers given to these follow-up questions persuade us that the respondents were not merely reading the stimulus card, guessing or trying to please the interviewer.

³⁴ See e.g., 6 J.Thomas McCarthy, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION*, § 32:175 (4th ed. 2011).

³⁵ See e.g., *McDonald's Corp. v. McBagel's, Inc.*, 649 F.Supp. 1268, 1 USPQ2d 1761 (S.D.NY 1986); *James Burrough Limited v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 192 USPQ 555, 564 (7th Cir. 1976); *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F.Supp. 651, 215 USPQ 175, 181-83 (W.D.Wash. 1982); *Pebble Beach Co. v. Tour 18 I. Ltd.*, 155 F.3d 526, 48 USPQ2d 1065, 1076-77 (5th Cir. 1998); *Indianapolis Colts, Inc. v. Metropolitan Baltimore Football Club Ltd. Partnership*, 34 F.3d 410, 31 USPQ2d 1811, 1816 (7th Cir. 1994); and *Anheuser-Busch. Inc. v. Balducci Publications*, 28 F.3d 769, 31 USPQ2d 1296 (8th Cir. 1994).

Rather, given the way in which this survey format carefully follows the *Ever-Ready* survey format, we find that it is reliable and therefore of probative value on the issue of likelihood of confusion herein.

Applicant also takes issue with opposer's classification of certain responses as belonging in the category of those indicating a clear connection to Clinique. While we do not agree with applicant's characterization, even if we were to subscribe to applicant's allegations that weak indicators of confusion were coded in opposer's favor, a somewhat reduced net percentage would still clearly be recognized by courts as supporting a finding of likelihood of confusion. *Grotian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 365 F. Supp. 707, 180 USPQ 506, 513 (S.D.N.Y. 1973), modified, 523 F.2d 1331, 186 USPQ 436 (2d Cir. 1975) [8.5% sufficient to show likely confusion between the marks **STEINWAY** and **STEINWEG** for piano consumers].

After carefully reviewing Dr. Ford's survey design and results, we find that the numerous "flaws" that applicant alleges weaken the survey's value are not flaws at all, or would cause only a minor diminution in the compelling showing of likelihood of confusion found in the results of this survey.

We note, in conclusion, that the survey serves to corroborate what the other evidence of record demonstrates. Thus, although we find the survey proper, probative, and even compelling, it should not be viewed in the context of this overall case as solely determinative of the outcome.

As to the factor of intent, opposer argues that applicant had a bad faith intent³⁶ to trade on the goodwill of Clinique. *J & J Snack Food Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). Opposer contends that applicant's self-serving denial of any intent to copy opposer's **CLINIQUE** mark is not credible in light of the overwhelming fame of its **CLINIQUE** mark.

Bad faith, or intent to confuse, falls under the thirteenth *du Pont* factor "any other established fact probative of the effect of use." *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1890 (TTAB 2008). "[W]hen there is evidence of an applicant's intent to adopt a mark that suggests to purchasers a successful mark already in use by another, the Board may, and ought to, take into account that intent when resolving the issue of likelihood of confusion when that issue is not free from doubt." *First*

³⁶ At points, applicant seems to confuse allegations of bad faith adoption by a junior party with the unrelated issue of whether applicant possessed a *bona fide* intention to use the mark in commerce, as required by Section 1 of the Lanham Act. Applicant's brief at 26-27.

International Services Corp. v. Chuckles Inc., 5 USPQ2d 1628, 1633 (TTAB 1988). See also *Roger & Gallet S.A. v. Benice Trading Co. Inc.*, 1 USPQ2d 1829, 1832 (TTAB 1987).

However, "an inference of 'bad faith' requires something more than mere knowledge of a prior similar mark." *Sweats Fashions, Inc. v. Pannill Knitting Co., Inc.*, 833 F.2d 1560, 1565, 4 USQP2d 1793 (Fed. Cir. 1987). See also, *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1310 (Fed. Cir. 1989); and *Ava Enterprises Inc. v. Audio Boss USA Inc.*, 77 USPQ2d 1783, 1787 (TTAB 2006).

This record does not establish that applicant intended to adopt its marks in bad faith. While it seems highly unlikely that applicant was unaware of opposer's **CLINIQUE** marks when applicant adopted its marks - and we appreciate that for opposer's counsel, this was enough to "raise an eyebrow" - we find that it is not sufficient to prove an *intent* to confuse. *Ava Enterprises*, 77 USPQ2d at 1789.

On balance, the relevant *du Pont* factors weigh in favor of a likelihood of confusion. In view of the fame of opposer's **CLINIQUE** marks, the relatedness of the goods and services, channels of trade and classes of customers, and the similarity of the marks, we conclude that there is a

likelihood of confusion between applicant's mark and opposer's **CLINIQUE** marks.

Finally, it is well established that as a newcomer, applicant has both the opportunity and the obligation to avoid confusion, and one who adopts a mark similar to the mark of another for related goods or services does so at his own peril. *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976). This is especially relevant where the senior, established mark is one that is also famous. *Nina Ricci*, 12 USPQ2d at 1904.

Accordingly, opposer has proven its claims of likelihood of confusion under Section 2(d) of the Trademark Act as to the applied-for mark.

In view of our decision on likelihood of confusion, we do not reach the dilution claims brought under Section 43(c).

Decision: The notice of opposition is sustained and registration to applicant is hereby refused.