

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: August 2, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Estee Lauder Cosmetics Ltd.

v.

Ana Maria Alves Casas

—
Opposition No. 91252583
—

Barbara A. Solomon, Jason D. Jones, Daniel M. Nuzzaci, of
Fross Zelnick Lehrman & Zissu PC for Estee Lauder Cosmetics Ltd.

Nicholas D. Wells and Stephen H. Bean, of Legends Law Group PLLC
for Ana Maria Alves Casas.

—
Before Wolfson, Heasley, and Allard,
Administrative Trademark Judges.

Opinion by Allard, Administrative Trademark Judge:

Ana Maria Alves Casas (“Applicant”) seeks registration on the Principal Register
of the mark shown below:

mccosmetics
— NY

for use with “Cosmetics; cosmetic creams for skin care; non-medicated cosmetic creams for body care; sunscreen creams; face and body creams; skin cleansers; non-medicated creams for skin care after laser epilation; massage creams,” in International Class 3.¹ Applicant disclaimed the exclusive right to use the term “NY”. The involved application also identifies various dietary supplements in International Class 5, but they are not at issue in this proceeding.²

In its First Amended Notice of Opposition,³ which was filed pursuant to the parties’ stipulation,⁴ Estee Lauder Cosmetics Ltd. (“Opposer”) alleged rights to numerous registered MAC and MAC-inclusive trademarks for use with various cosmetics and skincare products, including the MAC mark, which is registered in standard character format for a variety of cosmetics, such as lipsticks, mascara, blushers, skin cleansers, and eye creams.⁵

Opposer opposed registration of Applicant’s mark on two grounds: (1) likelihood of confusion with Opposer’s MAC and MAC-inclusive trademarks under Section 2(d)

¹ Application Serial No. 88359609 was filed on March 27, 2019 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s allegation of first use anywhere and use in commerce since at least as early as “20160200”, which is interpreted as February 29, 2016, since 2016 was a leap year. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 903.06 (July 2022) (“When a month and year are given without a specified day, the date presumed for purposes of examination is the last day of the month.”).

² Opposer’s Main brief, p. 27 n.2 (37 TTABVUE 29).

³ 6 TTABVUE 5-138. We refer to this pleading for simplicity as “Amended Notice of Opposition.”

⁴ 6 TTABVUE 2-3.

⁵ Reg. No. 3,023,827, issued on December 6, 2005, registered and renewed.

of the Trademark Act, 15 U.S.C. § 1052(d);⁶ and (2) dilution by blurring under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).⁷

In her Answer to the Amended Notice of Opposition, Applicant denied the salient allegations.⁸

The case is fully briefed.⁹ Opposer bears the burden of proving its claims by a preponderance of the evidence. *See Jansen Enters., Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007). Having considered the evidentiary record, the parties' arguments and applicable authorities, we find that Opposer has carried its burden for purposes of its likelihood of confusion claim and sustain the opposition on this ground. Because

⁶ Amended Notice of Opposition, paras. 19-24 (6 TTABVUE 11-12).

⁷ *Id.* at paras. 25-30 (6 TTABVUE 12-30).

Opposer's Amended Notice of Opposition also included a claim that Applicant's mark is geographically deceptively misdescriptive and should not be registered under Section 2(e)(3) of the Trademark Act, 15 U.S.C. § 1052(e)(3), due to the "NY" element. However, in its trial brief, Opposer acknowledged that it was not pursuing this claim at trial. Opposer's Main brief, p. 28 n.4 (37 TTABVUE 30). Accordingly, it is deemed waived. *See, e.g., Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1426 n.3 (TTAB 2013); *Knight Textile Corp. v. Jones Inv. Co.*, 75 USPQ2d 1313, 1314 n.4 (TTAB 2005) (where opposer presented no arguments in its brief regarding the claim of dilution, opposer was deemed to have waived the claim).

⁸ Answer (10 TTABVUE). After acknowledging that an answer was due but had not been filed, the Board entered a notice of default against Applicant on May 5, 2020. 8 TTABVUE. Applicant subsequently filed a Motion to Set Aside Default (9 TTABVUE) and concurrently filed her Answer to the Amended Notice of Opposition (10 TTABVUE). By Order dated July 23, 2020, the default was set aside and the proceeding resumed. 11 TTABVUE.

⁹ Opposer's main brief was submitted in both redacted and unredacted versions: the publicly available version is at 37 TTABVUE and the confidential version is at 36 TTABVUE. Similarly, Opposer's rebuttal brief was submitted in both redacted and unredacted versions: the publicly available version is at 40 TTABVUE and the confidential version is at 39 TTABVUE.

we find in favor of Opposer on its Section 2(d) claim, we decline to reach Opposer's dilution claim.

I. The Record

The record consists of the pleadings¹⁰ and, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), the file of the involved application. In addition, the parties have made the following evidence of record.

A. Opposer:

- Testimony Declaration of Aida Moudachirou-Rebois, Senior Vice President Global Marketing for Makeup Art Cosmetics, Inc. ("Makeup Art"), and Exhibits PX1–PX25 thereto.¹¹
- Testimony Declaration of Jessica Heiss, Esq., Vice President and Lead Trademark Counsel for Opposer.¹²
- Notice of Reliance on Opposer's Registrations as shown in attached Exhibits PX26–PX39.¹³ This includes, for example, the registration for the MAC (Stylized) mark (Reg. No. 1,642,532).¹⁴

¹⁰ The operative pleadings are Opposer's Amended Notice of Opposition (6 TTABVUE 5-138) and Applicant's Answer to the Amended Notice of Opposition (10 TTABVUE).

Opposer's Amended Notice of Opposition attached as an exhibit printouts of the TSDR status page for each of its pleaded registrations, including the registration for the MAC mark in standard characters. 6 TTABVUE 16-25. Accordingly, they are properly of record. Trademark Rule 2.122(c) and (d), 37 C.F.R. § 2.122(c) and (d).

¹¹ The Declaration of Ms. Moudachirou-Rebois was submitted in both redacted and unredacted versions. The publicly available version is at 26 TTABVUE and the confidential version is at 27 TTABVUE.

Opposer identifies the company as both Makeup Art Cosmetics, Inc. and Makeup Arts Cosmetics, Inc. We refer to the company as Makeup Art Cosmetics, Inc. herein.

¹² 25 TTABVUE.

¹³ 28 TTABVUE.

¹⁴ There appears to be some confusion by both parties about the specific marks forming the bases of Opposer's claim.

First, Opposer's Notice of Reliance includes MAC-inclusive registrations that were not pled in Opposer's Amended Notice of Opposition (the "New Registrations"). However, as Applicant did not object to the New Registrations or move to strike them, we consider the New

- Notice of Reliance on Official Records: (1) a prior, nonprecedential decision by the TTAB in the case of *Estee Lauder Cosmetics Ltd. v. Yung Shin Pharm Ind. Co., Ltd.*, Opp. No. 91191370, 2012 TTAB LEXIS 123 (TTAB 2012) that Opposer asserts is relevant to show the strength and fame of Opposer's MAC and MAC-inclusive marks (PX40);¹⁵ and (2) an Office Action in connection with a third-party's application to register the mark N.Y. GIRL NEW YORK GIRL

Registrations stipulated into the record and any issue relating to them to have been tried by implied consent. *Time Warner Entm't Co. v. Jones*, 65 USPQ2d 1650, 1653 n.2 (TTAB 2002) (where opposer, during trial, filed notice of reliance on seven unpleaded registrations and where applicant did not object thereto, Board found parties had tried by implied consent, any issues arising from those registrations).

The New Registrations are Reg. No. 1,642,532 for MAC (Stylized) for various cosmetics in Class 3 (PX26); Reg. No. 2,495,240 for MAC (Stylized) for consultation services in the selection and use of cosmetics in Class 42 (PX28); Reg. No. 3,092,847 for MAC (Stylized) for online retail stores featuring cosmetics (PX32); Reg. No. 3,237,448 for MAC for cosmetic bags (Class 18) and cosmetic brushes (Class 21) (PX33); and Reg. No. 4,184,695 for cosmetic bags (Class 18) (PX38).

Second, Applicant in her trial brief addresses the marks pled by Opposer in its original Notice of Opposition (1 TTABVUE), not the Amended Notice of Opposition, which is the operative pleading. Applicant's Main brief, p. 5 (38 TTABVUE 6). The marks asserted in each pleading are slightly different, as shown by comparing the chart in paragraph 8 of the Notice of Opposition with the same chart in the Amended Notice of Opposition. As all of the registered marks pleaded in the Amended Notice of Opposition are properly of record, we will consider them, to the extent that the registrations are valid and subsisting (as discussed in more detail below). However, as the application for the MAC COSMETICS mark (Ser. No. 88/267,112) was not pled in the Amended Notice of Opposition nor was evidence of it submitted under a notice of reliance, we do not consider it further.

Third, Applicant argues that Opposer is relying on three registrations that "now stand cancelled." Applicant's brief, p. 5, n.1 (38 TTABVUE 6). However, Opposer countered that it is not relying on these cancelled registrations, and as support of its argument, points to the fact that it did not introduce evidence of them under its notice of reliance. Opposer's Reply brief, p. 4-5, n.2 (40 TTABVUE 6-7). The cancelled registrations are MAC REFLECTS GLITTER (Reg. No. 3,880,331); MAC SUPERSLICK (Reg. No. 4,029,518); and MAC BY REQUEST (Reg. No. 4,552,866).

We take judicial notice of the fact that the status of these registrations has changed and that they are now cancelled; therefore, we do not give them any further consideration. *See Nike Inc. v. WNBA Enterprises, LLC*, 85 USPQ2d 1187, 1192 n.9 (TTAB 2007); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 704.03(b)(1)(A) (2022).

¹⁵ 29 TTABVUE 4-21. The decision is not precedential and, therefore, it is not binding, but we may consider it for whatever persuasive value it may hold. *In re Constr. Research & Tech. GmbH*, 122 USPQ2d 1583, 1585 n.6 (TTAB 2017) ("Board decisions which are not designated as precedent are not binding on the Board, but may be cited and considered for whatever persuasive value they may hold."); *In re Loggerhead Tools, LLC*, 119 USPQ2d 1429, 1440 n.8 (TTAB 2016).

to show that the PTO considers the term NY to be geographically descriptive (PX41).¹⁶

- Notice of Reliance on Discovery Responses: Applicant's responses to select interrogatories (PX42); Applicant's admissions to certain requests for admissions (PX43); and Applicant's supplemental response to Opposer's Interrogatory No. 8 (PX44).¹⁷
- Notice of Reliance on Printed Publications, which consist of third-party articles (PX45–PX50).¹⁸
- Notice of Reliance on Internet Documents, such as printouts of some social media sites and screen captures of third-party websites featuring Opposer's marks (PX51–PX148).¹⁹

B. Applicant:

- Testimony Declaration of Ana Maria Alves Casas, and printouts from Internet searches from different sources showing different possible meanings for the abbreviation of NY attached as Exhibits A–C.²⁰
- Notice of Reliance on Internet Documents, all showing different possible meanings for the abbreviation of NY (Exhibits A–C), which are duplicates of the exhibits attached to the Declaration of Ms. Casas.²¹

II. Background

A. Overview of Applicant's Business and Mark

Applicant Casas testified that she is the CEO of MCGP Medical Growth Pharma, S.A. ("MCGP"), which provides all the marketing and business activities for the

¹⁶ 29 TTABVUE 22-112.

¹⁷ This Notice of Reliance was submitted in both redacted and unredacted versions. The redacted version appears at 30 TTABVUE and the unredacted version appears at 31 TTABVUE.

¹⁸ 32 TTABVUE.

¹⁹ 33 TTABVUE.

²⁰ 34 TTABVUE.

²¹ 35 TTABVUE.

MCCOSMETICS NY and Design mark in the United States.²² MCGP's business is "manufacturing and selling general cosmetics, medical cosmetics, and dietary supplements."²³ Although Ms. Casas does not offer many details, Ms. Casas testified that MCGP products are represented by MCGP distributors in the United States.²⁴

B. Overview of Opposer's Business and Marks

The MAC brand was launched in Canada in 1983 as an independent line of cosmetics designed and created for professional make-up artists.²⁵ The term MAC was chosen as an acronym for the name of the founding company—Makeup Art Cosmetics, Inc.²⁶ According to Ms. Moudachirou-Rebois, Makeup Art "revolutionized" the beauty industry by providing professional quality makeup used by professional make-up artists to the general public for everyday use.²⁷

In 1985, Makeup Art started selling its cosmetics in the United States.²⁸ MAC-branded cosmetics and skin care products have been marketed and sold in the United States continuously for more than three decades with total sales since launch in the

²² Declaration of Ana Maria Alves Casas ("Decl. Casas"), para. 1 (34 TTABVUE 2).

²³ Applicant's Answer to Opposer's Interrogatory No. 4 (30 TTABVUE 7).

²⁴ Decl. Casas, para. 3 (34 TTABVUE 2).

²⁵ Trial Declaration of Aida Moudachirou-Rebois ("Decl. Moudachirou-Rebois"), para. 6 (26 TTABVUE 4).

²⁶ *Id.* Makeup Art has the exclusive rights to use the MAC and MAC-inclusive trademarks in the United States through a license from Estee Lauder Cosmetics Ltd., owner of the asserted registrations and Opposer in the present proceeding. *Id.* at para. 1 (26 TTABVUE 2). Makeup Art became a wholly-owned subsidiary of The Estee Lauder Companies, Inc. in 1998. *Id.* at para. 7 (26 TTABVUE 4).

²⁷ *Id.*

²⁸ *Id.* at para. 7 (26 TTABVUE 4).

billions of dollars.²⁹ Today Makeup Art offers nearly 2,000 different cosmetic and skin care products under the MAC mark.³⁰ In the U.S. alone, MAC-branded products are sold in more than 1,200 locations, 149 of which are devoted exclusively to selling MAC-branded products.³¹

Ms. Moudachirou-Rebois testified that MAC is a well-known “prestige makeup” brand, sold in the finer department stores, such as Nordstrom, Bloomingdales, and Saks Fifth Avenue.³² This is in contrast to “mass makeup” brands, which are sold in drug stores and big box retailers like Wal-Mart and Target.³³ The “prestige makeup” market is a more than \$6 billion a year industry and includes over 300 brands.³⁴

Ms. Moudachirou-Rebois testified that the MAC brand is so well-known that “[s]ince 2014 and continuing to date, MAC has been ranked and remains the #1 prestige makeup brand sold in the United States measured [both] by dollar share”³⁵ and “by unit share.”³⁶

Additionally, Jessica Heiss, Esq., Vice President and Lead Trademark Counsel for Opposer, testified that Opposer owns more than thirty registrations for the MAC and MAC-inclusive marks in the United States; fourteen of which issued before 2014 and

²⁹ *Id.* at para. 5 (26 TTABVUE 4).

³⁰ *Id.* at para. 9 (26 TTABVUE 5).

³¹ *Id.* at para. 10 (26 TTABVUE 5).

³² *Id.* at paras. 10, 20 (26 TTABVUE 5, 8).

³³ *Id.* at para. 20 (26 TTABVUE 8).

³⁴ *Id.*

³⁵ *Id.* at paras. 11, 21 (26 TTABVUE 5, 8).

³⁶ *Id.* at paras. 11, 22 (26 TTABVUE 5, 9).

are thus over five years old.³⁷ Ms. Heiss further testified that Opposer spends “a great deal of resources policing the MAC Marks and enforcing its rights in the marks.”³⁸ If Opposer identifies a potentially conflicting mark, it takes appropriate action, including initiating opposition proceedings, sending demand letters, and initiating domain name disputes,³⁹ as needed. Ms. Heiss also testified that “perhaps due to the fame of the MAC Marks, competitors in the past have steered clear of using marks that are confusingly similar to the MAC Marks.”⁴⁰

III. Entitlement to a Statutory Cause of Action

“Under the Supreme Court’s decision in *Lexmark International, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 129, 132 (2014), entitlement to a statutory cause of action under the Lanham Act requires demonstrating (1) an interest falling within the zone of interests protected by the Lanham Act and (2) an injury

³⁷ *Id.* at para. 8 (25 TTABVUE 4). See as Exhibits PX26-39 attached to Opposer’s Notice of Reliance (28 TTABVUE).

³⁸ Decl. Heiss, para. 9 (25 TTABVUE 4).

³⁹ *Id.* at paras. 9-14 (25 TTABVUE 4-6).

⁴⁰ *Id.* at para. 11 (25 TTABVUE 5). Ms. Heiss testified that the present proceeding is not the only proceeding in which action has been taken against Applicant regarding her MCCOSMETICS NY and Design mark. Acknowledging that non-US trademark proceedings are not controlling here, Ms. Heiss testified that Makeup Art opposed Applicant’s application to register the MCCOSMETICS NY mark before the European Union Intellectual Property Office (“EUIPO”) based on Makeup Art’s rights in the MAC marks in the European Union. The EUIPO subsequently sustained the opposition for all of the contested goods in Class 3, based on a likelihood of confusion with Makeup Art’s EU Trademark Registration for the MAC MAKE-UP ART COSMETICS mark. The decision was based “in large part on the EUIPO’s finding that the mark MAC MAKE-UP ART COSMETICS had a ‘strong enhanced degree of distinctiveness and a high degree of reputation at least for ‘cosmetics’ in Class 3’” and to have ‘become an attractive and powerful brand on the whole EU market in the cosmetics and beautification sectors.’” Applicant did not appeal the decision with respect to Class 3 goods. *Id.* at para. 15 (25 TTABVUE 6-7).

proximately caused by a violation of the Act.” *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 2022 USPQ2d 602, * 2 (Fed. Cir. 2022). There is “no meaningful, substantive difference between the analytical frameworks expressed in *Lexmark* and *Empresa Cubana* [*Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.2d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014).]” *Corcamore, LLC v. SGM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, *4 (Fed. Cir. 2020). Thus, “a party that demonstrates a real interest in [oppos]ing a trademark under [Trademark Act Section 13, 15 U.S.C.] § 106[3] has demonstrated an interest falling within the zone of interests protected by [the Trademark Act] Similarly, a party that demonstrates a reasonable belief of damage by the registration of a trademark demonstrates proximate causation within the context of § 106[3].” *Id.* at *7.

Opposer made of record numerous registrations of its marks from the USPTO’s Trademark Status & Document Retrieval (“TSDR”) database,⁴¹ including its MAC mark in standard character form (Reg. No. 3,023,827),⁴² and its MAC (Stylized) mark (Reg. No. 1,642,532),⁴³ showing active status and title in Opposer. These registrations give Opposer a real interest in this proceeding and a reasonable belief of damage from registration of Applicant’s mark, *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000), based on a likelihood of confusion claim that is

⁴¹ Copies of the TSDR printouts were attached as Exhibits PX26-39 to Opposer’s Notice of Reliance on Registrations (28 TTABVUE 2-141) and also as collective Exhibit A to Opposer’s Amended Notice of Opposition (6 TTABVUE 16-137).

⁴² The TSDR printout for the registration for the MAC mark is attached to the Amended Notice of Opposition at 6 TTABVUE 16-25 and under a Notice of Reliance at 28 TTABVUE 61-72.

⁴³ The TSDR printout for the MAC (Stylized) registration is at 28 TTABVUE 8-19.

not wholly without merit. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Because Opposer has established its entitlement to assert its Section 2(d) claim, it has standing to pursue its dilution claim as well. *See, e.g., Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1877 (TTAB 2011). Applicant admitted in her response to Opposer's request for admission that she does not challenge Opposer's entitlement to bring this action.⁴⁴

IV. Likelihood of Confusion Analysis

Section 2(d) of the Trademark Act prohibits the registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). To prevail on its Section 2(d) claim, Opposer must prove, by a preponderance of the evidence, that it has priority in the use of its marks and that Applicant's use of her mark is likely to cause confusion, mistake, or deception as to the source or sponsorship of the goods identified in the involved application. *See Cunningham*, 55 USPQ2d at 1848.

⁴⁴ Applicant's Response to Request No. 35 (30 TTABVUE 19).

issue with respect to the goods identified in the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Moreover, Applicant does not dispute Opposer's priority in this matter and, indeed, does not address the issue in her brief.⁴⁷

B. Likelihood of Confusion

Our determination as to whether there is a likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"); *see also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In this case, the facts in evidence as addressed in the parties' briefs bear on the following factors: the strength – and possible fame – of Opposer's MAC and MAC (Stylized) marks; the similarity between the parties' marks; the identity of the goods; the relatedness of the parties' channels of trade; the classes of purchasers; the nature and extent of any actual confusion; and length of time during and conditions under which there has been concurrent use without evidence of actual confusion. We discuss each factor in turn.

1. The Fifth *DuPont* Factor: The Strength of Opposer's Marks

We first consider the strength of Opposer's marks under the fifth *DuPont* factor, *DuPont*, 177 USPQ at 567, as that may affect the scope of protection to which Opposer's marks are entitled. In determining the strength of a mark, we consider

⁴⁷ Applicant's brief (38 TTABVUE).

both its inherent strength, based on the nature of the mark itself, and its commercial strength, based on marketplace recognition of the mark. *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, *21 (TTAB 2022) (citing *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010). 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. 2022) (“The first enquiry is for conceptual strength and focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”).

a. The Inherent Strength of Opposer’s MAC Marks

Because Opposer’s marks are both registered on the Principal Register, with no claim of acquired distinctiveness under Section 2(f), we presume they are inherently distinctive, i.e., that they are at least suggestive of the identified goods. 15 U.S.C. § 1057(b) (registration is “prima facie evidence of the validity of the registered mark”); *In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007) (when a mark is registered on the Principal Register, “we must assume that it is at least suggestive”). Moreover, Applicant does not offer any evidence or argument that Opposer’s marks are conceptually weak.⁴⁸

b. The Commercial Strength of Opposer’s MAC Marks

Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use because

⁴⁸ Applicant’s brief (38 TTABVUE).

they have extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000).

The fifth factor considers the commercial strength of a mark, that is, “the extent to which ‘a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator.’” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1056 (TTAB 2017) (quoting *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (citations omitted)). As the Federal Circuit has explained, “[w]hile dilution fame is an either/or proposition—fame either does or does not exist—likelihood of confusion fame ‘varies along a spectrum from very strong to very weak.’” *Joseph Phelps Vineyards*, 122 USPQ2d at 1734 (quoting *Palm Bay Imps., Inc. v. Veuve Cliquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (internal quotation omitted)). “A mark ‘with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark.’” *Omaha Steaks, Int’l v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018) (quoting *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992)).

Opposer argues that “[t]he MAC Mark is unquestionably strong and famous” and that, as a result, it is entitled to a broad scope of protection.⁴⁹ Applicant neither

⁴⁹ Opposer’s Main brief, p. 31 (37 TTABVUE 33). In its brief, Opposer uses the defined term “MAC Mark” interchangeably to refer to all of the MAC-inclusive marks (see Opposer’s brief, p. 32 (37 TTABVUE 34) (“The MAC Mark is the subject of more than 30 U.S. registrations, fourteen of which are incontestable”)) and to refer to the MAC (Stylized) mark alone (see

expressly concedes the fame of Opposer's marks for likelihood of confusion purposes, nor expressly disputes it, but does argue that "fame is insufficient, standing alone, to establish a likelihood of confusion[.]"⁵⁰ However, even if Applicant does not clearly dispute the fame of Opposer's MAC marks for likelihood of confusion purposes, Opposer, as the party asserting fame, "must clearly prove it," *Weider Publ'ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1353 (TTAB 2014), in order for us to weigh the fifth *DuPont* factor in Opposer's favor; therefore, we must examine the record to determine whether Opposer has carried its burden. As the evidence shows Opposer predominately uses the MAC (Stylized) mark, we focus the fame analysis on it.

The fame or marketplace strength of a mark can be shown directly, through consumer surveys, which are rare, or indirectly, by, among other things, the volume of sales and advertising expenditures of the goods offered under the mark. *Bose Corp.*, 63 USPQ2d at 1305-066. Opposer argues that "[u]nder either analysis, the uncontested record amply evidences the fame of the MAC Mark."⁵¹

In support of its claim, Opposer offers the results of a brand awareness study here, albeit in a footnote in its likelihood of confusion analysis, reserving the bulk of the discussion about the study for the fame element analysis in its dilution claim.⁵²

Opposer's brief, p. 32 (37 TTABVUE 34) ("For more than thirty years, the MAC Mark has been continuously used on every advertisement").

⁵⁰ Applicant's brief, p. 6 (38 TTABVUE 7).

⁵¹ Opposer's Main brief, p. 32 (37 TTABVUE 34).

⁵² *Id.* at p. 33 n.6 (37 TTABVUE 35).

With regard to the brand awareness study, Ms. Moudachirou-Rebois testified that in October 2020, The Estee Lauder Companies, Inc., which wholly owns Opposer, commissioned the study for its key brands, including the MAC (Stylized) mark, in the United States.⁵³ The confidential results confirmed that the MAC (Stylized) brand is a highly recognizable “prestige makeup” brand.⁵⁴

In addition to this evidence of commercial strength as shown through the brand awareness study, Opposer made of record a significant amount of additional evidence to support its claim that the mark is famous for purposes of likelihood of confusion, such as, its long term use, significant advertising, high volume of sales, and unsolicited media exposure, as discussed in more detail below.

i. Length of Use of the MAC (Stylized) Mark

Ms. Moudachirou-Rebois testified that the MAC mark has been used continuously since the brand was launched in the United States in 1985.⁵⁵

Ms. Moudachirou-Rebois testified that the MAC mark is prominently and consistently used on all packaging, advertising and signage. Specifically, she testified that “[e]very MAC product [], every advertisement created by MAC, every piece of promotion or marketing created by MAC, every communication sent by or on behalf of MAC, every press release put out by MAC, every retail location that sells MAC

⁵³ Decl. Moudachirou-Rebois, paras. 47-48 (26 TTABVUE 20-21) and attached Exhibit PX25, which is filed under seal.

⁵⁴ *Id.*

⁵⁵ *Id.* at paras. 6, 7 (26 TTABVUE 4).

products, and every point of purchase material at MAC counters and stores bears or displays the MAC name or mark as shown below:⁵⁶



Ms. Moudachirou-Rebois also testified that from 1985 to the present, “[t]he MAC trademark is used on every conceivable makeup product, including foundation, powder, concealer, blush, bronzer, mascara, eye shadow, eye liner, false eyelashes, nail polish, lipstick, lip gloss, lip balm, lip liner, makeup brushes, cosmetic bags and makeup remover.”⁵⁷ In 2000, Makeup Art began expanding to skin care products, such as moisturizing lotions and creams, and exfoliators.⁵⁸ While the exact number of cosmetic and skin care products offered under the MAC mark fluctuates due to the constant introduction of new products, Ms. Moudachirou-Rebois testified that since at least 2014, there have been approximately 2,000 “continuous life” makeup and skin care products offered under the MAC mark.⁵⁹

ii. High Volume of Sales under the MAC Mark

Since its launch in the United States in 1985, the MAC brand has grown significantly. In the U.S. alone, MAC-branded cosmetics are sold in more than 1,200

⁵⁶ *Id.* at para. 15 (26 TTABVUE 6). Representative samples of the use of the MAC mark on cosmetics is attached to Ms. Moudachirou-Rebois’ declaration as Exhibits PX1 and PX2 (26 TTABVUE 26-68).

⁵⁷ *Id.* at para. 19 (26 TTABVUE 7-8).

⁵⁸ *Id.*

⁵⁹ *Id.*

locations.⁶⁰ This includes 149 MAC stand-alone stores in 124 cities in the US, which are devoted entirely to MAC-branded products.⁶¹ Ms. Moudachirou-Rebois testified that, in addition to the freestanding MAC stores located in major metropolitan areas, such as New York, Los Angeles, Chicago, and Miami, MAC cosmetics are sold through dedicated retail counters, including in fine department stores (such as Nordstrom, Bloomingdales, and Saks Fifth Avenue), beauty stores (such as Sephora and Ulta), duty-free stores in major U.S. airports, online at MAC's website maccosmetics.com, and through third-party websites authorized to sell MAC products (such as bloomingdales.com and nordstrom.com).⁶²

Referring specifically to the volume of sales, Ms. Moudachirou-Rebois testified that MAC cosmetics are among the best-selling makeup products in the United States. Specifically, from 2014-2021 MAC was ranked as the #1 prestige makeup brand sold in the United States measured by both dollar and unit share.⁶³ Ms. Moudachirou-Rebois gave confidential testimony about Makeup Art's total net sales and unit sales in the US between 2014-2021, all of which are significant.⁶⁴

Below is a representative photograph of a MAC-dedicated counter in a department store prominently bearing the MAC (Stylized) mark:⁶⁵

⁶⁰ *Id.* at para. 10 (26 TTABVUE 5).

⁶¹ *Id.* at paras. 10, 24 (26 TTABVUE 5, 9) and attached Exhibit PX3 filed under seal.

⁶² *Id.* at paras. 10, 24-28 (26 TTABVUE 5, 9-10).

⁶³ *Id.* at paras. 21, 22 (26 TTABVUE 8-9).

⁶⁴ *Id.*

⁶⁵ Exhibit PX4 to the Decl. Moudachirou-Rebois (26 TTABVUE 71).



Additionally, below is a representative photograph of a Makeup Art stand-alone store prominently bearing the MAC (Stylized) mark:⁶⁶



iii. Advertising and Promotional Efforts

In addition to appearing prominently on MAC cosmetics and their packaging, in MAC-branded stores and MAC-branded retail sales counters (as shown above) and

⁶⁶ Exhibit PX5 (26 TTABVUE 79).

on its website and social media, the MAC (Stylized) mark is heavily promoted and advertised.⁶⁷ In each situation, the MAC (Stylized) mark appears prominently.

Ms. Moudachirou-Rebois testified as to the amount of money that Makeup Art spent annually for the years 2014-2021 to market and promote products under the MAC mark in the United States, all of which are substantial.⁶⁸ She also testified that Makeup Art devotes a large portion of its advertising budget to print advertisements that appear regularly in beauty periodicals, such as *Allure* and *Glamour*; in fashion periodicals, such as *Vogue*, *Vanity Fair*, and *Harper's Bazaar*; in trade publications, such as *Women's Wear Daily*; and in general interest publications and newspapers, such as *The New York Times*, *In Style*, and *People*.⁶⁹ Below is a representative ad that shows the MAC (Stylized) mark prominently featured:⁷⁰

⁶⁷ *Id.* at para. 29 (26 TTABVUE 11).

⁶⁸ *Id.* at para. 30 (26 TTABVUE 11).

⁶⁹ *Id.* at para. 31 (26 TTABVUE 11-12), and Exhibit PX6 thereto. We note that some of the ads attached in PX6 (see, for example, 26 TTABVUE 87, 89-90) appear to be printer's proofs; however, as Applicant has not objected to them or otherwise sought to discredit this evidence, we consider the issue waived.

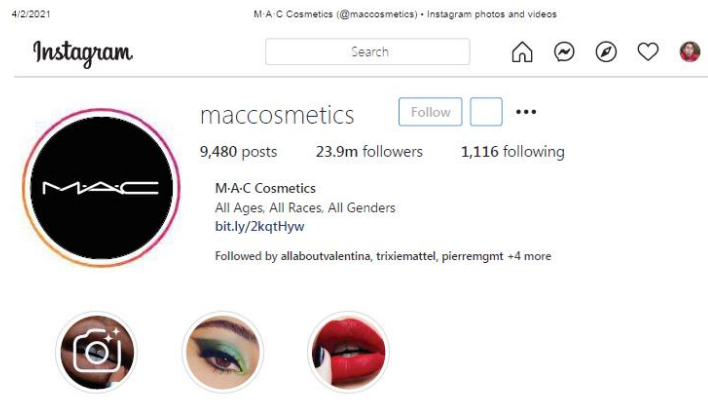
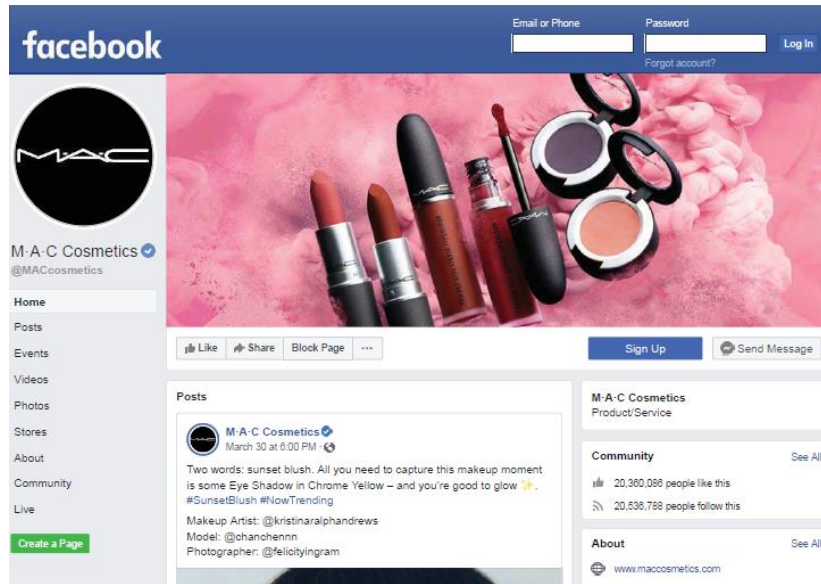
⁷⁰ Exhibit PX5 (26 TTABVUE 88).



Ms. Moudachirou-Rebois also testified as to the widespread use of social media to promote and advertise the MAC (Stylized) mark, such as: (1) the MAC Facebook account (@MACcosmetics), which has over 20 million followers; (2) the MAC Instagram account (@maccosmetics), which has over 24 million followers and over 10,000 posts; (3) the MAC Twitter account (@MACcosmetics), which has over 1.5 million followers; (4) the MAC TikTok account (@maccosmetics), which has over 290,000 followers; and (5) the MAC YouTube account (@MAC Cosmetics), which has over 629,000 subscribers, where the channel’s most popular videos receive millions of views.⁷¹ The MAC (Stylized) mark is prominently displayed on social media, as shown below:⁷²

⁷¹ Decl. Moudachirou-Rebois, para. 32 (26 TTABVUE 12); copies of the home pages for the foregoing social media accounts are attached as Exhibits PX7-PX10.

⁷² 26 TTABVUE 138, 142, and 146.



Additionally, Ms. Moudachirou-Rebois testified in detail about the Makeup Art - established MAC AIDS Fund, which has been a very successful charitable fundraising initiative that contributes to the fame of the MAC mark. The MAC AIDS Fund was established by Makeup Art in 1994 to support people around the world who are living with HIV/AIDS.⁷³ She testified that “[t]he heart and soul of the fund is [Makeup Art’s] ‘VIVA GLAM’ products.”⁷⁴ Every two years, Makeup Art creates new lip color products that are offered under the name “MAC VIVA GLAM.”⁷⁵ All proceeds from the sale of the MAC VIVA GLAM products go directly to the fund.⁷⁶ While the fund initially raised and donated money for HIV/AIDS, the fund name was changed in 2019 from MAC AIDS Fund to the MAC VIVA GLAM fund, and with its name change, it broadened the scope of its mission to include, for example, equal rights for women, girls and the LGBTQ community.⁷⁷ To date, sales of the MAC VIVA GLAM products have raised over \$500 million, and, in 2020 the MAC VIVA GLAM campaign donated \$10 million for COVID-19 emergency relief.⁷⁸

⁷³ Decl. Moudachirou-Rebois, para. 33 (26 TTABVUE 12-13).

⁷⁴ *Id.*

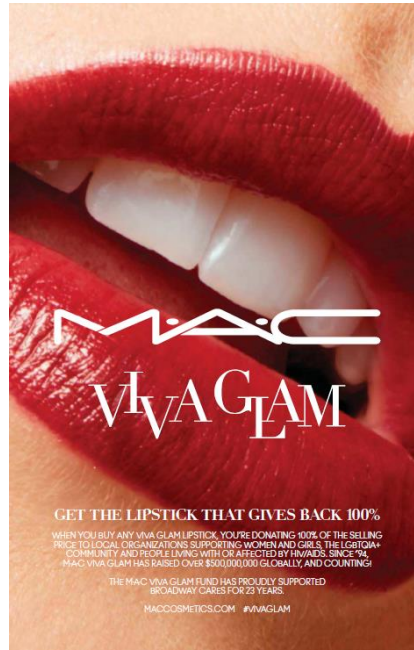
⁷⁵ *Id.*

⁷⁶ *Id.*

⁷⁷ *Id.*

⁷⁸ *Id.* Exhibits PX11 and PX12 are articles featuring MAC VIVA GLAM, its history and fundraising success.

Makeup Art advertises the MAC VIVA GLAM products in order to boost both sales and charitable donations. In these advertisements, the MAC (Stylized) mark is prominently featured, as shown in the representative samples below:⁷⁹



⁷⁹ Exhibit PX13 (26 TTABVue 169, 180).

Continuing, Ms. Moudachirou-Rebois testified that the entertainment community has played a large part in making the ads both memorable and newsworthy. The advertising campaigns have featured as spokespersons such recognized figures as (1) musicians Ariana Grande, Miley Cyrus, Lady Gaga, RuPaul, Elton John, Ricky Martin, Troye Sivan, Cyndi Lauper, Fergie, Christina Aguilera, Missy Elliot, K.D. Lang, Debbie Harry, Eve, Boy George, Mary J. Blige, Shirley Manson and Lil' Kim; and (2) actresses, such as, Chloe Sevigny, Dita Von Teese and Pamela Anderson.⁸⁰ Significantly, the MAC VIVA GLAM advertisements have appeared in many national publications, including *The New York Times*, *Out Magazine*, *Vogue*, *Women's Wear Daily*, *Elle*, *In Style*, *Cosmopolitan*, *W*, *Harper's Bazaar*, *Marie Claire*, *Vanity Fair*, *Lucky*, *Interview*, *Essence*, *Vibe*, *Latina*, *Allure*, *Teen Vogue*, and *O, The Oprah Magazine*.⁸¹ Makeup Art has even advertised MAC VIVA GLAM on a billboard in New York City's Times Square.⁸²

Second, Makeup Art has been a regular sponsor of the twice-yearly New York Fashion Week, one benefit of which is that the MAC (Stylized) mark then appears on Fashion Week event invitations, programs, signage and flags.⁸³ As one part of Fashion Week, Makeup Art designs the models' makeup at many of the high-profile fashion shows, which is covered by the press.⁸⁴ In one relatively recent example,

⁸⁰ Decl. Moudachirou-Rebois, para. 34 (26 TTABVUE 13).

⁸¹ *Id.* Representative MAC VIVA GLAM ads are attached as Exhibit PX13 (26 TTABVUE 163-182).

⁸² *Id.* at para. 34 (26 TTABVUE 13).

⁸³ *Id.* at para. 39 (26 TTABVUE 15).

⁸⁴ *Id.* and Exhibit PX14 (26 TTABVUE 190-94).

Makeup Art collaborated with Christian Cowan and music superstar Lil Nas X to create unique makeup looks for the reveal of their unisex, ready-to-wear collection that premiered at the Spring 2021 New York Fashion Week.⁸⁵ Much of Makeup Art's involvement in NY Fashion Week is routinely covered by the press, and this event was no exception, as it was covered in an article from *BeautyStat* magazine.⁸⁶

Third, Ms. Moudachirou-Rebois testified that Makeup Art routinely collaborates with celebrities, famous designers, and entertainment brands to create limited-edition lines of MAC makeup.⁸⁷ For example, Makeup Art collaborated with Brooke Shields, Mariah Carey, Taraji P. Henson, Teyana Taylor, Zac Posen, and Jeremy Scott.⁸⁸ Makeup Art collaborated with Mattel to create a limited edition "MAC Loves Barbie" line in 2007 and collaborated again in 2020 in celebration of the BARBIE brand's 61st birthday,⁸⁹ which featured a "cool-toned bubblegum-pink" lipstick, offered under the MAC (Stylized) mark.⁹⁰

Over the years, Makeup Art has collaborated with The Walt Disney Company ("Disney") to launch makeup collections celebrating the release of Disney films, including *Maleficent* in 2014 and *Cruella* in 2021.⁹¹ Makeup Art has also collaborated

⁸⁵ *Id.*

⁸⁶ *Id.* A copy of the *BeautyStat* magazine article is attached as Exhibit PX14 (26 TTABVUE 184-88); other articles are attached as Exhibits PX15 and PX16 (26 TTABVUE 190-98).

⁸⁷ *Id.* at para. 40 (26 TTABVUE 15-16).

⁸⁸ *Id.* Copies of articles regarding these celebrity collaborations are attached at Exhibit PX17.

⁸⁹ *Id.* at para. 40 (26 TTABVUE 15-16) and attached Exhibit PX18.

⁹⁰ Exhibit PX18 (26 TTABVUE 220).

⁹¹ *Id.* at para. 40 (26 TTABVUE 15-16). Articles detailing collaborations between MAC and Disney are attached as Exhibits PX19 and PX20.

with other entertainment franchises, including the *Simpsons* and *Star Trek*.⁹² Images of representative samples of the limited edition cosmetic lines bearing the MAC (Stylized) mark appear below:⁹³



⁹² *Id.* at para. 40 (26 TTABVUE 15-16). Exhibits PX21 and PX22 are copies of an articles regarding these collaborations

⁹³ 26 TTABVUE 222, 225, 227 and 229.



Fourth, Ms. Moudachirou-Rebois testified that Makeup Art promotes the MAC mark by providing makeup for use in movies, television shows, and Broadway plays. This includes *MTV*, *E! News*, *Keeping Up With the Kardashians*, *the Handmaid's Tale* (Hulu), *Pen 15* (Hulu), *High Fidelity* (Hulu), *Serena: The Series* (Netflix), and *Tall Girl* (Netflix).⁹⁴ At the end of each show, Makeup Art receives a “rolling credit”

⁹⁴ Decl. Moudachirou-Rebois, para. 41 (26 TTABVUE 17).

thanking MAC for providing makeup.”⁹⁵ Similarly, Makeup Art provides makeup for actors in various films, such as *Pirates of the Caribbean: The Curse of the Black Pearl* (2003), and, more recently, *The Prom* (2020) and *Promising Young Woman* (2020), to name a few.⁹⁶ For its contribution, Makeup Art receives a “thank you credit’ for providing the makeup at the end of each film”.⁹⁷

Turning now to Broadway, Makeup Art has provided makeup for the actors in the following Broadway musicals and plays: *Moulin Rouge*, *Jagged Little Pill*, *Hadestown*, *Tina the Musical*, *Mean Girls*, *Pretty Woman*, *Legally Blonde*, *Hairspray*, *Looped*, *A View from the Bridge*, *South Pacific*, *Rock of Ages*, *Dirty Dancing*, *Promises, Promises*, *Tarzan*, *Mary Poppins*, *In the Heights*, *Wicked*, *The Little Mermaid*, *La Cage Aux Folles*, *American Idiot*, *The Addams Family*, and *A Little Night Music*. MAC received a thank you credit in the Playbill for these Broadway shows that read: “Makeup provided by MAC.”⁹⁸

Fifth, Makeup Art promotes and markets the MAC brand by sponsoring high-profile events.⁹⁹ For example, Makeup Art has sponsored numerous entertainment and charity events in the United States, such as the Susan G. Komen Race For the Cure, the St. Jude Children’s Research Hospital fundraiser, the GLAAD Media Awards, the Make-A-Wish Foundation Ball, the Grammy Awards, the BET Hip Hop

⁹⁵ *Id.*

⁹⁶ *Id.*

⁹⁷ *Id.*

⁹⁸ *Id.*

⁹⁹ *Id.* at para. 42 (26 TTABVUE 17-18).

Awards, Women in Film Lucy awards, She Rocks Awards, ASCAP Latin Music Awards, Hollywood Music in Media Awards, Hollywood Beauty Awards, Latin American Music Awards, Rock and Roll Hall of Fame Induction, Leo Awards, Nashville Film Festival, NAACP Awards, SXSW Music Conference, MTV VMA's, and the California Women's Film Festival.¹⁰⁰ As a sponsor, the MAC mark appears on signage, written material, and on products that are distributed to attendees.¹⁰¹

Additionally, the MAC (Stylized) mark is advertised and promoted by others, such as third-parties that are authorized to offer Makeup Art's products online.¹⁰² This includes, for example, third-party websites at bloomingdales.com, dillards.com, nordstrom.com, saksfifthavenue.com, sephora.com, and ulta.com.¹⁰³ A representative screenshot from bloomingdales.com is shown below:¹⁰⁴

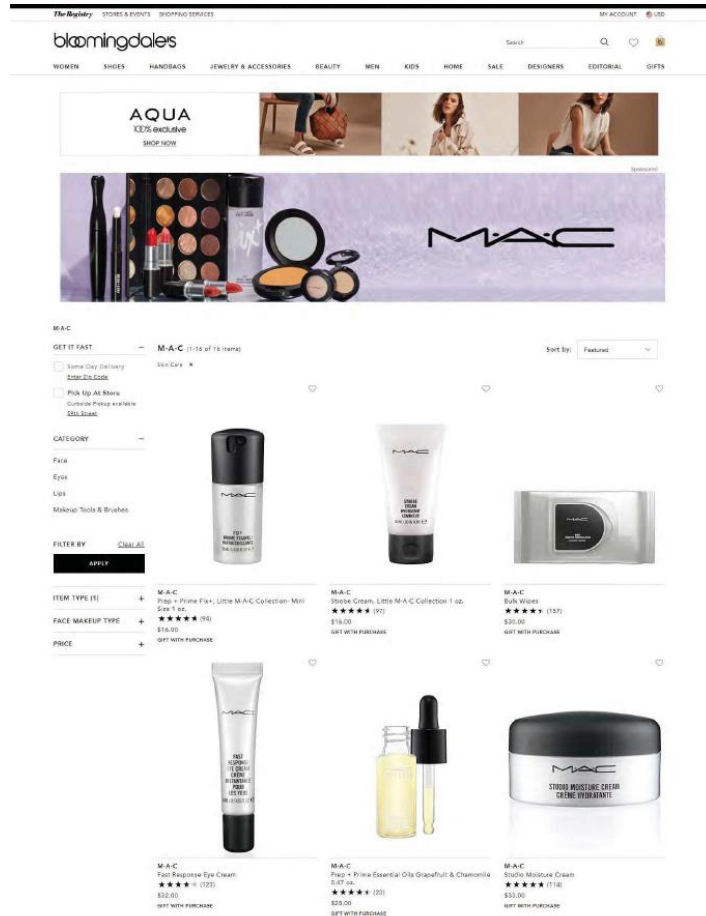
¹⁰⁰ *Id.*

¹⁰¹ *Id.*

¹⁰² *Id.* at para. 43. Attached as Exhibit PX23 (26 TTABVUE 239-47) are true and correct copies of representative printouts from third party websites bloomingdales.com, dillards.com, nordstrom.com, saksfifthavenue.com, sephora.com, and ulta.com

¹⁰³ Decl. Moudachirou-Rebois, para. 43 (26 TTABVUE 18). Samples of third-party websites advertising and promoting the MAC mark are attached as Exhibit PX23 (26 TTABVUE 239-47).

¹⁰⁴ Exhibit PX23 (26 TTABVUE 239).



iv. Unsolicited Media Coverage and Awards

Ms. Moudachirou-Rebois testified that MAC-branded products are the subject of unsolicited media coverage and “appear frequently in beauty editorials and product reviews in various print and online publications and television programs, creating billions of media impressions per year.”¹⁰⁵ Ms. Moudachirou-Rebois further testified that during the calendar years 2018, 2019, and 2020, there were “thousands” of unpaid product placements that alluded to the MAC mark. Continuing, she added that “[t]hese product placements appeared in national and regional magazines,

¹⁰⁵ Decl. Moudachirou-Rebois, para. 44 (26 TTABVUE 18).

newspapers, trade publications, on-line sites and blogs, and television programs, which together have been viewed over 112 billion times[,]”¹⁰⁶ the estimated value of which her confidential testimony shows is substantial.¹⁰⁷ Examples include: *Allure*, *Glamour*, *Women’s Health*, *Martha Stewart Online*, *POPSUGAR*, *Teen Vogue*, *InStyle Magazine*, *Cosmopolitan*, *Vogue*, *The New York Times*, *Harper’s Bazaar*, and *Elle*.¹⁰⁸

Ms. Moudachirou-Rebois also testified about industry awards that Makeup Art has received for its MAC-branded cosmetics. This includes numerous awards from national beauty and fashion magazines, including “Reader’s Choice Awards” and “Best Beauty Buy Awards.”¹⁰⁹ For example, in 2021, Makeup Art won Self Magazine’s 2021 SELF Beauty Award for Best Mascara, Cosmo’s 2021 COSMOPOLITAN Beauty Award for Best Color Corrector, Essence Magazine’s 2021 ESSENCE Best in Black Award for lipstick, and Prevention’s 2021 PREVENTION Beauty Award for best concealer.¹¹⁰ More awards for the years 2019 and 2020 are described by Ms. Moudachirou-Rebois.¹¹¹

¹⁰⁶ *Id.* at para. 45 (26 TTABVUE 18-19).

¹⁰⁷ *Id.*

¹⁰⁸ *Id.* An example of a *New York Times* article, dated April 23, 1996, is attached as Exhibit PX24 (26 TTABVUE 249-52).

¹⁰⁹ *Id.* at para. 46 (26 TTABVUE 19-20).

¹¹⁰ *Id.*

¹¹¹ *Id.*

c. Summary Regarding the Fifth *DuPont* Factor re Strength of Opposer's Mark

In light of the above evidence, none of which is disputed by Applicant or even discussed in Applicant's brief,¹¹² we find both of Opposer's MAC marks to be inherently strong and we additionally find Opposer's MAC (Stylized) mark to be famous for purposes of likelihood of confusion. Accordingly, this factor weighs heavily in favor of finding a likelihood of confusion.

2. The Second and Third *DuPont* Factors

The second *DuPont* factor "considers '[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,'" while the third *DuPont* factor considers "the similarity or dissimilarity of established, likely-to-continue trade channels." *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). Our analysis under these factors is based on the identifications of goods in Applicant's involved application and Opposer's MAC and MAC (Stylized) registrations. *Detroit Athletic*, 128 USPQ2d at 1051; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-63 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 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

¹¹² Applicant's brief (38 TTABVUE).

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.”).

Opposer's registration for its MAC mark in standard character form identifies the following goods: “Cosmetic products including ... multi-use colored creams [;]... non-medicated skin care products, namely ... eye creams ...”.

Similarly, Applicant's involved application identifies the following goods: “Cosmetics; cosmetic creams for skin care; non-medicated cosmetic creams for body care; sunscreen creams; face and body creams; skin cleansers; non-medicated creams for skin care after laser epilation; massage creams”.

We find that Applicant's “cosmetic creams for skin care” are encompassed by Opposer's “cosmetic products including multi-use colored creams,” and that Applicant's “cosmetic creams for skin care” encompass Opposer's “non-medicated skin care products, namely eye creams.” Thus, the parties' goods are in-part legally identical. *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018) (where the goods in an application or registration are broadly described, they are deemed to encompass all the goods of the nature and type described therein); *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant's broadly worded identification of ‘furniture’ necessarily encompasses Registrant's narrowly identified ‘residential and commercial furniture.’”). Further, where, as here, Applicant's goods are in a single class, it is sufficient for our purposes if legal identity is established for only one item in the identification of goods. *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (It

is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application).

Similarly, we compare the goods identified in the MAC (Stylized) registration to the goods identified in Applicant's involved application. The MAC (Stylized) registration identifies "skin cleaner" and Applicant's involved application identifies "skin cleansers." We take judicial notice of the fact that "cleanser" means "a preparation (such as a scouring powder or a skin cream) used for cleaning."¹¹³ Thus, we find these goods to be legally identical in part.

Where the parties' goods are legally identical, with no restrictions in the application and registration, those legally identical goods are presumed to travel in the same channels of trade to the same class of purchasers. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.").

Accordingly, we find that the second and third *DuPont* factors strongly weigh in favor of finding a likelihood of confusion.

3. The First *DuPont* Factor: The Similarity of the Parties' Marks

"The first *DuPont* factor concerns 'the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.'"

¹¹³ MERRIAM-WEBSTER DICTIONARY (www.merriam-webster.com) accessed on July 22, 2022.

Palm Bay Imps., 73 USPQ2d at 1691 (quoting *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, No. 18-2236 (Fed. Cir. Sept. 13, 2019). The proper test regarding similarity “is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai*, 127 USPQ2d at 1801 (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks and citation omitted)). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks.” *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018) (citations omitted).

Our findings above on the second and fifth *DuPont* factors reduce the degree of similarity between the MAC (Stylized) mark and Applicant’s mark that is necessary for confusion to be likely. Because the parties’ goods are legally identical in part, “the degree of similarity necessary to support a conclusion of likely confusion declines” with respect to those goods, *Cai*, 127 USPQ2d at 1801, and because we have found that Opposer’s MAC (Stylized) mark is famous under the fifth *DuPont* factor, it “receives more legal protection than an obscure or weak mark.” *Omaha Steaks*, 128 USPQ2d at 1689 (quoting *Kenner Parker Toys*, 22 USPQ2d at 1456).

Opposer argues that Applicant's MCCOSMETICS NY and Design mark is highly similar to Opposer's MAC mark in terms of sight, sound, meaning and overall commercial impression.¹¹⁴ Opposer argues that the dominant part of Applicant's mark is "MC" while Opposer's mark is MAC, differing only by the letter "a". This causes the marks to be similar in sight and commercial impression. Opposer also argues that the MC portion of Applicant's mark sounds virtually identical to Opposer's MAC mark when pronounced.¹¹⁵

Applicant argues against each point.¹¹⁶ First, with regard to appearance, Applicant argues that her mark is a non-word MCCOSMETICS in all lower-case letters. Additionally, her mark is visually distinct because it includes the additional element NY, together with a long horizontal line that vertically separates MCCOSMETICS from NY.¹¹⁷

Applicant also argues that her mark sounds different from Opposer's when pronounced because Applicant's mark visually breaks as MCCOS and METICS, leading to a pronunciation of "mi cos" and "me tics".¹¹⁸ Applicant further argues that even if some consumers were to read the mark as MC and COSMETICS NY, the

¹¹⁴ Opposer's Main brief, p. 39 (37 TTABVUE 41).

¹¹⁵ *Id.*

¹¹⁶ Applicant's brief, pp. 6-9 (38 TTABVUE 7-10).

¹¹⁷ Decl. Casas, para. 11 (34 TTABVUE 4); Applicant's brief, pp. 7-8 (38 TTABVUE 8-9).

¹¹⁸ Decl. Casas, para. 11 (34 TTABVUE 4); Applicant's brief, pp. 8-9 (38 TTABVUE 9-10).

result is still a dissimilar pronunciation of M and C (phonetically /em si/) and COSMETICS (phonetically /koz-met-iks/) and NY (phonetically /en wye/).¹¹⁹

With regard to connotation, Applicant argues that her mark is an acronym where the letter M stands for “maçon” and the letter C stands for “casa.”¹²⁰ “The idea behind the ‘MC’ portion of Applicant’s mark is analogous to a bricklayer (mason) building a house, step by step.”¹²¹ Similarly, Applicant further argues that the letters N and Y stand for “new” and “youth,”¹²² and that the “new youth” portion of Applicant’s mark represents the youthful appeal and anti-aging properties of Applicant’s goods.¹²³ This is in contrast to Opposer’s mark, MAC, which is an acronym for Makeup Art Cosmetics.

In reply, Opposer counters that “[i]t strains credulity to believe that consumers will parse ‘MCCOSMETICS’ into ‘MCCOS and METICS’ rather than ‘MC’ and ‘COSMETICS’, especially given that the applied-for mark is being used in connection with **cosmetics**[]” and that “it is more rational to conclude that consumers will parse MCCOSMETICS into ‘MC’ and the recognized term ‘COSMETICS’.”¹²⁴ Continuing,

¹¹⁹ Applicant’s brief, pp. 8-9 (38 TTABVUE 9-10).

¹²⁰ Casas Decl., para. 7 (34 TTABVUE 3); Applicant’s Answer to Interrogatory No. 2 (30 TTABVUE 6).

¹²¹ Decl. Casas, para. 7 (34 TTABVUE 3).

¹²² Decl. Casas, para. 7 (34 TTABVUE 3); Applicant’s Answer to Interrogatory No. 2 (30 TTABVUE 6).

¹²³ Decl. Casas, paras. 7, 10 (34 TTABVUE 3).

¹²⁴ Opposer’s Reply brief, p. 8 (40 TTABVUE 10) (emphasis in original).

Opposer argues that, under this more natural division, the similarities between MCCOSMETICS NY and MAC – both for use with cosmetics – are evident.¹²⁵

Additionally, Opposer seeks to discredit Applicant’s argument that the design element of her mark distinguishes the parties’ marks, arguing that a mere horizontal line is not enough to cause Applicant’s mark to make a different overall appearance.¹²⁶ Further, to the extent that Applicant relies on the NY element to distinguish the marks, Opposer argues that Applicant has disclaimed the NY element, so it does not serve any source-identifying function sufficient to distinguish the marks.¹²⁷ Further, Opposer argues that consumers will not view or understand “NY” to mean “New Youth” as there is no evidence to support Applicant’s claim. Indeed, Opposer argues that consumers will not interpret “NY” to mean “New Youth”—they will interpret it to mean “New York” as Applicant offers nothing but “rank speculation” in the form of printouts from the acronym finder to support her claim.¹²⁸

Opposer also seeks to discredit Applicant’s arguments that the parties’ marks will be pronounced differently. For the same reasons that consumers will not view the MCCOSMETICS as MCCOS and METICS, Opposer contends the mark is unlikely to be pronounced in a like manner.¹²⁹ Regardless, Opposer continues, it is well-settled

¹²⁵ *Id.*

¹²⁶ *Id.* at pp. 8-9 (40 TTABVUE 10-11).

¹²⁷ *Id.* at p. 9 n.3 (40 TTABVUE 11).

¹²⁸ Opposer’s Main brief, pp. 47-48 n.7 (37 TTABVUE 49-50).

¹²⁹ Opposer’s Reply brief, p. 10 (40 TTABVUE 12).

that there is no correct pronunciation of a trademark that is not an English word: “While it is pure speculation on the part of Applicant to claim that consumers will pronounce [her] mark as ‘mi cos’ and ‘me tics,’ if Applicant takes this position then she must also concede that [it] is equally plausible (if not probable) that consumers will pronounce it as ‘MC’ and ‘COSMETICS’, a pronunciation that is audibly similar to MAC [].”¹³⁰

Opposer also seeks to discredit Applicant’s arguments that the marks have different connotations, arguing:

Even assuming that Applicant *herself* intends the letters “M” and “C” to represent the words “Mason” and “Casa,” there is no evidence that *consumers* will share this understanding or will understand the “MC” portion of Applicant’s mark to be a reference to building a house (nor would such an interpretation intuitively pop into someone’s head in connection with the application of cosmetics). In fact, there is no evidence in the record to support this interpretation, which appears to have been made up for purposes of this opposition proceeding.

Opposer’s Reply brief, pp. 11-12 (40 TTABVUE 13-14) (emphasis in original).

Given the above-discussed evidence and arguments, we find that the parties’ marks are similar. Because Applicant’s mark is used with cosmetics, it would be natural for consumers to visually break the mark into components MC and COSMETICS and to pronounce these components in a similar manner when verbalizing the mark. Further, the COSMETICS element in Applicant’s mark is generic when considered in light of Applicant’s goods and thus has little to no trademark significance. *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d

¹³⁰ *Id.*

1567, 1569 (Fed. Cir. 1987) (“Generic terms, by definition incapable of indicating source, are the antithesis of trademarks ...”).

We also note that Opposer’s MAC mark is registered in standard character format. Thus, it could be displayed in any font style, size or color, including a lowercase font similar to Applicant’s. *See Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983).

As for the meanings ascribed to the MC and NY acronyms, we are not persuaded by Applicant’s arguments. There is nothing inherent in Applicant’s mark or in her marketing to lead consumers to believe that MC stands for “maçon” and “casa” and that the letters N and Y stand for “new” and “youth”. Registration of the involved mark is being sought in the United States, where NY is commonly understood to refer to New York, as shown by Applicant’s Notice of Reliance evidence, where New York is shown as the most popular meaning,¹³¹ so it is likely that consumers would understand the NY element to stand for New York.

In view of the above evidence and arguments, and in view of Opposer’s MAC mark registered in standard character format, we find the parties’ marks to be similar. Consequently, this factor weighs in favor of a finding of likelihood of confusion.

4. The Seventh and Eighth *DuPont* Factors: Nature and Extent of Actual Confusion and Related Conditions for Confusion

The seventh *DuPont* factor is the “nature and extent of any actual confusion,” while the eighth *DuPont* factor considers the “length of time during and conditions

¹³¹ Applicant’s Notice of Reliance (35 TTABVUE 5).

under which there has been concurrent use without evidence of actual confusion.”
DuPont, 177 USPQ at 567.

Applicant argues that she sells her products in Virginia, California, Maryland, New Jersey, Florida, Massachusetts and New York.¹³² Applicant argues that there have been no incidents of actual confusion, despite Applicant’s sales in the United States, including in Opposer’s home state of New York, since 2016.¹³³ Applicant asserts that there have been no incidents of confusion despite Opposer’s “alleged fame and boasting tens of millions of social media followers.”¹³⁴ Consequently, Applicant argues that confusion, if it were likely, would have occurred by now.¹³⁵

Opposer counters that the purported lack of confusion is irrelevant as there has not been a significant opportunity for actual confusion to have occurred.¹³⁶ Opposer argues that Applicant’s sales cannot be significant as Applicant did not introduce any evidence of actual sales in the U.S., and Applicant has admitted that her advertising has been limited.¹³⁷

After considering the evidence of record, we find that Applicant has not made of record any evidence of any sales under her mark in the United States and we find that she has not engaged in enough advertising to be meaningful. Therefore, we find

¹³² Applicant’s brief, p. 10 (38 TTABVUE 11).

¹³³ *Id.*

¹³⁴ *Id.*

¹³⁵ *Id.*

¹³⁶ Opposer’s Reply brief, p. 12 (40 TTABVUE 14).

¹³⁷ *Id.* at p. 13 (40 TTABVUE 15).

that there has not been significant opportunity for actual confusion to have occurred. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred) *cited in Chutter, Inc. v. Great Mgmt. Grp.*, 2021 USPQ2d 1001, *46-47 (TTAB 2021). Consequently, the absence of incidents of actual confusion to date is in no way representative of the likelihood of confusion posed by broader use of the mark. *See Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987) (“although a registrant’s current business practices in connection with which the mark is used may be quite narrow, they may change at any time”); *In re Midwest Gaming & Ent.*, 106 USPQ2d at 1165. Accordingly, the seventh and eighth *DuPont* factors are neutral.

5. Balancing the *DuPont* Factors

All of the relevant *DuPont* factors either support a finding of a likelihood of confusion or are neutral. Opposer’s MAC (Stylized) mark and its MAC mark in standard character format for cosmetics and related products are both inherently distinctive. Additionally, the MAC (Stylized) mark is famous. Consequently, Opposer’s MAC (Stylized) mark is entitled to a broad scope of protection. The parties’ goods are legally identical in part, so the channels of trade and classes of consumers for those goods are presumed to be the same. Thus, the second, third, and fifth *DuPont* factors support a finding of a likelihood of confusion. The marks are sufficiently similar in appearance, sound, connotation and commercial impression for confusion to be likely, particularly given the legal identity of the goods and the strength of

Opposer's MAC (Stylized) mark, so the first *DuPont* factor also weighs in favor of a finding of a likelihood of confusion. The seventh and eighth *DuPont* factors, which potentially could mitigate against a finding of a likelihood of confusion based on the other factors, are neutral.

In sum, we find that Opposer has shown, by a preponderance of the evidence, that confusion is likely, and we sustain Opposer's opposition under Trademark Act § 1052(d), 15 U.S.C. § 1052(d).

V. Conclusion

“When an opposer's trademark is a strong, famous mark, it can never be ‘of little consequence.’” *Recot Inc.*, 54 USPQ2d at 1897 (quoting *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984)). The Federal Circuit has stated repeatedly that there is no excuse for even approaching the well-known trademark of a competitor inasmuch as “[a] strong mark...casts a long shadow which competitors must avoid.” *Kenner Parker Toys*, 22 USPQ2d at 1456. Because Applicant's mark is similar to both Opposer's MAC mark in standard character form and in its famous stylized form, the parties' goods are legally identical in part, and the channels of trade and classes of consumers for such goods are presumed to be the same, we find confusion is likely and sustain the opposition to Applicant's application under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

VI. Decision

The opposition to registration of the mark in Application Serial No. 88359609 in Class 3 is sustained on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).¹³⁸

¹³⁸ Because we sustain the opposition based on Opposer's Section 2(d) claim, we need not reach Opposer's claim of dilution by blurring under Section 43(c). *See Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013); *Venture Out Props. LLC v. Wynn Resorts Holdings LLC*, 81 USPQ2d 1887, 1893 (TTAB 2007) ("In view of our decision finding a likelihood of confusion, we need not reach the issue of dilution.").