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**PARA LABORATORIES, INC., Plaintiff,-against-BETTER BOTANICALS, INC.,
Defendant.**

CV 98-1523

**UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF NEW
YORK**

1998 U.S. Dist. LEXIS 17468; 48 U.S.P.Q.2D (BNA) 1050

May 6, 1998, Decided

May 6, 1998, Entered

DISPOSITION: [*1] Para Labs' motion for a preliminary injunction denied.

LexisNexis (TM) HEADNOTES- Core Concepts:

COUNSEL: Robert Ullman, Esq., Of Counsel, BASS & ULLMAN, ESQS., New York, New York, for Plaintiff.

Maurice U. Cahn, Esq., Frederick N. Samuels, Esq., Of Counsel, CAHN & SAMUELS, LLP, Washington, D.C., for Defendant.

Patricia A. Wilczynski, Esq., Of Counsel, SCULLY, SCOTT, MURPHY & PRESSER, P.C., Garden City, New York, for Defendant.

JUDGES: JACOB MISHLER, U.S. District Judge.

OPINIONBY: JACOB MISHLER

OPINION:

Memorandum of Decision and Order

May 6, 1998

MISHLER, District Judge

Plaintiff Para Laboratories, Inc. ("Para Labs") moves for a preliminary injunction enjoining defendant Better Botanicals, Inc. ("Better Botanicals") from manufacturing, selling, distributing, advertising or promoting Better Botanicals' products as "Indulge Dead Sea Salt Bath Therapy," "Cheer Dead Sea Salt Therapy" and "Purify Dead Sea Salt Therapy" as acts of infringement on Para Labs' trademark "Batherapy."

The court conducted an evidentiary hearing. The court finds, solely for the purpose of the motion, as follows:

Para Labs has been engaged in the manufacture, distribution and sale of professional and consumer products such as hair, skin and bath aids [*2] since about 1937. Para Labs introduced mineral salt bath products, using the trademark Batherapy in 1954. Para Labs registered the mark "Batherapy" in the United States Patent and Trademark Office on September 27, 1955. The registration has been renewed — the last renewal term beginning on September 27, 1995.

Para Labs mineral salt products are sold under the trademark Batherapy throughout the United States, Canada, England, Poland, Panama, Germany and Korea. Para Labs Batherapy product is advertised in trade magazines, local newspapers and trade shows in the health and beauty industries.

Batherapy accounted for about \$3,217,000 in sales for the past three years. The cost of advertising Batherapy has been in excess of \$150,000 for the past year.

Better Botanicals was founded in the latter part of 1995 by Robert Holdheim and his wife. Its business is conducted from a store in Georgetown in Washington, D.C. About half the sales are to customers at the store; the rest of the sales are through mail order. Better Botanicals also sells to stores who, in turn, sell to consumers in various parts of the United States, e.g., Nordstrom (Montgomery County, Md.), Brownes Apothecary (Miami [*3] Beach, Fl.), Merz Apothecary (Chicago, Il.), H2O. Spa (Metairie, La.), the Whole Foods Chain (stores in various parts of the United States). Its mail order sales reach Canada, Europe, the Middle East and Latin America.

Among the products it sells at its Georgetown store and in parts of the United States and elsewhere are those that contain Dead Sea salts, marketed as "Indulge Dead Sea Salt Bath Therapy," "Cheer Dead Sea Salt Bath Therapy," and "Purify Dead Sea Salt Bath Therapy."

Para Labs' Queen Helene Batherapy and Better

Botanicals bath therapy brands are represented as containing mineral sales used in bath therapy. They are competitive items.

Better Botanicals bath therapy products are sold to the consumer at substantially higher prices and are rarely found in the same retail stores that sell Para Labs bath products.

Better Botanicals Dead Sea Salt brands are packaged and sold under the following label:

[SEE ILLUSTRATION IN ORIGINAL]

together with its trademark Better Botanicals, which was registered on September 2, 1997.

DISCUSSION

Batherapy as a Suggestive Trademark

The categories of trademarks were first pronounced in *Abercrombie & Fitch Co. v. Hunting* [*4] *World, Inc.*, 537 F.2d 4, 9-11 (2d Cir. 1976). The Supreme Court in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 112 S. Ct. 2753, 2757, 120 L. Ed. 2d 615 (1992) recognized the continued use of the classification of categories of trademarks as expressed by Judge Friendly in *Abercrombie*, i.e., (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful.

Para Labs trademark Batherapy is suggestive. "A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of [the] goods." *Abercrombie*, 537 F.2d at 11, citing *Stix Products, Inc. v. United Merchants & Manufacturers, Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968). See also *W.W.W. Pharmaceutical Co., Inc. v. Gillette Co.*, 808 F. Supp. 1013, 1022 (S.D.N.Y. 1992), aff'd, 984 F.2d 567 (2d Cir. 1993) ("Sportstick . . . the consolidation of 'sport' and 'stick' in a single word suggests both the product's form and usage, but requires some imagination to surmise the nature of the product. This is the essence of a suggestive mark."). We find that Batherapy is a suggestive trademark.

Para Labs Claim of Infringement

Para Labs acknowledges [*5] that its claim that Better Botanicals' use of Bath Therapy also alleges infringement of its trademark under § 368-d of New York General Business Law.

Section 32 of the Lanham Act, 15 U.S.C. § 1114 provides in pertinent part:

- (1) Any person who shall, without the consent of the registrant —
- (a) use in commerce any reproduction, counterfeit, copy or

colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive

* * *

shall be liable in a civil action by the registrant.

Section 43 of the Lanham Act, 15 U.S.C. § 1125 provides in pertinent part:

(a) Civil Action. Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which —

- (1) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, [*6] or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.

* * *

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

A claim for infringement of a registered trademark must allege and prove that defendant's mark is used (1) in commerce, (2) without consent, (3) in connection with sale, offering for sale, or advertising of services, and (4) in a manner likely to cause confusion or mistake or to deceive purchasers as to the source or origin of such services.

Proof of the likelihood of confusion need not be established by proof of actual confusion. However, "such evidence if available, is entitled to substantial weight." *International Kennel Club v. Mighty Star, Inc.*, 846 F.2d 1079, 1090 (7th Cir. 1988), quoting from *Helene Curtis Industries, Inc. v. Church and Dwight Co., Inc.*, 560 F.2d 1325, 1330 (7th Cir. 1977), cert. denied, 434 U.S. 1070, 98 S. Ct. 1252, 55 L. Ed. 2d 772 (1978).

The key element in deciding the issue presently before the court is the likelihood of confusion or mistake [*7] or the likelihood that purchasers will be deceived as to the source or origin of services.

In *Gruner & Jahr U.S.A. Pub. v. Meredith Corp.*, 991 F.2d 1072, 1077 (2d Cir. 1993), the court states:

We turn now to the key element a plaintiff must prove under 15 U.S.C. § 1114(a) in order to succeed in a trademark infringement suit, that is, that there is a likelihood of confusion or, in other words, that numerous ordinary prudent purchasers are likely to be misled or confused as to the source of the product in question because of the entrance in the marketplace of defendant's mark. See *Western Pub. Co. v. Rose Art Industries, Inc.*, 910 F.2d 57, 59 (2d Cir. 1990). For a finding of infringement a probability of confusion, not a mere possibility of confusion, must be found to exist. See McCarthy, Trademarks §§ 23:1[C], 23:2[B].

The factors ordinarily weighed in determining the likelihood of confusion are the familiar Polaroid factors, which include: 1) the strength of the plaintiff's mark; 2) the similarity of plaintiff's and defendant's marks; 3) the competitive proximity of the products; 4) the likelihood that plaintiff will "bridge the gap" and offer a product [*8] like defendant's; 5) actual confusion between products; 6) good faith on the defendant's part; 7) the quality of defendant's product; and 8) the sophistication of buyers. *Polaroid*, 287 F.2d [492] at 495; see also *Lang v. Retirement Living Pub. Co.*, 949 F.2d 576, 580 (2d Cir. 1991). The Polaroid factors are not dispositive, and additional factors may be considered or initial factors abandoned. See *Polaroid*, 287 F.2d at 495.

Likelihood of Confusion

A trademark is used "to identify and distinguish [] goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." (§ 45 Lanham Act, 15 U.S.C. § 1127) (definition "trademark").

We turn to the Polaroid factors to determine whether Better Botanicals' use of the words Bath Therapy causes confusion in the minds of "numerous ordinary prudent purchasers [who] are likely to be misled or confused as to the source of the product in question because of the entrance in the market place of defendant's mark." *Gruner*,

991 F.2d at 1077.

Strength of Para Labs Mark

Para Labs' trademark Batherapy has been registered and used [*9] by Para Labs for more than forty years. Section 33 of the Lanham Act, 15 U.S.C. § 1115(b) provides:

To the extent that the right to use the registered mark has become uncontestable under section 15, n1 the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of registrant's exclusive right to use the registered mark in commerce.

See *Gruner*, 991 F.2d at 1076; *W.W.W. Pharmaceutical*, 984 F.2d 567, 572 (2d Cir. 1993) ("a mark's strength is assessed using two factors: (1) the degree to which it is inherently distinctive; and (2) the degree to which it is distinctive in the marketplace"), citing *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1131-33 (2d Cir. 1979).

n1 15 U.S.C. § 1065. Under § 15 of the Lanham Act, 15 U.S.C. § 1065, a registered mark which has been in continuous use for more than five years and is still in use is uncontestable.

We find that Batherapy [*10] is a strong mark as applied to beauty products and bathing additives.

Similarity of the Marks

Para Labs argues that the marks sound the same, citing *Banff, Ltd. v. Federated Dep't Stores, Inc.*, 841 F.2d 486 (2d Cir. 1988) (B Wear and Bee Wear). The sound of the marks in this case is somewhat similar but not to the extent found in *Banff*.

The single word Batherapy is not similar to the various Dead Sea Salt Bath Therapy products marketed by Better Botanicals. In addition to the difference in price, the "dissimilarity is accentuated in the nature, packaging, and presentation of the two [products]." *Western Pub. Co., Inc. v. Rose Art Industries, Inc.*, 733 F. Supp. 698, 701 (S.D.N.Y.), aff'd, 910 F.2d 57 (2d Cir. 1990); *W.W.W. Pharmaceutical*, 984 F.2d at 573 ("Although the marks are composed of the same words and sound the same when uttered, several factors distinguish them. First, WWW's mark appears as one word and is the only identifier of the product. On Gillette's product, however, the words "sport" and "stick" are preceded in larger letters by the

well-known brand name "Right Guard.").

We find that prefacing "Indulge Dead Sea Salt," "Cheer Dead Sea [*11] Salt," and "Purify Dead Sea Salt" to the words "Bath Therapy" substantially reduces the likelihood of customer confusion.

The Competitive Proximity of the Products

Both products direct their appeal to consumers suffering from back pains. However, Better Botanicals' marketing emphasizes the presence of Dead Sea salts and essential oils and herbs not found in Batherapy products. As previously indicated, the use of such products required a substantially higher cost to the consumer than Batherapy products. Such a difference in quality and price lessens the competition between the Batherapy and Better Botanicals products.

Likelihood of Confusion

Para Labs concedes that proof of actual confusion is insubstantial. n2

n2 Ms. DeMaille testified that when she called a store and asked if they carried bath therapy, the store keeper said they did and that the manufacturer was Better Botanicals. Joel Estrin, Para Labs' Sales and Marketing Director, testified that on asking a store keeper whether he carried "bath therapy," the response was "which one?"

[*12]

We find there is no likelihood of confusion by an appreciable segment of the purchasing public as to the source of the product. "The obvious price differential and physical differences are such that even the least sophisticated buyer would not be confused as to the relationship of the products or their sources." *Western Pub. Co., Inc.*, 733 F. Supp. at 702.

Fair Use

Better Botanicals asserts as an affirmative defense:

Defendant has the privilege and right to engage in commerce using a descriptive expression notwithstanding plaintiff's alleged trademark rights under 15 U.S.C. § 1115 (P 46).

15 U.S.C. § 1115(b) states in pertinent part:

Infringement as defined in section 32 [15 U.S.C. § 1114] . . . shall be subject to the following defenses or defects:

(4) That the use of the name, term, or de-

vice charged to be an infringement is a use, otherwise than as a mark . . . of a term or device which is descriptive of . . . the goods or services of [a] party, or their geographic origin.

In *Cosmetically Sealed Indus., Inc. v. Chesebrough-Pond's USA Co.*, 125 F.3d 28, 30 (2d Cir. 1997), the court holds that, "the defense permits others to use protected [*13] marks in descriptive ways, but not as marks identifying their own products." n3

n3 The court there held that the defendant's use of the phrase "Seal It With A Kiss" describes "an action that the sellers hope consumers will take, using their product," and therefore avoids liability that would arise if used as a mark identifying defendant's products against plaintiff's trademark "Sealed With A Kiss." *Id.* at 30.

U.S. Shoe Corp. v. Brown Group, Inc., 740 F. Supp. 196, 198 (S.D.N.Y.), aff'd, 923 F.2d 844 (2d Cir. 1990) holds:

The purpose of the defense is to prevent the trademark rights of one party from being extended to preclude another party from the description of his product to the public. When the plaintiff chooses a mark with descriptive qualities, the fair use doctrine recognizes that "he cannot altogether exclude some kinds of competing uses, particularly those which use words in their primary descriptive and non-trademark sense." (citations omitted).

The use of the term "Bath [*14] Therapy" is to describe a method of relief from the pain and discomfort of arthritis or other back conditions. The use of the term "Bath Therapy" prefaced by Dead Sea Salt is to attract purchases to the pleasure of using an exotic salt from the Dead Sea. For example, in *Jean Patou, Inc. v. Jacqueline Cochran, Inc.*, 201 F. Supp. 861, 865 (S.D.N.Y. 1962), aff'd, 312 F.2d 125 (2d Cir. 1963), the trademark "Joy" used on perfumes and toilet waters was not infringed by defendant's use of the phrase "Joy of Bathing" in its bath products. More specifically, the court held:

While it is desirable to protect a person who has built up a public association with certain products under his trademark from having his business taken by somebody else, it is also undesirable to block the channels of expression by giving protection to everyone who may go out and appropriate an ordinary

descriptive word for his own business use. (citation omitted).

* * *

The use of the phrase JOY OF BATHING is designed to suggest the pleasure which will accompany the use of defendant's product in one's bath, and thus performs a descriptive function.

To give the plaintiff the protection it seeks would be the [*15] first step in bestowing upon it a virtual monopoly of any phrase commencing with the word "joy."

B & L Sales Assoc. v. H. Daroff and Sons, Inc., 421 F.2d 352, 354 (2d Cir.), cert. denied, 398 U.S. 952, 90 S. Ct. 1873, 26 L. Ed. 2d 292 (1970) (Phrase "Come On Strong")

was not in a trademark sense).

Conclusion and Order

Para Labs failed to show "either (1) likelihood of success on the merits or (2) sufficiently serious questions going to the merits to make them a fair ground for litigation." Bell & Howell: *Mamiya Co. v. Masel Supply Co. Corp.*, 719 F.2d 42, 45 (2d Cir. 1983), quoting *Jackson Dairy, Inc. v. H.P. Hood & Sons, Inc.*, 596 F.2d 70, 72 (2d Cir. 1979).

Para Labs' motion for a preliminary injunction is denied.

The court will conduct a trial on the merits on May 15, 1998, at 11:00 a.m.

SO ORDERED.

JACOB MISHLER, U.S. District Judge