

On My Mind Blog

Adding a Feature to a Weak Trademark May Avoid a Likelihood of Confusion

02.27.2025 By [William M. Borchard](#)

If you select a trademark dominated by a word or number already in use or registered by several others for identical or related goods or services, your inclusion of some other distinctive feature may be sufficient to avoid a finding of likelihood of confusion for registration purposes.

The following is an example of such a mark:



Metabeauty, Inc. adopted and applied to register the mark shown above, which prominently features the number 12, for skin care preparations (considered included in cosmetics) and retail services.

The Examining Attorney refused registration on the ground that there was a likelihood of confusion with the registered mark TWELVE COSMETICS (with COSMETICS disclaimed) in standard characters for cosmetics. (The number and word apparently are deemed legally equivalent.)

Metabeauty appealed to the Trademark Trial and Appeal Board (TTAB), which generally affirms such refusals about 90% of the time.

1. **Relatedness of the Goods and Services.** Metabeauty merely stated in its brief that “the goods and services differ.” The TTAB pointed out that this was not the correct issue. The proper question was whether the public would be confused as to the *source* of the goods and services. The Examining Attorney’s evidence of about ten third-party websites and several third-party registrations showed that the respective goods and

services were marketed and sold by others under a single trademark in the same trade channels to the same classes of consumers. This relatedness favored likely confusion.

2. **Weakness of the Number 12 or TWELVE for cosmetics.** Third-party registrations are relevant to conceptual strength of a mark. The weaker a registered mark is, the closer an applicant's mark can come. Metabeauty submitted third-party registrations of marks containing 12 or TWELVE for cosmetics, skin care preparations, and hair care preparations, nine of which the TTAB found probative of conceptual weakness. This weakness weighed against likely confusion. (The TTAB did not mention whether or not there was marketplace weakness as well.)
3. **Similarity/Dissimilarity of the Marks.** The TTAB compared the marks in their entireties as to "appearance, sound, connotation and commercial impression." It stated that the most memorable element of the registered mark was the word TWELVE especially since the disclaimed COSMETICS was the generic word for the products and less significant when comparing the marks. In Metabeauty's mark, the number 12 was the name consumers would use to call for the goods, and it was more memorable than the green-colored octagon design, although the design added to the commercial impression of the mark. Presumably, this favored likely confusion.

Despite the relatedness of the goods/services, and the dominance of the 12/TWELVE element in the marks, the TTAB concluded that the two word structure of the registered mark, compared with Metabeauty's mark with its green-colored design element, made the marks sufficiently dissimilar given the weak nature of the number 12 and the word TWELVE in connection with cosmetics.

Accordingly, the TTAB reversed the refusal to register Metabeauty's mark.

[In re Metabeauty, Inc.](#), Application No. 97492557 (T.T.A.B. January 28, 2025)

Author's Note:

Adopting a mark with a dominant element that is weak in trademark significance may not preclude that mark's registration if that mark includes one or more other elements that distinguish it from similar marks. As usual, the factual evidence is key to the outcome, which can be unpredictable.

However, it is well to consider that a mark's weakness may limit the scope of its exclusivity with a resulting inability to stop the use and registration of similar marks.

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Bill has handled domestic and international trademark and copyright matters at the highest level for over 60 years. He has counseled and represented clients on domestic and international trademark matters concerning clearance, registration, proper use, licensing, contested administrative proceedings and infringement claims. He became Senior Counsel in January 2024 and is now focusing on providing guidance and advice to other lawyers within our firm and writing informative and engaging articles on intellectual property law developments.