

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

June 4, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Flageoli, Ltd.

Serial No. 78969164

Daphne Sheridan Bass of the Law Offices of Daphne Sheridan Bass for Flageoli, Ltd.

Jason Paul Blair, Trademark Examining Attorney, Law Office 104 (Christopher Doninger, Managing Attorney).

Before Hairston, Bergsman and Ritchie,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Flageoli, Ltd. filed an intent-to-use application for the mark ICE AGE FULL LIP SERVICE LIP PLUMPER, in standard character form, for "non-medicated lip care preparations," in Class 3. Applicant disclaimed the exclusive right to use the term "Lip Plumper."

The Trademark Examining Attorney refused registration on the ground of likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), because applicant's mark ICE AGE FULL LIP SERVICE LIP PLUMPER, when

used in connection with "non-medicated lip care preparations," so resembles the previously registered mark LIP SERVICE, in typed drawing form, for "non-medicated lip balms," in Class 5, as to be likely to cause confusion.¹

Preliminary Issue

Applicant submitted evidence with its appeal brief. The examining attorney lodged an objection to the evidence on the ground that the evidence was untimely. Trademark Rule 2.142(d) provides that "[t]he record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed." In view thereof, the objection is sustained and we will not consider the evidence attached to applicant's brief.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of

¹ Registration No. 1246795, issued December August 2, 1983; renewed. Registrant disclaimed the exclusive right to use the word "Lip." According to the Trademark Manual of Acceptable Identification of Goods and Services, non-medicated lip balm is classified in International Class 3. Medicated lip balm is classified in International Class 5.

confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also*, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

A. The similarity or dissimilarity and nature of the goods.

It is well settled that likelihood of confusion is determined on the basis of the goods as they are identified in the application and the cited registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re William Hodges & Co., Inc.*, 190 USPQ 47, 48 (TTAB 1976). In analyzing the similarity or relatedness of the goods, it is not necessary that the respective goods be identical or even competitive to find that they are related for purposes of likelihood of

confusion. The issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984). The goods need only be sufficiently related that consumers would be likely to assume, upon encountering the goods under similar marks, that the goods originate from, are sponsored or authorized by, or are otherwise connected to the same source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, applicant is seeking to register its mark for "non-medicated lip care preparations." "Preparations" are "something prepared, manufactured, or compounded: a preparation for sunbathers."² The cited registration is for "non-medicated lip balms." A "balm" is "anything that heals, soothes, or mitigates pain ... salve, unguent, lotion, emollient."³ A "balm" is something "prepared, manufactured, or compounded" so applicant's "non-medicated lip care preparations" are related to, and

² The Random House Dictionary of the English Language (Unabridged), p. 1527 (2nd ed. 1987). *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

³ *Id.* at 161.

actually encompass, registrant's "non-medicated lip balms." Because applicant's goods encompass the goods in the cited registration, the goods are in part identical.

Applicant argues the goods are different because its mark will be used to identify a "lip plumper" used to make lips appear larger and more attractive while the cited registration is for lip balms used to relieve the discomfort of chapped lips. However, as stated above, the issue of likelihood of confusion must be resolved on the basis of the goods as set forth in the application and the registration. In this case, applicant broadly described its goods as "preparations" which encompass lip balms, not lip plumpers.

B. The similarity or dissimilarity of likely-to-continue trade channels and the buyers to whom sales are made.

Because the goods are in part identical and because there are no limitations in either the registration of the application, we must presume that applicant's and registrant's goods will be sold in the same channels of trade and will be bought by the same classes of consumers.

See Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002); *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490,

1 USPQ2d 1813, 1815 (Fed. Cir. 1987); and *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994).

C. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We turn now to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that 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 terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a

general rather than specific impression of the marks.

Winnebago Industries, Inc. v. Oliver & Winston, Inc.,
207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott
Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Since the
products at issue are lip care preparations and balms, the
average consumer is an ordinary consumer.

In comparing the marks, it is a well-established
principle that, in articulating reasons for reaching a
conclusion on the issue of likelihood of confusion, there
is nothing improper in stating that, for rational reasons,
more or less weight has been given to a particular feature
of a mark, provided the ultimate conclusion rests on a
consideration of the marks in their entireties. *In re
National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed.
Cir. 1985). The feature common to both marks in this case,
LIP SERVICE, is suggestive. "Lip" refers to a part of the
body (*i.e.*, "either of the two fleshy parts or folds
forming the margins of the mouth and functioning in
speech").⁴ "Service" is "an act of helpful activity; help;
aid ... supplying maintenance and repair to make fit for use;
repair; restore to condition for service."⁵ Thus, "lip
service" means to aid or restore the lips. This conclusion

⁴ *Id.* at 1120.

⁵ *Id.* at 1750.

is further corroborated by the applicant's addition of the word "Full" before "Lip Service" creating the term "Full Lip Service" further emphasizing the highly suggestive, if not descriptive, nature of the term "Lip Service" as used by applicant.

"The scope of protection to be afforded suggestive marks such as [registrant's mark] must be somewhat limited in scope and cannot be extended to preclude the subsequent registration of another mark which also has a similar suggestive connotation as applied to the goods, provided that said other mark is otherwise sufficiently distinguishable from the first." *Exxon Corp. v. U.S. Industries, Inc.*, 213 USPQ 393, 395 (TTAB 1982) ("there are sufficient differences in the marks 'RUFFIES' and 'RUFF 'N REDDI' as to avoid a likelihood of confusion"); *see also Standard Brands, Inc. v. Peters*, 191 USPQ 168, 172 (TTAB 1976) (the addition of "Corn" to CORN-ROYAL is sufficient to distinguish it from ROYAL, ROYAL FLO-N-FRY an ROYAL GOLDEN BLEND); *General Mills, Inc. v. Frito-Lay, Inc.*, 176 USPQ 148, 154 (TTAB 1972) (FUNYUNS does not so resemble ONYUMS that confusion is likely).

Because "Lip Service" is suggestive, the dominant portion of applicant's mark is the term "Ice Age" which is a completely arbitrary term when used in connection with

lip balms. The significance of the term "Ice Age" as the dominant element of applicant's mark is further reinforced by its location as the first part of the mark. See *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"); see also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers must first notice the identical lead word).

While the marks at issue share the term "Lip Service," we find that "Lip Service" is a suggestive term that limits the scope of exclusivity afforded the registered mark. This is not to say that the inclusion of the identical words "Lip Service" in applicant's mark can be ignored, or that it does not contribute to the commercial impression of that mark. However, when the marks are compared in their entireties, the addition of the arbitrary term "Ice Age" to applicant's mark serves to distinguish the marks because

consumers are likely to regard "Lip Service" as used in applicant's mark as indicating the function of applicant's lip preparation, and to look to the other elements in the mark to indicate the source of applicant's product.

As stated by the Court of Customs and Patent Appeals, the predecessor to our reviewing court,

"* * * It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility for confusion that exists in the latter case."

Sure-Fit Products Company v. Saltzson, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958).

Unlike the case where the cited registration is an arbitrary or famous mark, the addition of ICE AGE to the suggestive term LIP SERVICE is sufficient to distinguish the marks. Accordingly, we find that the marks are not confusingly similar in terms of appearance, sound, meaning and commercial impression.

D. Balancing the factors.

Despite the identity of the goods and the presumption that the goods move in the same channels of trade and are sold to the same classes of consumers, the differences in the marks is sufficient to negate finding that there is a likelihood of confusion. In other words, the dissimilarity of the marks outweighs the other relevant factors. *Kellogg Co. v. Pack'em Enterprises, Inc.*, 14 USPQ2d 1545 (TTAB 1989), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

Decision: The refusal to register is reversed.