

This Opinion is Not a
Precedent of the TTAB

Mailed: January 18, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
—

Johnson & Johnson

v.

Pissterine, LLC
—

Opposition No. 91254670
—

James D. Weinberger and Sydney Kipen of Fross Zelnick Lehrman & Zissu PC,
for Johnson & Johnson.

Pissterine, LLC, represented by Andy Zou, “owner.”
—

Before Taylor, Bergsman, and Pologeorgis,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:



Pissterine, LLC (“Applicant”) seeks registration on the Principal Register for the
mark PISSTERINE (in standard characters) for the following goods:

Mouthwashes, not for medical purposes; Non-medicated
mouthwash and gargle; Non-medicated mouthwashes, in
International Class 3.¹

¹ Application Serial No. 88542484 was filed July 27, 2019, and is based upon Applicant’s
allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the
Trademark Act, 15 U.S.C. § 1051(b).

Johnson & Johnson (“Opposer”) opposes registration of Applicant’s mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Opposer alleges ownership and use of the LISTERINE mark in connection with oral care products based on first use in commerce as early as 1881. Not. of Opp.

¶ 4.2 Opposer pleads ownership of nine registrations (one now cancelled³) for its previously used and registered LISTERINE marks, as set forth below:⁴

Registration No. /Status	Mark	Goods/Services
41413 Issued November 3, 1903; renewed (6 th)	LISTERINE	Liquid chemical or medical preparation manufactured by us under a private formula and more especially known as an antiseptic, in Class 5
45682 Issued August 29, 1905; renewed (6 th)		Antiseptic medicinal preparations, in Class 5
85150 Issued January 30, 1912; renewed (6 th)	LISTERINE (standard characters)	Antiseptic for medicinal use, personal hygiene, and toilet, in Class 5
118052 Issued August 14, 1917; renewed (6 th)		Tooth-paste, in Class 3

² 1 TTABVUE 7. To the extent Opposer additionally claims common law rights in the LISTERINE mark(s) for the same or very similar goods as those identified in the pleaded registrations, given the presumptions accorded a registration under Section 7(b) of the Trademark Act, we confine our likelihood of confusion analysis to Opposer’s pleaded registrations vis-à-vis Applicant’s applied-for mark.

³ *Id.* at 7-8. Registration No. 3721217 was cancelled because “registrant [Opposer] did not file an acceptable declaration under section 8.” A cancelled registration is not evidence of any existing rights in the mark. *See Action Temp. Servs. v. Labor Force*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989). An expired or cancelled registration is evidence of nothing but the fact that it once issued. *Sunnen Prods. Co. v. Sunex Int’l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987). Accordingly, we have not considered this registration in our decision.

⁴ *Id.*

Registration No. /Status	Mark	Goods/Services
240162 Issued May 1, 1881; renewed (5 th)	LISTERINE (Typed format)	Medicinal, antiseptic compound, in Classes 3 and 5.
3933530 Issued March 22, 2011; Section 8 & 9 declaration received	LISTERINE (standard characters)	Information services, namely, providing health information on the subjects of oral care and oral health provided through interactive social media websites, in Class 44
3729760 Issued December 22, 2009; renewed (1 st)	LISTERINE (standard characters)	Dental floss, in Class 21
4163328 Issued April 25, 2011; Section 8 & 9 declaration received	LISTERINE	Medicated mouthwash, in Class 5

Opposer also opposes registration of Applicant’s mark on the ground of dilution by blurring or tarnishment of its famous LISTERINE Mark, in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).⁵

Applicant, in its answer, admitted that “Opposer has for many years been engaged in the manufacture, distribution, marketing, and sale of a wide variety of personal care products” and that “[t]he LISTERINE Mark has been used continuously and/or registered by Opposer since a date prior to any date on which Applicant can rely,”⁶ but denied the remaining salient allegations in the Notice of Opposition.⁷

⁵ 1 TTABVUE 10 (Not. of Opposition ¶ 13).

⁶ 1 TTABVUE 6, 5 TTABVUE 2 and 3 (Notice of Opposition ¶¶ 1 and 7, Answer ¶¶ 1 and 7).

⁷ 5 TTABVUE. Applicant asserted six statements or allegations characterized as “Affirmative Defenses.” *Id.* at 3-4 Answer at ¶¶ 15-21. The statement set forth at paragraph 15 merely

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122, 37 CFR § 2.122, the file of the subject application. During its testimony period, Opposer made of record the following:

1. The testimony declaration, with Exhibits 1 through 10, of Kamran Shahzad, Opposer's Senior Brand Manager for the LISTERINE® brand⁸ (alternatively referred to as the Shahzad decl.); and

2. Opposer's notice of reliance on printouts from the Trademark Status and Document Retrieval (TSDR) database of Opposer's seven live pleaded registrations showing current status and title of those registration.⁹

Applicant did not take testimony or otherwise submit any evidence. Only Opposer filed a brief. *See* TBMP § 801.02(b) ("The filing of a brief on the case is optional, not mandatory, for a party in the position of defendant."); *see also* Trademark Rule 2.128(a)(1), 37 C.F.R. § 2.128(a)(1).

incorporates Applicant's prior responses to the enumerated allegations in the Notice of Opposition. The statements at paragraphs 18-20 constitute mere amplifications of the denials in the answer and have been treated as such. Applicant did not pursue, at trial or in briefing, the allegations at paragraphs 16-17 and 21 that its mark is a parody and falls under the fair use exclusion or that "registration and ownership of the mark and the mark itself is part of an expression protected by the First Amendment," so these defenses have been forfeited. *See TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1100-01 (TTAB 2018) (affirmative defenses waived because not pursued at trial or argued in brief).

⁸ 8 TTABVUE (confidential version including confidential Exhibit 10) and 9 TTABVUE (redacted version, excluding Exhibit 10). Exhibit 4 is a media file that was submitted as a bulky exhibit (11 TTABVUE).

⁹ 10 TTABVUE.

II. Opposer's Entitlement to a Cause of Action¹⁰

Entitlement to a statutory cause of action is an essential element in every inter partes case. *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)). A party in the position of plaintiff may oppose registration of a mark when it demonstrates an interest falling within the zone of interests protected by the statute, 15 U.S.C. § 1063, and a reasonable belief in damage that is proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at * 6-7 (Fed. Cir. 2020), *cert. denied*, 141 S.Ct. 2671 (2021).

Opposer's entitlement to oppose registration of Applicant's mark is established by its pleaded registrations listed above, which the record shows to be valid and subsisting, and owned by Opposer.¹¹ *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1501 (TTAB 2015). In addition, as noted, Applicant admitted that Opposer has for many years been engaged in the manufacture, distribution, marketing, and sale of a wide variety of personal care products.

¹⁰ Board decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of "standing." Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Section 13 and 14 remain applicable. *See Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

¹¹ 10 TTABVUE (Opposer's Notice of Reliance).

III. Priority

To establish priority in a likelihood of confusion claim brought under Trademark Act Section 2(d), a party must prove that, vis-à-vis the other party, it owns “a mark or trade name previously used in the United States ... and not abandoned....” Trademark Act Section 2, 15 U.S.C. § 1052. A party may establish its prior proprietary rights in a mark through ownership of a registration, actual use or through use analogous to trademark use. *See* Trademark Act Sections 2(d) and 45, 15 U.S.C. §§ 1052(d) and 1127; *T.A.B. Sys. v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996). Because Opposer’s pleaded registrations are properly of record, priority is not at issue in the opposition with respect to the LISTERINE mark(s) for the goods and services identified therein. *See King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Applicant does not contest Opposer’s priority, but instead admitted Opposer’s prior use and registration of the LISTERINE marks.

IV. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.* (“*DuPont*”), 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-1163 (Fed. Cir. 2019) (Board considers each *DuPont* factor for which there is evidence

and argument). 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 pleaded marks and that use of Applicant's mark is likely to cause confusion, mistake, or deception as to the source or sponsorship of Applicant's goods, *Cunningham*, 55 USPQ2d at 1848, even in the absence of contrary evidence or argument. *Threshold TV, Inc. v. Metronome Enters., Inc.*, 96 USPQ2d 1031, 1040 (TTAB 2010).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors, and the other *DuPont* factors for which there is evidence and argument, are discussed below.

A. Strength of Opposer's Mark

We first consider the strength of Opposer's LISTERINE marks in order to evaluate the scope of protection to which they are entitled. The strength of a mark rests on the extent to which "a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator." *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (citing *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)). In determining the strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition. *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d

1458, 1476 (TTAB 2014); *see also In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010).

1. Inherent or Conceptual Strength

To determine the conceptual strength of Opposer's LISTERINE marks, we evaluate where they lie "along the generic-descriptive-suggestive-arbitrary (or fanciful) continuum..." *In re Davia*, 110 USPQ2d 1810, 1815 (TTAB 2014)), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019).

Opposer's asserts, and Applicant does not dispute, that its "LISTERINE mark is a term that does not describe or suggest any characteristics of qualities of the recited goods in the LISTERINE registrations, namely mouthwash, antiseptics, dental floss, or providing information on oral care" and is therefore arbitrary and entitled to a broad scope of protection. Opposer's brief. p. 22.¹² Indeed, the record shows that "[t]he initial inspiration for the name LISTERINE came from an English doctor, Joseph Lister, who was the first surgeon to perform an operation in a chamber sterilized with antiseptics." Shahzad decl. ¶ 7.¹³ We accordingly find Opposer's LISTERINE mark to be arbitrary and thus conceptually strong. *See e.g., Palm Bay v. Veuve Clicquot*, 73 USPQ2d at 1692 (arbitrary terms are conceptually strong trademarks); *Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1181 (Fed. Cir. 2004) (defining a fanciful mark as "a non-dictionary word concocted by the trademark holder for its product" and observing that such marks are typically

¹² 12 TTABVUE 24. Opposer also argues its pleaded LISTERINE marks are inherently distinctive, eight of which being incontestable and not subject to challenge as descriptive.

¹³ 9 TTABVUE 4.

strong); *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1479 (TTAB 2007) (completely unique and arbitrary, if not coined, nature of mark in relation to goods entitles the registered mark to a broad scope of protection, and significantly increases the likelihood that the marks, when used in connection with the identical goods would cause confusion).

Additionally, inasmuch as Opposer's LISTERINE mark(s) are registered, they must be accorded all of the presumptions that are to be accorded registered marks pursuant to Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b) .

We find that LISTERINE is an inherently or conceptually strong mark.

2. Commercial Strength or Fame

We next analyze the commercial strength or fame of Opposer's LISTERINE mark(s). A commercially strong or famous mark is one that has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). "Fame of an opposer's mark, if it exists, plays a 'dominant role in the process of balancing the *DuPont* factors.'" *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)).

In the likelihood of confusion analysis, fame varies along a spectrum from very strong to very weak. *Joseph Phelps Vineyards*, 122 USPQ2d at 1734. Because of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012); *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009).

Strength or fame of a mark “may be measured indirectly by the volume of sales and advertising expenditures in connection with the [goods or services] sold [or provided] under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the [goods and services] identified by the mark []; and the general reputation of the [goods and services].” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1056 (TTAB 2017); *see also Bose* 63 USPQ2d at 1305-06.

To demonstrate the commercial strength or fame of its LISTERINE mark(s), Opposer primarily relies on the declaration testimony of its Senior Brand Manager, Kamran Shahzad and accompanying exhibits. Mr. Kamran particularly testifies that:

- The ... LISTERINE Brand date[s] back to 1879 when Dr. Joseph Lawrence introduced the first antiseptic mouthwash for use in surgeries and bathing wounds, and it was first sold to dentists in 1895¹⁴;
- the LISTERINE name and mark has been used continuously in the U.S. since the launch of LISTERINE mouthwash in 1879, and appear prominently on product packaging and in connection with the LISTERINE Brand information services¹⁵;
- Opposer provides LISTERINE Brand information on its website, in brochures, on office posters, on fact sheets, and education handouts; and provides educational and support programs called “The Office Essentials Program and The Student Essentials Program,” through which it offers dentists and hygienists free patient samples and patient education. Opposer also has distributed three million samples of rinse and floss via direct mail and

¹⁴ 9 TTABVUE 3 (Shahzad decl. ¶ 5).

¹⁵ *Id.* at TTABVUE 4-5 (Shahzad decl. ¶¶ 7-8).

sampling in addition to two million coupons to boost trial incentives and patient education¹⁶;

- Opposer has tracked 5.8 million impressions on digital, social, search and print media with 20,000 unique visitors each month to the LISTERINE Professional section of its website, and registered a total 30,000 Office Essentials members¹⁷;
- LISTERINE products are sold throughout the United States in brick and mortar pharmacies, grocery and convenience stores and online. Examples of retailers that offer LISTERINE products both in store and online, include, e.g., Target, Duane Reade, Walgreens, Rite Aid, Bed Bath & Beyond, CVS Pharmacy, and Walmart¹⁸;
- Although the specific sales figures for the LISTERINE branded products are confidential,¹⁹ LISTERINE sales figures for the United States are impressive, with 1.5 billion bottles of LISTERINE Brand mouthwash having been sold in the United States in the last decade. Based on the sales, relative to the market, LISTERINE is the number one mouthwash brand in the U.S.²⁰;
- Opposer advertises its LISTERINE products in a variety of media, including newspapers, magazines, television, radio, outdoor advertising, digital and the Internet²¹;

¹⁶ *Id.* at TTABVUE 5, 20-352 (Shahzad decl. ¶¶ 9-10, Exs. 2 and 3).

¹⁷ *Id.* at TTABVUE 5, (Shahzad decl. ¶ 10).

¹⁸ *Id.* at 9, 415-463 (Shahzad decl. ¶ 19, Ex. 8).

¹⁹ It appears that Opposer inadvertently failed to redact previously categorized confidential sales figures in certain portions of its brief. Opposer is allowed until twenty days from the mailing date of this order to resubmit its redacted brief, if necessary. If a substitute redacted brief is timely received, the previously submitted one will be treated as confidential.

²⁰ 9 TTABVUE 9 (Shahzad decl. ¶ 20)

²¹ *Id.* at 6 (Shahzad decl. ¶ 11).

- Opposer's advertising figures for its LISTERINE products also are confidential and, similar to its sales figures, also are quite impressive²²;
- Opposer advertises its LISTERINE mark(s) through commercials, videos, and digital display advertisements shown on various streaming services, channels, and social media platforms, including ABC, ABC News, Amazon, CBS, Discovery, Ellen Tube, Hearst, Hulu, Meredith, MLS Soccer, NBCU, Pulpo, Roku, Scripps Networks, Telemundo, Tubi TV, Viacom, and YouTube. These platforms garner hundreds of millions of views annually and LISTERINE commercials have received significant attention from both consumers and the media. Specifically, the LISTERINE YouTube Channel has 19.6 thousand subscribers and 49,995,033 million views²³;
- Opposer also has placed print advertisements and coupons in a variety of national newspapers and magazines, including All Recipes, Better Homes & Gardens, Cosmopolitan, Entertainment Weekly, Food Network Magazine, Good Housekeeping, O The Oprah Magazine, People, People En Espanol, Southern Living, and Woman's Day, and on retail displays prominently featuring the LISTERINE mark in stores carrying LISTERINE branded products²⁴;
- Opposer engages in outdoor advertising of the LISTERINE brand by displaying LISTERINE campaigns in high traffic areas²⁵;
- Opposer also uses social media and online dissemination of advertising campaigns, including Instagram, Facebook and Twitter, which receive "a significant amount" of traffic from U.S. consumers,

²² 8 TTABVUE (Shahzad confidential testimony declaration).

²³ *Id.* at 7, 355-365 (Shahzad decl. ¶ 14, Ex. 4; *see also* 11 TTABVUE (bulky specimen)).

²⁴ *Id.* at 7, 367-377 (Shahzad decl. ¶ 15, Ex. 5).

²⁵ *Id.* at 8, 378-381 (Shahzad decl. ¶ 16, Ex. 6).

and has partnered with social media influencers to promote its products²⁶; and

- LISTERINE goods and services have received significant unsolicited press coverage.²⁷

In view of the above, we find that Opposer has established that its pleaded registered LISTERINE mark(s) falls on the much higher end of the commercial strength spectrum “from very strong to very weak,” *Joseph Phelps Vineyards*, 122 USPQ2d at 1734 and, in fact, is famous for oral care products and services.²⁸ Notably, there is no third-party use evidence to diminish the demonstrated commercial strength and fame of Opposer’s LISTERINE mark(s).

In sum, the conceptual and commercial strength (and fame) of Opposer’s LISTERINE mark(s) strongly supports a finding that confusion is likely.

B. Similarity of the Marks

We now turn to the first *DuPont* factor focusing on the similarity or dissimilarity of the marks, keeping in mind that famous marks, as is the case here, receive a broader scope of protection than other marks. *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) (“A strong mark ... casts a long shadow which competitors must avoid. ... Thus, the Lanham Act’s tolerance for similarity between competing marks varies inversely with the fame of

²⁶ *Id.* at 8, 382-414 (Shahzad decl. ¶ 17, Ex. 7).

²⁷ *Id.* at 9, 464-553 (Shahzad decl. ¶ 21, Ex. 9).

²⁸ In making this finding, we have not relied on the summaries of Opposer’s commissioned market surveys regarding consumer awareness because its methodology was insufficient. We also give little consideration to Opposer’s purported YouGov BrandIndex Awareness position because of a lack of confirming evidence.

the prior mark. As a mark's fame increases, the Act's tolerance for similarities in competing marks falls.”).

In considering the marks, we compare them in their entirety as to appearance, sound, connotation and commercial impression. *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 at 1812 (TTAB 2014)); accord *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

“The proper test 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.” *Coach Servs.*, 101 USPQ2d at 1721 (citation omitted); *In re i.am.symbolic*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Here, the average purchaser is an ordinary consumer of oral care preparations and services.

We compare Opposer's LISTERINE standard character mark and its minimally stylized LISTERINE marks with Applicant's standard character PISSTERINE mark

and find them visually similar to the extent that they consist of similarly structured one-word terms that end with the letter string “ERINE. The difference in the first letters “P” and “L,” and the use of a single letter “S” in Opposer’s mark versus a double letter “S” in Applicant’s mark, do little to distinguish the marks’ appearance. *See e.g., American Cyanamid Co. v. U.S. Rubber Co.*, 356 F.2d 1008, 148 USPQ 729 (CCPA 1966) (PHYGON confusingly similar to CYGON); *Research in Motion Ltd. v. Defining Presence Mktg. Grp., Inc.*, 102 USPQ2d 1187, 1193 (T.T.A.B. 2012) (finding CRACKBERRY confusingly similar to BLACKBERRY where “[b]oth marks consisted of an unbroken string of ten letters broken into three syllables” differing only in their first two letters, the “stress and cadence of the marks could be, and almost surely are, identical,” and “[t]he first syllables of the respective marks (“black” and “crack”) are undeniably similar in sound, and the balance of each mark is the identical word ‘- berry”). Moreover, the additional letter “S” in Applicant’s mark is embedded in the middle of the term and may not even be noticed.

The minimal stylization in some of Opposer’s LISTERINE marks also does not distinguish those marks from Applicant’s. Because Applicant’s mark is registered in standard characters, Applicant is not limited to any particular depiction of its mark; it may be displayed in any lettering style; the rights reside in the wording and not in any particular display. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908, 1909 (Fed. Cir. 2012); *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1284 (TTAB 2009). Thus, Applicant may display its PISSTERINE mark in the identical font style

and size in which Opposer's stylized marks are shown. *See* Trademark Rule 2.52(a); 37 C.F.R. § 2.52(a).

As to sound, both Opposer's LISTERINE mark and Applicant's PISSTERINE mark are similar in that they have the same three-syllable cadence, with a rhyming first syllable and identical following syllables. *See In re Energy Telecomms. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983) ("Slight differences in the sound of similar marks do not avoid a likelihood of confusion.").

As to connotation, Opposer's LISSTERINE mark(s) and, in the absence of any evidence regarding consumer perception of Applicant's PISSTERINE mark, both appear to be arbitrary. Nonetheless, given the fame of Opposer's LISTERINE mark(s) and the similarities between the marks in appearance and sound, we find the marks in their entirety to be similar.

The similarity of marks *DuPont* factor thus weighs in Opposer's favor.

C. Similarity of Goods and Services, Trade Channels and Consumers

We next compare Applicant's goods to Opposer's goods and services under the second *DuPont* factor. "This factor considers whether 'the consuming public may perceive [the respective goods and services of the parties] as related enough to cause confusion about the source or origin of the goods and services.'" *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014). In making our determination regarding the relatedness of the goods and services, we must look to the goods as identified in Applicant's application and the goods and services recited in Opposer's registrations. *See In re Detroit Athletic Co.*, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018);

In re Dixie Rests., Inc., 105 F.3d 1405, 41 USPQ 1531, 1534 (Fed. Cir. 1997); *see also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

Relatedness may be shown on the basis of those identifications alone, without resort to extrinsic evidence. *Hewlett-Packard v. Packard Press*, 62 USPQ2d at 1004-05. “[L]ikelihood of confusion can be found ‘if the respective products [and services] are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

Here, we find from the face of the respective identifications that Applicant’s non-medicated mouthwashes and gargles and Opposer’s medicated mouthwash, antiseptic, tooth-paste, dental floss, and providing health information on oral care and oral health are inherently related and complementary. Particularly, the medicated and non-medicated mouthwashes may be used independently for the same purpose, namely as an oral rinse, and all of the respective goods and services may be used and rendered together in an oral care regimen and to promote oral health. *See Kellogg Co. v. Gen. Mills Inc.*, 82 USPQ2d 1766, 1770-71 (TTAB 2007) (goods may be found intrinsically related without further evidence). We therefore find Applicant’s goods and Opposer’s goods and services related for purposes of our likelihood of confusion analysis.

Furthermore, because there are no limitations as to channels of trade or classes of purchasers in Applicant's identification of goods or Opposer's identifications of goods and services, we must presume that the respective goods and services move in all channels of trade usual for these goods and services. *See In re Detroit Athletic*, 128 USPQ2d 1047, 1052 (TTAB 2018) (quoting *In re i.am.symbolic*, 123 USPQ2d at 1750 ("In the absence of meaningful limitations in either the application or the cited registrations, the Board properly presumed that the goods travel through all usual channels of trade and are offered to all normal potential purchasers.")).

As shown by the record, channels of trade for Opposer's goods and services and goods of the type identified in Applicant's application, include, or would include, online and brick and mortar grocery, drug, and big box stores which are, or would be, purchased by the usual classes of purchasers, which in this case include ordinary consumers. We accordingly find the channels of trade and the classes of consumers to overlap.

Accordingly the *DuPont* factors concerning the relatedness of the goods and services, trade channels and classes of consumers favor a finding of likelihood of confusion.

D. Sophistication of the Consumers/Purchasing Care

As pointed out by Opposer, neither Applicant's application nor Opposer's registrations are limited to "expensive goods that invite sophisticated purchasing decisions." In fact, the records shows, at least with regard to Opposer's oral care

products in the nature of mouthwash, toothpaste and dental floss,²⁹ that they are relatively inexpensive, selling for under \$10 a unit.³⁰ Given the demonstrated inexpensive pricing of oral care products, we find that consumers will include ordinary consumers who will exercise no more than ordinary care in their purchasing decisions and who may purchase such products on impulse. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000) (“When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.”). The standard of care is that of the least sophisticated potential purchaser. *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1163 (cited in *In re FCA US LLC*, 126 USPQ2d at 1222 (“Board precedent requires our decision to be based on the least sophisticated potential purchasers.”)).

This *DuPont* factor accordingly is neutral.

E. 13th DuPont Factor – Applicant’s Intent

An applicant’s bad faith adoption and use of a mark may be considered under the thirteenth *DuPont* factor. *Tao Licensing*, 125 USPQ2d at 1063-64 (citing *J & J Snack Foods*, 18 USPQ2d at 1891) (“Whether there is evidence of intent to trade on the goodwill of another is a factor to be considered.”); *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628, 1630 (Fed. Cir. 1988) (“proof of intent

²⁹ Applicant seeks registration of its mark based on a bona fide intention to use in commerce and there is no record evidence that Applicant has commenced use of its mark in connection with the identified non-medicated mouthwash.

³⁰ 9 TTABVUE 416-462 (Shahzad decl., Ex. 8).

to trade on another's goodwill" can provide "persuasive evidence of likelihood of confusion").

A finding of bad faith must be supported by evidence of an intent to confuse, rather than mere knowledge of another's mark or even an intent to copy. *See, e.g., Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769, 1782 (2d Cir. 2009) ("[T]he only relevant intent is intent to confuse. There is a considerable difference between an intent to copy and an intent to deceive.") (quotation omitted).

Opposer maintains that Applicant's intent in adopting the PISSTERINE mark also establishes a likelihood of confusion between the parties' marks. Citing *L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883, 1891 (TTAB 2008), Opposer specifically argues that:

Applicant's mark is plainly a play on Johnson & Johnson's LISTERINE mark, a fact which Applicant effectively admits in its answer to the Notice of Opposition by stating that its PISSTERINE mark "is a parody." ... As such, Applicant's PISSTERINE mark intentionally seeks to and does call to mind LISTERINE. This "leads . . . to the conclusion that [A]pplicant's adoption of [Applicant's Mark] was in bad faith, with the intention to trade off of [the LISTERINE mark]. ..."

Opposer's brief p. 34 (internal citation omitted).³¹

We acknowledge, as Opposer argues, that Applicant's intention for its mark to be a parody does not necessarily negate a finding of likelihood of confusion. *See e.g., Nike, Inc. v. Maher*, 100 U.S.P.Q.2d 1018, 1023 (TTAB 2011) ("[P]arody is not a defense if the marks would otherwise be considered confusingly similar."); *Starbucks U.S.*

³¹ 12 TTABVUE 34.

Brands, LLC v. Ruben, 78 U.S.P.Q.2d 1741, 1754 (T.T.A.B. 2006) (holding LESSBUCKS COFFEE confusingly similar to STARBUCKS and STARBUCKS COFFEE, for identical goods and services, noting that “parody is unavailing to applicant as an outright defense and, further, does not serve to distinguish the marks”).

However, a parody, defined in MERRIAM-WEBSTER.COM DICTIONARY in part as “a feeble or ridiculous imitation,”³² by its very nature is an attempt to create an association in the form an outlandish imitation. *Cf.*, *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 84 USPQ2d 1969 (4th Cir. 2007) (“While a parody intentionally creates an association with the famous mark in order to be a parody, it also intentionally communicates, if it is successful, that it is not the famous mark, but rather a satire of the famous mark.”). As such, we do not find that Applicant’s intent to create a parody with its PISSTERINE mark, by itself, evidences an intention to trade on the goodwill of Opposer’s LISTERINE mark(s). In order to demonstrate that Applicant’s application was filed in bad faith, Opposer must show that Applicant intentionally sought to trade on Opposer’s good will, and the record evidence is insufficient to support this contention.

Thus, the thirteenth *DuPont* factor based on bad faith adoption is neutral.

³² Merriam-Webster, <https://www.merriam-webster.com/dictionary/parody>. Accessed 5 Jan. 2022. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold.TV Inc.*, 96 USPQ2d at 1038 n.14.

F. Conclusion

After considering all of the evidence of record and all the arguments pertaining to the applicable likelihood of confusion factors, we find that Opposer has demonstrated, by a preponderance of the evidence, that confusion is likely between Applicant's PISSTERINE mark for "mouthwashes, not for medical purposes; non-medicated mouthwash and gargle; [and] non-medicated mouthwashes" and Opposer's registered LISTERINE mark(s) for medicated mouthwash, antiseptic preparations, tooth-paste, dental floss, and providing information on oral care. We find so given the fame of Opposer's conceptually arbitrary LISTERINE mark – which entitles it to a wide latitude of protection, the similarity of the marks, the related and complementary nature of the goods and services and the overlapping trade channels and classes of consumers.

V. Dilution

In view of our decision finding a likelihood of confusion, we need not reach the issue of dilution. *See Venture Out Props. LLC. v. Wynn Resorts Holdings, LLC*, 81 USPQ2d 1887, 1894 (TTAB 2007).

Decision: The opposition to the registration of the PISSTERINE mark in Application Serial No. 88034012 is sustained on the ground of likelihood of confusion under Section 2(d), and registration to Applicant is refused.