

This Opinion is Not a
Precedent of the TTAB

Mailed: December 4, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

—
The Lip Bar, Inc.

v.

Suzanne Lang Fragrance Inc.

—
Opposition No. 91277112

—
Staci R. DeRegnaucourt of Varnum LLP, for Opposer The Lip Bar, Inc.

Scott J. Slavick and Thomas M. Williams, of Barack Ferrazzano
Kirschbaum & Nagelberg LLP, for Applicant Suzanne Lang
Fragrance Inc.

—
Before Wellington, Johnson, and Lavache,
Administrative Trademark Judges.

Opinion by Johnson, Administrative Trademark Judge:¹

Suzanne Lang Fragrance Inc. (“Applicant” or “SLF”) seeks to register the standard character mark LIP LAB (“Applicant’s Mark”) on the Principal Register for “cosmetics; make-up; lip gloss; lip liner; lipstick; beauty masks, namely, lip masks; lip crayons; lip

¹ The citation form in this opinion is in a form provided in the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03 (2024). This opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals only by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board, this opinion employs citation to the Westlaw (WL) database unless noted otherwise. Practitioners should adhere to the guidance set forth in TBMP § 101.03.

pencils; lip tints; lip primers; lip cream; lip scrubs; pre-moistened cosmetic wipes, namely, lip wipes; lip oil; blush; mascara; eye liner; eye shadow; face powder; pressed face powder; foundation make-up” (“Applicant’s Goods”) in International Class (“Class”) 3.²

In its Notice of Opposition,³ The Lip Bar, Inc. (“Opposer”) pleads prior use and registration of the following marks (collectively, “The Lip Bar marks”):

- (1) Registration No. 5579335 (“335 Registration”) for the standard character mark THE LIP BAR;⁴ and
- (2) Registration No. 4160619 (“619 Registration”) for “The Lip Bar stylized mark” shown below,⁵



both in Class 3 for

Cosmetic pencils; Cosmetic preparations; Cosmetics; Cosmetics and cosmetic preparations; Cosmetics and make-up; Cosmetics in general, including perfumes; Cosmetics, namely, lip primer; Cosmetics, namely, lip repairers; Lip balm; Lip cream; Lip gloss; Lip gloss palette; Lip liner; Lip polisher; Lipstick; Lipstick cases; Lipstick holders; Lipsticks; Make-up kits comprised of Lipstick, Lip gloss, lip balm, Lip Pencils and Lip exfoliants.

² Application Serial No. 90768628 was filed on June 11, 2021, under Section 1(b) of the Trademark Act, 15 U.S.C § 1051(b), based upon SLF’s allegation of a bona fide intent to use the mark in commerce.

³ Notice of Opposition, 1 TTABVUE. Citations to the record are to the publicly available documents in TTABVUE, the Board’s electronic docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, 2014 WL 343270, at *2 n.6 (TTAB 2014). The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry, if applicable. Opposer’s Amended Trial Brief is located at 37 TTABVUE and Opposer’s Confidential Trial Brief is located at 34 TTABVUE. Opposer’s Rebuttal Brief is located at 38 TTABVUE and Opposer’s Confidential Rebuttal Brief is located at 39 TTABVUE. Unless noted otherwise, we will refer to the non-confidential versions of the parties’ briefs.

⁴ Registered Oct. 9, 2018. “LIP” is disclaimed.

⁵ Registered June 19, 2012; renewed. “LIP” is disclaimed.

As grounds for the opposition, Opposer alleges that use of Applicant's Mark, LIP LAB, would be likely to cause confusion with Opposer's The Lip Bar marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

I. Affirmative Defenses

In its Answer,⁶ Applicant denies the salient allegations of the Notice of Opposition. As an affirmative defense, Applicant asserts the prior registration, or *Morehouse*, defense. *See Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881 (CCPA 1969). The principle of the *Morehouse* defense is that an opposer cannot be further damaged, within the meaning of Section 13 of the Trademark Act, 15 U.S.C. § 1063, by registration of a mark for particular goods and services, if the applicant already owns an existing, unchallenged registration for the same or a substantially identical mark for the same or substantially identical goods and services. *Id.* (no injury from registration of BLUE MAGIC for pressing oil when applicant owned prior registration for BLUE MAGIC for hair dressing; record showed the goods offered under the marks were "one and the same"). However, where the goods or services in the application include others that are not present in the existing registration, the *Morehouse* defense has been held to be unavailable as to any goods or services. *See, e.g., Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 1986 WL 83320, at *4 (TTAB 1986) (*Morehouse* defense inapplicable where prior registration was for "rifle scopes" and application was for "telescopic sights, rifle scopes, handgun scopes, binoculars and spotting scopes").

⁶ 4 TTABVUE. Applicant's Trial Brief is located at 36 TTABVUE.

The services identified in Applicant's prior registration for LIP LAB are:

Retail store services featuring cosmetics and cosmetic lip products; retail store services featuring custom blended lipsticks, in Class 35; and

Custom lipstick blending services for personal use; custom cosmetic blending services for personal use, in Class 40.⁷

The goods identified in the LIP LAB application are:

Cosmetics; make-up; lip gloss; lip liner; lipstick; beauty masks, namely, lip masks; lip crayons; lip pencils; lip tints; lip primers; lip cream; lip scrubs; pre-moistened cosmetic wipes, namely, lip wipes; lip oil; blush; mascara; eye liner; eye shadow; face powder; pressed face powder; foundation make-up, in Class 3.

Since the involved application identifies goods that are not substantially identical to the services of the prior registration, the *Morehouse* defense is inapplicable here.

Applicant also asserts the affirmative defense of laches. A prima facie defense of laches requires a showing of (1) unreasonable delay in asserting one's rights against another, and (2) material prejudice to the latter as a result of the delay. *Bridgestone/Firestone Rsch., Inc. v. Auto. Club de L'Ouest de la France*, 245 F.3d 1359, 1361 (Fed. Cir. 2001). Applicant argues that the laches clock begins from when Applicant began to use the common law mark "Lip Lab By Bite" for its boutiques. (28 TTABVUE 3). But "[i]n an opposition or cancellation proceeding the objection is to the rights which flow from registration of the mark." *Nat'l Cable Tel. Ass'n, Inc. v. Am. Cinema Eds., Inc.*, 937 F.2d 1572, 1581 (Fed. Cir. 1991) (citations omitted); *see also Lincoln Logs Ltd. v. Lincoln Pre-cut Log Homes, Inc.*, 971 F.2d 732, 734 (Fed. Cir. 1992) (laches is "tied to a party's registration of a mark, **not** to a party's use of the mark") (italics in original). Given this

⁷ Reg. No. 5689788 was registered on March 5, 2019, based on a date of first use and first use in commerce of May 18, 2013. A Sections 8 and 15 combined declaration, 15 U.S.C. §§ 1058 and 1065, has been accepted and acknowledged. *See* 28 TTABVUE 7, 63-65.

temporal constraint, laches usually does not apply in opposition proceedings; however, a laches defense “may be based upon [the] opposer’s failure to object to an applicant’s earlier registration of the same mark for substantially the same goods [or services].” *Aquion Partners L.P. v. Envirogard Prods. Ltd.*, 1997 WL 424968, at *3 (TTAB 1997) (citing *Lincoln Logs*, 971 F.2d at 734 (citing *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 1977 WL 22601, at *7-8 (TTAB 1977)).

Obviously, the goods of the involved application and the services of the prior registration are not identical. Neither are they substantially the same. Consequently, Applicant’s laches defense fails. *Cf. Advance Mag. Publishers, Inc. v. Fashion Elecs., Inc.*, 2023 WL 4261426, at *5-6 (TTAB 2023) (some goods identified in applicant’s cancelled standard character registration for EVOGUE found substantially similar to, or encompassed by, goods identified in its application for standard character EVOGUE mark); *Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 2020 WL 4673282, at *11 (TTAB 2020) (defendant’s prior standard character mark registration BROOKLYN BREW SHOP for a “beer-making kit” found substantially similar to its applied-for stylized mark BROOKLYN BREW SHOP for various goods including a “beer making kit”), *aff’d in part, vacated in part on other grounds and remanded*, 17 F.4th 129 (Fed. Cir. 2021).

II. Focus on ’335 Registration and Brief Conclusion

We focus our likelihood of confusion analysis on the ’335 Registration for the standard character mark, THE LIP BAR (“Opposer’s Mark”), because this mark is closest to Applicant’s Mark, LIP LAB. If we find a likelihood of confusion between Applicant’s Mark and Opposer’s Mark, we need not find it as to Opposer’s other pleaded registration. Conversely, if we do not find a likelihood of confusion between Applicant’s Mark and the

Opposer's Mark, we would not find it as to Opposer's other pleaded registration. *See New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 WL 2853282, at *11 (TTAB 2020) (confining Section 2(d) analysis to most similar pleaded mark); *In re Max Cap. Grp. Ltd.*, 2010 WL 22358, at *2 (TTAB 2010) (same).

To prevail on its Trademark Act Section 2(d) claim, Opposer must prove, by a preponderance of the evidence, its entitlement to a statutory cause of action, priority, and likelihood of confusion. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945-46, 951 (Fed. Cir. 2000).

The case is fully briefed. Having considered the evidentiary record, Opposer's arguments, and applicable authorities, we dismiss the opposition for the reasons herein.

III. Entitlement to a Statutory Cause of Action⁸

Entitlement to a statutory cause of action is a requirement in every inter partes case. *Austl. Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 1373-74 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014)). A party in the position of plaintiff may oppose registration of a mark when doing so is within its zone of interests and it has a reasonable belief in damage that is proximately caused by registration of the mark. *Corcamore*, 978 F.3d at 1303 (holding that the test in *Lexmark* is met by demonstrating:

⁸ Opposer makes an argument about "standing" in its brief. *See* 37 TTABVUE 26-27. Our decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063 and 1064, under the rubric of "standing." We now refer to this inquiry as "entitlement to a statutory cause of action." Despite the change in nomenclature, our prior decisions and those of the U.S. Court of Appeals for the Federal Circuit interpreting "standing" under Sections 13 and 14 of the Trademark Act remain applicable. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1303 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021); *Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 WL 6938378, at *1 (TTAB 2020).

(1) a real interest in opposing or cancelling a registration of a mark, which satisfies the zone-of-interests requirement; and (2) a reasonable belief in damage proximately caused by registration of the mark).

Here, Opposer's ownership of pleaded registrations for The Lip Bar marks and its submission, during trial, of printouts showing the current status and title of the pleaded registrations⁹ support Opposer's plausible likelihood of confusion claim against the involved application, demonstrate Opposer's real interest in this proceeding, and a reasonable basis for its belief of damage. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1377 (Fed. Cir. 2012). Opposer has thus established its statutory entitlement to bring this opposition proceeding.

IV. Evidentiary Issues

Before focusing on the merits of the opposition, we address several evidentiary issues. At Appendix A of its brief, (36 TTABVUE 50-68), Applicant objects to the issues outlined below.

A. Opposer's submission of its own discovery via its notice of reliance

Under Trademark Rule 2.120(k)(1), 37 C.F.R. § 2.120(k)(1), "[t]he discovery deposition of a party or of anyone who at the time of taking the deposition was an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, may be offered in evidence by an adverse party." Under Trademark Rule 2.120(k)(5), 37 C.F.R. § 2.120(k)(5), "[w]ritten disclosures, an answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the record only by the receiving or inquiring party,"

⁹ USPTO Trademark Status & Document Retrieval ("TSDR") printouts located at 16 TTABVUE.

unless fairness dictates that the submission(s) must be clarified to avoid the submissions of the receiving or inquiring party from being misleading. *Id.*

In its trial brief, Applicant objects for the first time to Opposer's submission, via notice of reliance, of its own Amended Responses to Applicant's First Request for Admissions, (located at 14 TTABVUE 7-12; 15 TTABVUE 7-12), Opposer's submission of its own Amended Responses Applicant's First Set of Interrogatories, (located at 14 TTABVUE 14-22; 15 TTABVUE 14-22), and to Opposer's submission of the Fed. R. Civ. P. 30(b)(6) deposition testimony of Ms. Melissa Butler, Opposer's CEO and Founder. (located at 20 & 21 TTABVUE). In response, Opposer contends generally that Applicant's objections are untimely, procedural, and waived. (*See* 38 TTABVUE 7-8).

We sustain Applicant's objections, inasmuch as they are not procedural. *See Orange Bang, Inc. v. Olé Mexican Foods, Inc.*, 2015 WL 5675641, at *5 n.16 (TTAB 2015) ("the responding party may not make its own discovery responses of record except when necessary to make not misleading the discovery responses submitted by the inquiring party"). Opposer's submissions do not fall under the Trademark Rule 2.120(k)(5) exception for rebutting misleading submissions either. *Id.* We also sustain Applicant's objection to Opposer's submission of Ms. Butler's discovery deposition testimony. Trademark Rule 2.120(k)(1); *see First Int'l Servs. Corp. v. Chuckles Inc.*, 1988 WL 252292, at *2 n.5 (TTAB 1988).

However, Applicant submitted, via its notice of reliance, parts of Ms. Butler's deposition testimony for the record, as well as some of Opposer's discovery answers and responses. (*See* 30 TTABVUE 25-37, 39-187). Therefore, both parties may rely on, for any purpose, the portions of Opposer's discovery that Applicant submitted for the record.

Trademark Rule 2.120(k)(7), 37 C.F.R. § 2.120(k)(7) (“When a written disclosure, a discovery deposition, or a part thereof, or an answer to an interrogatory, or an admission, or an authenticated produced document has been made of record by one party in accordance with the provisions of paragraph (k)(3) of this section, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.”). But we strike from the record the portions of Opposer’s discovery answers and responses submitted by Opposer only, and the portions of Ms. Butler’s 30(b)(6) deposition testimony submitted by Opposer only.

B. Opposer’s submission of the Testimony Declaration of Ms. Antanika Robinson

Applicant contends that the Testimony Declaration of Antanika Robinson (and the emails attached thereto as Exhibit A) should be stricken now because Ms. Robinson was not previously identified in Opposer’s initial disclosures or any supplemental disclosure. *See* Fed. R. Civ. P. 26(a) and (e). (36 TTABVUE 54). Applicant cites Fed. R. Civ. P. 37(c)(1), which states, “[i]f a party fails to provide information or identify a witness as required by Rule 26(a) or (e), the party is not allowed to use that information or witness ... at a trial, unless the failure was substantially justified or is harmless.” Because Applicant “did not learn of Opposer’s intention to rely on Ms. Robinson’s testimony on likelihood of confusion until Opposer served its pretrial disclosures,” (36 TTABVUE 54), Applicant argues it was “deprived of any opportunity to take discovery from Ms. Robinson,” (36 TTABVUE 58), and thus, the Robinson Declaration is “an unfair surprise that cannot be cured” under the five-factor test¹⁰ in *Great Seats, Inc. v. Great Seats, Ltd.*, 2011 WL 4871871 (TTAB 2011).

¹⁰ The five-factors of the *Great Seats* test are: (1) the surprise to the party against whom the evidence would be offered; (2) the ability of that party to cure the surprise; (3) the extent to which

(36 TTABVUE 56-57). Applicant further argues that “[p]ermitt[ing] Opposer to enter this unanticipated testimony, without Applicant having any means of probing it or challenging it without seeking to reopen discovery, disrupts the order of this trial.” (36 TTABVUE 58). In turn, Opposer argues generally that Applicant’s objection is procedural, untimely, and thus, waived. (38 TTABVUE 8).

While it is true that “[i]nitial disclosures, discovery responses and pretrial disclosures should be viewed as a continuum of *inter partes* communication designed to avoid unfair surprise and to facilitate fair adjudication of the case on the merits,” *Sheetz of Del., Inc. v. Doctor’s Assocs. Inc.*, 2013 WL 5315963, at *2 (TTAB 2013) (citation omitted), procedural objections to testimony and evidence, such as the objections Applicant makes here, must be raised promptly to allow an opportunity to cure. *See Empresa Cubana del Tabaco d.b.a. Cubatabaco v. Gen. Cigar Co.*, 2022 WL 17844056, at *4 n.21 (TTAB 2022) (citing *Moke Am. LLC v. Moke USA LLC*, 2020 WL 1937891, at *7 (TTAB 2020)), *rev’d on other grounds sub nom. Moke Am. LLC v. Am. Custom Golf Cars, Inc.*, 671 F.Supp.3d 670 (E.D. Va. 2023)); *see generally* TBMP §§ 707.02 and 707.03 and cases cited therein. Under Trademark Rule 2.121(e), 37 C.F.R. § 2.121(e), “[w]hen testimony has been presented by affidavit or declaration, but was not covered by an earlier pretrial disclosure, the remedy for any adverse party is the **prompt** filing of a motion to strike” (emphasis added). *See also* Trademark Rule 2.121(e)(3), 37 C.F.R. § 2.123(e)(3) (“If pretrial disclosures or the notice of examination of witnesses served pursuant to paragraph (c) of this section are improper or inadequate with respect to any witness, an adverse party may cross-examine

allowing the testimony would disrupt the trial; (4) the importance of the evidence; and (5) the non-disclosing party’s explanation for its failure to disclose the evidence. 2011 WL 4871871, at *4 (citations omitted).

that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances.”).

Discovery closed in this case on September 4, 2023. Opposer’s pretrial disclosures were served on October 19, 2023. (30 TTABVUE 21-24). By October 19, Applicant was aware that Ms. Robinson had been disclosed as an individual likely to provide testimony in support of Opposer. Opposer then served the Robinson Declaration on December 4, 2023.¹¹ (18 TTABVUE 12). By December 4, Applicant was aware that Opposer proffered Ms. Robinson’s declaration — inappropriately — as part of its case-in-chief. The manner in which a procedural objection is raised may vary depending on the circumstances, but here, unlike the movant in *Great Seats*, Applicant did not make **any** objection to Opposer’s submission of the Robinson Declaration before trial. *See Moke Am.*, 2020 WL 1937891, at *7 (discussing ways applicant can object and put Board on notice of the objection). Instead, Applicant first objected to the Robinson Declaration in its June 17, 2024 Trial Brief, (36 TTABVUE 54-59), more than six months after the declaration was served. The supposed surprise to Applicant could have been cured had Applicant timely brought it to the Board’s attention. *See Société des Produits Nestle S.A. v. Taboada*, 2020 WL 4530518, at *9 (TTAB 2020) (objection that evidence was not adequately disclosed in pretrial disclosures overruled as untimely and waived when first raised in trial brief; objection

¹¹ The declaration is dated “12-3-23.” Opposer’s Trial Period ended on December 3, 2023. *See* 9 TTABVUE.

was curable and should have been made via motion to strike promptly after testimony declaration and exhibits were filed); *see generally* TBMP §§ 707.03(b)(1) and (b)(3).

Applicant also objects to the substance of the entire Robinson Declaration as hearsay, arguing that the declaration does not “contain specific accounts of Ms. Robinson’s own confusion experience, but rather generalized statements about unnamed third-party patrons’ alleged confusion. ... None of the statements she makes attest to her own actual confusion.” (36 TTABVUE 58-59). Applicant further argues that the emails attached to the declaration also “fail[] to establish Ms. Robinson’s own confusion. ... This is hearsay, and hearsay upon hearsay.” (36 TTABVUE 59).

“The Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence, including any inherent limitations,” keeping in mind “the various objections raised by the parties” in determining the probative value of objected-to testimony and evidence. *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 2017 WL 542344, at *2 (TTAB 2017); *see also Peterson v. Awshucks SC, LLC*, 2020 WL 7888976, at *4 (TTAB 2020); *U.S. Playing Card Co. v. Harbro, LLC*, 2006 WL 3704640, at *4 (TTAB 2006) (“[B]ecause an opposition is akin to a bench trial, the Board is capable of assessing the proper evidentiary weight to be accorded the testimony and evidence, taking into account the imperfections surrounding the admissibility of such testimony and evidence.”). “[T]he Board generally does not strike testimony taken in accordance with the applicable rules on the basis of substantive objections; rather, the Board considers such objections when evaluating the probative value of the testimony at final hearing.” *Bd. of Regents v. S. Ill. Miners, LLC*, 2014 WL 1246734, at *13 n.19 (TTAB 2014) (citations omitted). However, with respect to any of Ms. Robinson’s opinions which are

tantamount to legal conclusions, we disregard her testimony. *See, e.g., Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 2013 WL 5407315, at *5 (TTAB 2013) (“we have disregarded any opinion testimony regarding the ultimate disposition of the claims asserted herein”).

We overrule any remaining objections regarding the probative value of Ms. Robinson’s testimony, but if necessary, we will weigh the strength or weakness of them, including any inherent limitations therein.

C. Opposer’s submission of printed publications, Internet materials, and social media posts for the truth of the matters asserted

We now turn to Applicant’s objections that Opposer’s printed publications and Internet materials are hearsay. (36 TTABVUE 64-68). While Applicant is correct that the printed publications, Internet materials, and social media posts may not be considered for the truth of the matters asserted therein because they are not accompanied by testimony, these types of materials are admissible for what they show on their face. *Safer Inc. v. OMS Inv. Inc.*, 2010 WL 985355, at *6 n.14 and *8-9 (TTAB 2010); *see also Harry Winston, Inc. & Harry Winston S.A. v. Bruce Winston Corp.*, 2014 WL 3686875, at *7 (TTAB 2014). To the extent that Opposer asserts arguments that rely on these materials for the truth of the matter asserted therein, we will disregard those arguments.

D. Opposer’s submission of the Rebuttal Testimony Declaration of Melissa Butler

Next, we turn to Applicant’s objection that the Rebuttal Testimony Declaration of Melissa Butler does not constitute proper rebuttal evidence. Specifically, Applicant contends that Ms. Butler’s rebuttal declaration should have been submitted as part of Opposer’s case-in-chief, inasmuch as the declaration discusses the founding and

background of The Lip Bar marks and brand; Opposer's first use, priority, and fame; the similarity of the parties' marks, relatedness of their goods, and similarity of the trade channels; and alleged evidence of actual confusion. (36 TTABVUE 60-63). Opposer argues generally that Applicant's objection is procedural, untimely, and thus, waived. (See 38 TTABVUE 7-8). However, an objection to improper rebuttal testimony is not a procedural objection. *Moke Am.*, 2020 WL 1937891, at *6.

We agree that Ms. Butler's declaration testimony constitutes improper rebuttal. Her declaration testimony goes to the likelihood of confusion between the marks at issue, which is part of Opposer's case-in-chief. "Applicant is entitled to an opportunity to rebut, during its testimony period, any testimony and evidence proffered in support of the allegations in the notice of opposition. This opportunity is foreclosed if opposer withholds the evidence until its rebuttal testimony period, ***which is intended to be limited to denials, refutations or explanations of applicant's testimony and evidence.***" *Automedx, Inc. v. Artivent Corp.*, 2010 WL 3441114, at *2 (TTAB 2010) (italics and emphasis in original) (evidence supporting a party's case-in-chief is not rebuttal evidence) (citing *Gen. Elec. Co. v. Graham Magnetics Inc.*, 1977 WL 22676, at *1 n.5 (TTAB 1977)). See also *W. Leather Goods Co. v. Blue Bell, Inc.*, 1973 WL 19944, at *1 (TTAB 1973) (it is improper to submit during rebuttal evidence "which might appropriately have been introduced in the [party's] case-in-chief"); see generally TBMP § 707.04 ("objections to a notice of reliance, or to testimony, on substantive grounds, such as, that the proffered evidence constitutes hearsay or improper rebuttal ... generally are not waived for failure to raise them promptly, unless the ground for objection is one which could have been cured if raised promptly").

In addition, Ms. Butler's rebuttal testimony declaration was executed and served on March 18, 2024, one day **after** Opposer's rebuttal period ended on March 17, 2024. (9 TTABVUE). Accordingly, Applicant's objection is sustained and Ms. Butler's rebuttal testimony declaration has not been considered.

E. Overdesignation of evidence as “confidential”

Finally, we note that Opposer has overdesignated some evidence as “confidential.” (See generally 17 TTABVUE, 19 TTABVUE). For example, some of the printed publications and website content in Opposer's Notice of Reliance at 17 TTABVUE are designated as “confidential,” (see, e.g., 17 TTABVUE 9-22, 29-31, 42-45, 51-59, 68-69), but Opposer clearly states in the relevant notice of reliance that the publications and web publications are available to the general public and are in general circulation. “Board proceedings are designed to be publicly available and the improper designation of materials as confidential thwarts that intention. It is more difficult to make findings of fact, apply the facts to the law, and write decisions that make sense when the facts may not be discussed. The Board needs to be able to discuss the evidence of record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board's decisions.” *Edwards Lifesciences v. VigiLanz Corp.*, 2010 WL 1514315, at *2 (TTAB 2010). Because of this overdesignation, we will not be bound by “confidential” designations by either party in rendering our decision. We will treat as confidential only testimony and evidence that is truly confidential, commercially sensitive, or not publicly available.

V. The Evidentiary Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant's involved application. Other evidence of record, subject to the evidentiary rulings in Part IV above, is listed below.

A. Opposer's Evidence

1. Opposer's Notice of Reliance on Opposer's Trademark Registrations Under 37 C.R.F. [sic] & [sic] § 2.122(d)(2) (11 TTABVUE)
2. Opposer's Notice of Reliance on Official Records Under 37 C.F.R. § 2.122(e) and U.S. Trademark Applications Under 37 C.F.R. § 2.122(b) (12 TTABVUE)
3. Opposer's Notice of Reliance on Applicant's Pleadings and Disclosures Under 37 C.R.F. [sic] & [sic] § 2.120(k)(3) (13 TTABVUE)
4. Opposer's Notice of Reliance on Opposer's Pleadings and Disclosures Under 37 C.R.F. [sic] & [sic] § 2.120(k)(3) (Opposer's Amended Responses to Applicant's First Requests for Admissions) (14 TTABVUE—marked confidential; 15 TTABVUE)
5. Opposer's Notice of Reliance on Opposer's Trademark Registrations Under 37 C.R.F. [sic] & [sic] § 2.122(d)(2) (16 TTABVUE)
6. Opposer's Notice of Reliance on Printed Publications/Internet Materials Under 37 C.F.R. § 2.122(e) (17 TTABVUE)
7. Testimony Declaration [of] Antanika Robinson ("Robinson Declaration"), Store Manager of Opposer's flagship store in Detroit, Michigan (18 TTABVUE)
8. Opposer's Notice of Reliance on Printed Publications (Internet Materials) Under 37 C.F.R. § 2.122(e) (19 TTABVUE)
9. Deposition Testimony of Diana Peinado (22 TTABVUE; 23 TTABVUE – marked confidential; 26 TTABVUE --corrected transcript; 27 TTABVUE – corrected transcript marked confidential)
10. Opposer's Notice of Reliance on Discovery Deposition Testimony (reliance on the discovery Deposition of Melissa Butler and the discovery Deposition of Diana Peinado) (24 TTABVUE).

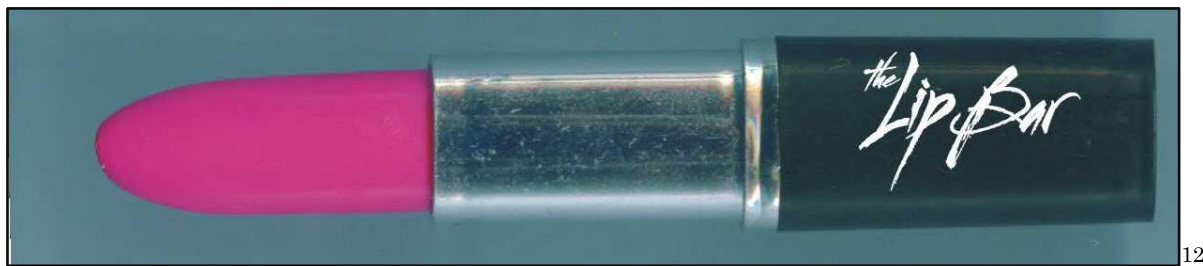
B. Applicant's Evidence

1. Testimonial Declaration of Diana Peinado, the General Manager of Lip Lab Boutiques (28 TTABVUE; 29 TTABVUE –marked confidential)
2. Applicant's Notice of Reliance (with Exhibits 1-34) (30 TTABVUE; 31 TTABVUE – marked confidential)

VI. The Parties and Their Marks

A. Opposer

Opposer The Lip Bar, Inc. is a company with its business address in Detroit, Michigan. (30 TTABVUE 41, 71). Melissa Butler is Opposer's CEO and Founder. (30 TTABVUE 42).



Ms. Butler began to use THE LIP BAR mark to offer lipstick as early as September 2011. (30 TTABVUE 61). In the early years of the business, Ms. Butler, as “lead mixologist,” made small batches of custom and prepackaged lipsticks in her kitchen, which Opposer offered for sale under THE LIP BAR mark. (30 TTABVUE 48-50). In 2014, Ms. Butler appeared on the television program “Shark Tank,” during which she pitched custom lipsticks offered under THE LIP BAR mark. (*Id.*). Today, Opposer offers pre-packaged lip products featuring The Lip Bar marks throughout the United States at Wal-Mart, Target, Meijer, and their respective websites; at Opposer's retail store in Detroit; and at Opposer's website. (30 TTABVUE 27).

¹² Photo of Opposer's lipstick displaying The Lip Bar stylized mark. 16 TTABVUE 58.



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B. Applicant

Applicant Suzanne Lang Fragrance Inc. is listed in USPTO records as a corporation organized under the laws of Canada with offices in Toronto, Ontario.¹⁴

In 2001, Applicant founded Bite Beauty, through which it sold pre-packaged cosmetic products at its website, bitebeauty.com, and at third-party retailers. (28 TTABVUE 4). In 2012, Applicant opened its first “Lip Lab by Bite” brick and mortar boutique in Soho, New York City, where customers could create custom lipsticks in a “laboratory-like” setting. (*Id.*). It was at

¹³ Some of Opposer’s Goods displaying the standard character mark. 17 TTABVUE 81.

¹⁴ See Application Serial No. 90768628 filed Jun. 11, 2021 at Trademark Status & Document Retrieval (TSDR) 1.

that time Applicant began using the marks LIP LAB and “Lip Lab by Bite” for its services. (28 TTABVUE 4-5).

Applicant was acquired by Kendo in 2014. (28 TTABVUE 5). Applicant’s “Lip Lab by Bite” boutiques continued to operate under the new ownership, and “Bite-branded” products were offered at Sephora and bitebeauty.com as well. (*Id.*).

By 2019, Applicant restructured its business, separating the operations and branding of “Bite Beauty” and LIP LAB. (28 TTABVUE 5). In 2021, Applicant began to redesign its product packaging and containers to just LIP LAB, and by January 1, 2022, Applicant had removed “by Bite” from its product packaging, marketing, and website. (*Id.*). Applicant also launched, in January 2022, its liplab.com website and created its social media accounts, such as @liplab on Instagram, where it has over 800,000 followers. (28 TTABVUE 5, 7).

Today, Applicant continues to operate ten LIP LAB brick and mortar boutiques in the United States.¹⁵ (28 TTABVUE 6). A photograph of the interior of one of Applicant’s LIP LAB boutiques is displayed below. (28 TTABVUE 4).

¹⁵ One more LIP LAB boutique was slated to open in the United States in February 2024. 29 TTABVUE 6.



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After booking an appointment at Applicant’s website, customers can create, at Applicant’s LIP LAB boutique, “customized lip products, including lipstick, lip balm, and lip gloss, with the help of Lip Lab’s color experts in a ‘laboratory’-like setting. Customization options include color, flavor, fragrance, finish texture, and packaging.” (28 TTABVUE 3). Displayed below is a “Creator Guide” provided to customers when they visit Applicant’s LIP LAB boutiques. (*Id.*).

¹⁶ 28 TTABVUE 27

MADE BY _____

SHADE O1: _____ SHADE O2: _____


FINISH: _____ FINISH: _____


FLAVOR: _____ FLAVOR: _____

COMPONENT COLOR: _____ COMPONENT COLOR: _____

FONT: _____ FONT: _____

LIP.LAB



Color Experts only: RE-ORDER YOUR SHADE 

FORMULA: _____ FORMULA: _____

LOCATION: _____ DATE: _____

COLOR EXPERT: _____

MADE BY _____

[@liplab](#) [@liplabboutique](#)


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PRICING

**pricing is per person*

| | |
|--|-------------|
| CUSTOM LIPSTICK | \$65 |
| CUSTOM HIGH-SHINE GLOSS | \$55 |
| CUSTOM BUTTER BALM | \$45 |
| EXTRA LIPPY BUNDLE <i>start with a custom lipstick</i> | |
| + LIPSTICK | \$40 |
| + HIGH-SHINE GLOSS | \$30 |
| + BUTTER BALM | \$25 |
| EXTRA GLOSSY BUNDLE <i>start with a custom high-shine gloss</i> | |
| + HIGH-SHINE GLOSS | \$30 |
| + BUTTER BALM | \$25 |
| EXTRA BALMY BUNDLE <i>start with a custom butter balm</i> | |
| + BUTTER BALM | \$25 |
| LIP PREP PRICING | |
| AGAVE LIP THERAPY | \$25 |
| AGAVE LIP SCRUB | \$25 |
| LINE & DEFINE LIP PRIMER | \$25 |
| PREP + MIX BUNDLES | |
| ANY 2 LIP PREP PRODUCTS <i>with color mixing service</i> | \$40 |
| ANY 3 LIP PREP PRODUCTS <i>with color mixing service</i> | \$60 |

GET INSPIRED



SHADE

CHOOSE YOUR FINISH

| | |
|----------------|---|
| MATTE LIPSTICK | <i>velvety • full coverage • no shine</i> |
| SATIN LIPSTICK | <i>smooth • full coverage • soft shine</i> |
| SHEER LIPSTICK | <i>translucent • light coverage • buildable</i> |
| BALM | <i>nourishing • lightweight • hint of tint</i> |
| GLOSS | <i>juicy • sheer coverage • super shine</i> |

CHOOSE YOUR FLAVOR

| | |
|-------------|-----------------------------|
| MANGO | <i>bright • fruity</i> |
| VANILLA | <i>warm • delicious</i> |
| PEPPERMINT | <i>fresh • invigorating</i> |
| POMEGRANATE | <i>rich • juicy</i> |
| ROSE | <i>aromatic • romantic</i> |

NAME IT *and* ENGRAVE IT

BERTHOLD DIDOT *sparose*

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Returning customers can reorder their customized lip products through the liplab.com website. (28 TTABVUE 4).

VII. Priority

Because Opposer has established ownership and validity of its pleaded registrations and Applicant did not file a counterclaim to cancel the pleaded registrations, priority is not at issue with respect to Opposer's registered marks and the goods identified therein. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 2016 WL 3915987, at *4 (TTAB 2016) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1402 (CCPA 1974)).

VIII. Likelihood of Confusion

Section 2(d) of the Trademark Act provides that a mark must be refused registration if it “[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 determine whether there is a likelihood of confusion between the marks under Section 2(d), we analyze the evidence and arguments under the *DuPont* factors. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361-62 (CCPA 1973) (“*DuPont*”). We consider each *DuPont* factor for which there is evidence and argument, *In re Guild Mortg. Co.*, 912 F.3d 1376, 1378-81 (Fed. Cir. 2019), but “[n]ot all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 998 (Fed. Cir. 2020); *see also In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993) (“[T]he

various evidentiary factors may play more or less weighty roles in any particular determination.”). “[E]ach case must be determined on the basis of its own particular facts.” *Finn v. Cooper’s Inc.*, 292 F.2d 555, 557 (CCPA 1961) (citation omitted).

Two key considerations are the similarity of the marks and the relatedness of the goods. *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164 (Fed. Cir. 2002) (citations omitted). The proper “focus is on the recollection of the average purchaser, who normally retains a general, rather than a specific impression of trademarks.” *L’Oreal S.A. v. Marcon*, 2012 WL 1267956, at *5 (TTAB 2012) (citation omitted); *see also Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 1007 (CCPA 1971) (The court is required to consider, “among other things, the fallibility of memory over a period of time, not merely whether one can distinguish the marks at a given moment.”).

A. The Similarity or Dissimilarity and Nature of the Goods

First, we focus on the second *DuPont* factor regarding the similarity (or relatedness) of the goods, 476 F.2d at 1361, and we look to the identifications in the application and the registration. *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1323 (Fed. Cir. 2014).

Applicant’s Goods and Opposer’s Goods both identify, among other goods, “cosmetics,”¹⁹ “make-up,” “lip gloss,” “lip liner,” “lipstick,” “lip cream,” “lip primer(s),” and

¹⁹ The Federal Food, Drug, and Cosmetic Act (FD&C Act) defines cosmetics as ‘articles intended to be rubbed, poured, sprinkled, or sprayed on, introduced into, or otherwise applied to the human body...for cleansing, beautifying, promoting attractiveness, or altering the appearance’ [FD&C Act, Sec. 201(i)].” Among the products included in this definition are lipstick, makeup, as well as “any substance intended for use as a component of a cosmetic product.” (<https://www.fda.gov/cosmetics/cosmetics-laws-regulations/it-cosmetic-drug-or-both-or-it-soap#Definecosmetic>) (last visited Nov. 7, 2024). The Board may take judicial notice of a statutory definition provided on a publicly available federal government website of the Food and Drug Administration. *See* FED. R. EVID. 201(b)(2) (“The court may judicially notice a fact that is not

“lip pencils.” Opposer’s “cosmetic pencils,” “cosmetic preparations,” “cosmetics and make-up,” and “cosmetics” overlap with all of Applicant’s remaining identified goods.

Such identity weighs strongly in favor of finding a likelihood of confusion. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1336 (CCPA 1981) (a finding of likely confusion must be made with respect to at least one item in each opposed class of the application to establish likely confusion as to that class of goods).

B. The Channels of Trade; Purchasing Conditions and Standard of Care

Next, we consider the third *DuPont* factor, “the similarity or dissimilarity of established, likely-to-continue trade channels,” 476 F.2d at 1361, and the fourth *DuPont* factor, “[t]he conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *Id.*

Because the parties’ identifications of goods are identical in part and overlapping, we presume that their goods travel through the same channels of trade to the same classes of purchasers. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1372 (Fed. Cir. 2018) (“With respect to similarity of the established trade channels through which the goods reach customers, the TTAB properly followed our case law and ‘presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods’”); *Am. Lebanese Syrian Assoc. Charities Inc. v. Child Health Rsch. Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011) (where the services were legally

subject to reasonable dispute because it ... can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned.”); *see also In re tapio GmbH*, 2020 WL 6938377, at *14 n.46 (TTAB 2020) (Board took judicial notice of 2010 U.S. Census records for the top 1,000 surnames); *see also U.S. v. Garcia*, 855 F.3d 615, 621-22 (4th Cir. 2017) (judicial notice of facts on U.S. Citizenship and Immigration Service website taken because it is a governmental source whose accuracy cannot be questioned).

identical, “the marketing channels of trade and targeted classes of consumers and donors are the same”).

Applicant nonetheless argues that “the parties’ trade channels never overlap and the difference in their nature is stark.” (36 TTABVUE 44). Applicant’s argument is unavailing because there are no restrictions in the parties’ identifications of goods and, as mentioned, we must presume that the in-part identical goods travel in the same ordinary channels of trade and that they are available to all usual purchasers for the goods. *Cai*, 901 F.3d at 1372 (citing *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (“[I]t is well established that, absent restrictions in the application and registration, [identical] goods and services are presumed to travel in the same channels of trade to the same class of purchasers.” (cleaned up))).

With respect to the fourth *DuPont* factor, Applicant characterizes Applicant’s customers as sophisticated. (36 TTABVUE 43). Applicant also argues that its requirement of scheduling appointments and the differences in product pricing – its custom lipstick costs \$65.00 per customer, compared to Opposer’s lipsticks which cost \$13.94 at Walmart – makes confusion unlikely. (36 TTABVUE 43; *see also* 19 TTABVUE 32). Opposer, too, argues that the “target consumer for the parties’ respective goods is identical,” (37 TTABVUE 26), and includes “sophisticated consumer [sic] seeking vegan and cruelty free cosmetics and makeup.” (*Id.*).

Again, since the identifications in Opposer’s registrations and the involved application are unrestricted as to price or how the goods are purchased, we must presume that the parties’ goods include ones that are inexpensive and purchased in all of the usual retail outlets for the goods. *L’Oreal*, 2012 WL 1267956, at *9. The record demonstrates that

lipstick products, like those sold by Applicant and Opposer, are offered for retail sale ranging in price from \$6.00 to \$56.00.²⁰ Although Applicant's custom lipstick may cost over \$51.00 more than Opposer's lipsticks at Walmart, and customers must schedule appointments in advance to make custom lipstick at Applicant's LIP LAB boutiques, this is not reflected in the identification. We must consider sales of the lipstick products at the lowest price point.

Overall, the third and fourth *DuPont* factors weigh in favor of finding of a likelihood of confusion.

C. Strength of Opposer's Mark

Before we compare the marks themselves, we consider the strength, as well as any weakness, of Opposer's THE LIP BAR mark as used in connection with Opposer's Goods. We do so because a determination of the strength or weakness of the mark helps inform us as to its scope of protection. *See In re Morinaga Nyugyo K.K.*, 2016 WL 5219811, at *6 (TTAB 2016) (“[T]he strength of the cited mark is — as always — relevant to assessing the likelihood of confusion under the du Pont framework.”). When evaluating the strength of a mark, we look at the mark's inherent, or conceptual, strength based on the nature of

²⁰ 17 TTABVUE 70-79 (*People Magazine*): The Lip Bar Vegan Matte Lipstick, \$12.99; MAC Cosmetics Ruby Woo Lipstick, \$19; Bare Minerals Mineralist Hydra-Soothing Lipstick, \$20; Kosas Weightless Lipstick, \$28; Pat McGrath's LiquiLust Matte Lipstick, \$30; Armani Beauty Lip Maestro Lip Lipstick, \$39; Chanel Rouge Allure Luminous Intense Lip Color, \$42; Tatcha Kyoto Red Silk Lipstick, \$55. 17 TTABVUE 119-29 (*Wall Street Journal*): The Lip Bar Liquid Matte in Bawse Lady, \$13; Cargo Matte Liquid Lipstick in Red, \$18; MAC Powder Kiss in Lasting Passion, \$21; Pat McGrath Labs Matte Trance Lipstick in Elson, \$28; RMS Beauty Lipstick in RMS Red, \$28; Kosas Weightless Lipstick in Electra, \$28; Westman Atelier Squeaky Clean Liquid Lip Balm in Pipsqueak, \$38; Tom Ford in Cherry Lush, \$56; 17 TTABVUE 155-68 (*Elle.com*): L'Oreal Paris Infallible Le Rouge Lipstick in Ravishing Red, \$6-\$7; The Lip Bar Vegan Lipstick \$13; Rare Beauty by Selena Gomez Lip Souffle Matte Cream Lipstick, \$20-\$36; Charlotte Tilbury Matte Revolution Lipstick in Walk of Shame, \$25-\$35; Dior Addict Lacquer Plump, \$38.

the term itself, and its commercial strength in the marketplace. *See Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1362 (Fed. Cir. 2023) (“There are two prongs of analysis for a mark’s strength under the sixth factor: conceptual strength and commercial strength.”); *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353-54 (Fed. Cir. 2010) (measuring both conceptual and marketplace strength); *Made in Nature, LLC v. Pharmavite LLC*, 2022 WL 2188890, at *12 (TTAB 2022) (“The strength of Opposer’s marks affects the scope of protection to which they are entitled.”).

Evidence of third-party use and registration typically falls under the sixth *DuPont* factor, “the number and nature of similar marks in use on similar goods.” 476 F.2d at 1361. Under the sixth *DuPont* factor, we take into account both conceptual strength, based on the nature of the mark itself, and commercial strength, based on marketplace recognition of the mark. *See In re Chippendales*, 622 F.3d at 1353-54; *see also Spireon*, 71 F.4th at 1362. Whereas the “fifth *DuPont* factor enables Opposer to prove that its pleaded marks are entitled to an expanded scope of protection by adducing evidence of the fame of the prior mark (sales, advertising, length of use), the sixth *DuPont* factor allows Applicant to contract that scope of protection by adducing evidence of the number and nature of similar marks in use on similar goods.” *Made in Nature*, 2022 WL 2188890, at *11 (quoting *DuPont*, 476 F.2d at 1361) (cleaned up).

1. Conceptual Strength

Conceptual strength is a measure of a mark’s distinctiveness and may be placed “in categories of generally increasing distinctiveness[:] ... (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.” *Spireon*, 71 F.4th at 1362 (quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992)). Third-party registrations of record

“may bear on conceptual weakness if a term is commonly registered for similar goods or services.” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 2017 WL 6336243, at *14 (TTAB 2017); *see also In re Mighty Leaf Tea*, 601 F.3d 1342, 1346-47 (Fed. Cir. 2010).

Because Opposer’s Mark issued on the Principal Register without a claim of acquired distinctiveness, the mark is presumed to be inherently distinctive for the goods identified in the registration. 15 U.S.C. § 1057(b); *Tea Bd. of India v. Republic of Tea, Inc.*, 2006 WL 2460188, at *21 (TTAB 2006) (“A mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods.” (citations omitted)).

However, if there is evidence that a mark, or an element of a mark, is commonly adopted by many different registrants, the mark or common element may have some non-source-identifying significance that undermines its conceptual strength as an indicator of a single source. *See Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1374 (Fed. Cir. 2015) (“[E]vidence of third-party registrations is relevant to ‘show the sense in which a mark is used in ordinary parlance,’ . . . that is, some segment that is common to both parties’ marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that segment is relatively weak.’”) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339 (Fed. Cir. 2015)).

Applicant asserts there are “numerous” relevant third-party registrations demonstrating a crowded field of similar marks, supposedly making Opposer’s Mark conceptually weak. In support, Applicant submitted for the record three valid and

subsisting third-party registrations that contain the term “LIP”²¹ and identify lipstick or other relevant goods, but Applicant did not submit any valid and subsisting third-party registrations that contain the term “BAR” for relevant goods.²² We therefore find that Applicant’s third-party registration evidence fails to support Applicant’s assertion that THE LIP BAR is conceptually weak.

In assessing THE LIP BAR mark on its face, it appears to be somewhat suggestive as applied to Opposer’s services. “THE” has no trademark significance because it is a definite article used before the noun “LIP.” *In re Thor Tech, Inc.*, 2009 WL 1098997, at *2 (TTAB 2009) (citations omitted) (“the” is a definite article that when used before a noun denotes a particular person or thing). “LIP,” which is descriptive and disclaimed, is defined as “either of two fleshy folds that surround the mouth in humans and many other vertebrates and are organs of human speech essential to certain articulations.” (Merriam-Webster.com, 30 TTABVUE 350). A “bar” is defined as “a counter at which food or especially alcoholic beverages are served.” (Merriam-Webster.com, 30 TTABVUE 377). And Opposer’s CEO testified that she had “mixology,”²³ which is “the art or skill of

²¹ 30 TTABVUE 192-208: LIP BUTTER, Supp. Reg. No. 2801623, for “lip creams and/or lotions for the lips and body; Namely, lipstick, lip balm, lip gloss, and lip liner” in Class 3; and LIP GLOSS BOSS, Reg. No. 4837726, for “Lip balm; Lip gloss” in Class 3 (“lip gloss” disclaimed). We have also considered a registration under Section 66(a), 15 U.S.C. § 1141a, for LIP HEROES, Reg. No. 5409630, because the record includes evidence of the mark’s use. Reg. No. 2826071, for LIP LUBE, is cancelled, so we have not considered it. However, all of the marks are in commercial use. *See* 30 TTABVUE 244-65.

²² *See* 30 TTABVUE 209-43.

²³MERRIAM-WEBSTERDICTIONARY(2024) (<https://www.merriam-webster.com/dictionary/mixology>) (last accessed Nov. 16, 2024). The Board may take judicial notice of dictionary definitions, including definitions from online dictionaries which exist in printed format or have fixed regular editions. *In re Cordua Rests. LP*, 2014 WL 1390504, at *2 n.4 (TTAB 2014) (citations omitted), *aff’d*, 823 F.3d 594 (Fed. Cir. 2016).

preparing mixed drinks,” in mind when she began making lipstick in her kitchen in Brooklyn, New York. (See 30 TTABVUE 48-49).

2. Commercial Strength

a. The Fame of the Prior Mark – Fifth *DuPont* Factor

The fifth *DuPont* factor, the “fame of the prior mark,” 476 F.2d at 1361, “varies along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1325 (Fed. Cir. 2017) (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1374-75 (Fed. Cir. 2005)) (cleaned up).

“A famous mark is one ‘with extensive public recognition and renown.’” *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002) (quoting *Kenner Parker Toys, Inc. v. Rose Art Indus.*, 963 F.2d 350, 353 (Fed. Cir. 1992)). Accordingly, for likelihood of confusion purposes, fame may be measured indirectly by the volume of sales and advertising expenditures of the goods sold under the mark, as well as by other factors such as length of time of use of the mark, widespread critical assessments, parodies, notice by independent sources of the products identified by the marks, and the general reputation of the goods or services. *Bose*, 293 F.3d at 1371. “Because of the wide latitude of legal protection accorded a famous mark and the dominant role fame plays in the likelihood of confusion analysis, the party asserting fame must clearly prove it.” *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 2014 WL 343269, at *6 (TTAB 2014).

Opposer asserts that THE LIP BAR has achieved fame as a result of its widespread use, recognition, and strength. (37 TTABVUE 18-23). Pictured below are Ms. Butler and Ms. Rochelle Spears, Opposer’s creative director, standing on a street in front of a

billboard referring to their appearance on the popular television program “Shark Tank.” (17 TTABVUE 9-14, 16).



²⁴

Opposer’s Goods and The Lip Bar marks are promoted through Opposer’s Instagram, Twitter (now known as X), Facebook, TikTok, and YouTube accounts, which display thousands of “followers,” “likes,” and subscribers. (See 19 TTABVUE 88, 107, 112, 118, 123, 132-35; see generally 30 TTABVUE 73). Opposer does not provide a specific country

²⁴ 17 TTABVUE 11

breakdown of its Facebook, Instagram, TikTok, and Twitter followers, YouTube subscribers, or its social media “likes,” so we do not know how many of the followers, “likes,” and subscribers are from U.S. consumers. Furthermore, it is highly likely that there is overlap among the Facebook, Instagram, Twitter, and TikTok followers. These shortcomings diminish the probative value of Opposer’s social media evidence. *See Performance Open Wheel Racing, Inc. v. U.S. Auto Club Inc.*, 2019 WL 2404075, at *12 (TTAB 2019).

Opposer and The Lip Bar marks have received unsolicited third-party coverage in publications such as *Allure, Black Enterprise, Forbes, In Style, Ebony, The Detroit News, The Detroit Free Press, CNBC.com, Women’s Wear Daily, People, Essence, Vogue, Marie Claire, Yahoo! Life, The Wall Street Journal, Cosmopolitan, and Elle*. (17 TTABVUE 23-169). Some of the articles feature Opposer’s Goods, Ms. Butler, and an unpaid well-known endorser, such as former First Lady Michelle Obama and the singer Chaka Khan. (*Id.*). Opposer’s Goods have also received unsolicited coverage on nationally syndicated television programs such as *Bethenny, The Real, and The Drew Barrymore Show*. (See 17 TTABVUE 17-22).

Overall, considering the evidence of record pertaining to Opposer’s social media impressions and the unsolicited third-party coverage of Opposer’s Mark and Opposer’s Goods in online publications, blogs, and on television programs, we find that THE LIP BAR has achieved some consumer exposure. But without any evidence of Opposer’s sales and revenue under The Lip Bar marks, we cannot conclude that Opposer’s Mark is commercially strong.

b. Similar Marks on Similar Goods – The Sixth *DuPont* Factor

Applicant contends that a crowded field of similar marks in actual use renders Opposer’s Mark commercially weak. (36 TTABVUE 32-33). This type of evidence pertains to the commercial strength of the mark. “Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Id.* (quoting *Palm Bay*, 396 F.3d at 1373). Evidence of actual third-party use of similar marks can be “powerful on its face” and can “show that customers ... have been educated to distinguish between different ... marks on the basis of minute distinctions,” *Juice Generation*, 794 F.3d at 1338 (citation and internal citation omitted), particularly if such evidence is “extensive.” *Jack Wolfskin*, 797 F.3d at 1373-74 (citing *Juice Generation*, 794 F.3d at 1339). *See also Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1324 (Fed. Cir. 2018) (“The purpose of introducing evidence of third-party use is ‘to show that customers have become so conditioned by a plethora of such similar marks that customers ‘have been educated to distinguish between different [such] marks on the bases of minute distinctions.’”) (quoting *Palm Bay*, 396 F.3d at 1374 (internal citation omitted)).

In support of its argument that Opposer’s Mark is commercially weak, Applicant proffered webpages displaying use of the marks LIP BUTTER, LIP HEROES, LIP LUBE, LIP GLOSS BOSS,²⁵ LIP SMACKER, LIP ESTEEM, and LIP VANITY COSMETICS,²⁶ with either lipstick, lip gloss, lip liner, lip balm, or combinations thereof. Applicant also proffered webpages displaying use of the marks THE MAKEUP BAR, MYX BLEND

²⁵ 30 TTABVUE 246-65 (LIP BUTTER, LIP HEROES, LIP LUBE, and LIP GLOSS BOSS).

²⁶ 30 TTABVUE 320-37 (LIP SMACKER, LIP ESTEEM, and LIP VANITY COSMETICS).

BAR,²⁷ and COLORBAR²⁸ with lipstick and cosmetics generally. This third-party commercial use evidence makes plain the descriptiveness of “LIP” when used for lipstick, lip gloss, lip liner, lip balm, and cosmetics. However, the third-party commercial use evidence does not demonstrate weakness of “BAR” for the same goods.

Considering the record as a whole, we find that Opposer’s Mark, which is registered on the Principal Register without a claim of acquired distinctiveness, is conceptually suggestive.²⁹ Commercially, the strength of Opposer’s Mark is slightly less than normal. Accordingly, we deem THE LIP BAR mark to have slightly less than the normal scope of protection afforded an inherently distinctive mark.

D. The Similarity or Dissimilarity of the Marks

Next, we turn to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression. 476 F.2d at 1361. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 2018 WL 2734893, at *5 (TTAB 2018) (quoting *In re Davia*, 2014 WL 2531200, at *2 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 732 (CCPA 1968). “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

²⁷ 30 TTABVUE 268-92 (THE MAKEUP BAR and MYX BLEND BAR).

²⁸ Use of the COLORBAR mark is located at 30 TTABVUE 340-47. We have not considered Applicant’s evidence of marketplace use from www.kendrascott.com (COLOR BAR for jewelry), hardware.doitbestonline.com (THE COLOR BAR for hardware store paint mixing), and www.thetiebar.com (TIE BAR for men’s neckties, bow ties, clothing, and accessories), because the goods offered at those pages under the marks are not relevant. *See* 30 TTABVUE 295-317.

²⁹ We note that Applicant also argues that Opposer’s Mark is suggestive “because it only requires a slight degree of imagination to understand that Opposer offers a variety of lip products, similar to a bar that offers a variety of alcoholic beverages.” (36 TTABVUE 28).

commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai*, 901 F.3d at 1373.

We focus on the recollection of the average consumer; here, an ordinary consumer who normally retains a general rather than a specific impression of trademarks, and who purchases “cosmetics,” which include “lipstick” and “make-up.” *See Geigy Chem.*, 438 F.2d at 1007; *L’Oreal*, 2012 WL 1267956, at *5.

Opposer’s Mark is THE LIP BAR and Applicant’s Mark is LIP LAB. Both are in standard characters and may be displayed in any font style, size, or color. Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a); *In re Viterra*, 671 F.3d at 1363.

As mentioned above, “THE” in Opposer’s Mark has no trademark significance. *See In re Thor Tech*, 2009 WL 1098997, at *2. Opposer’s registrations disclaim “LIP,” making BAR the dominant element. *See In re Code Consultants*, 2001 WL 1149619, at *4 (TTAB 2001) (disclaimed matter, “while not ignored in the analysis,” is often “less significant in creating the mark’s commercial impression”); *see also In re Allegiance Staffing*, 2015 WL4658961, at *4 (TTAB 2015) (“The [word] in Applicant’s mark is descriptive, as Applicant has acknowledged by its disclaimer of it Because descriptive words have little source-indicating significance, it is appropriate that we give less weight to [the word]; simply put, the presence of this word in Applicant’s mark is not sufficient to distinguish the marks.”).

In Applicant’s Mark, “LIP” is not disclaimed, but by itself the term is descriptive of Applicant’s Goods. We therefore give less weight to “LIP,” and find “LAB” to be the dominant element of LIP LAB.

The similarities end with the shared term “LIP.” The three letter words that follow in each — “BAR” for Opposer, and “LAB” for Applicant — cause the parties’ marks to appear and sound different.

More critically, the marks are very different in their connotations, or meaning. A “bar” is defined as “a counter at which food or especially alcoholic beverages are served.” (30 TTABVUE 377). In her deposition, Ms. Butler agreed that the mixology she used when creating lipstick during the early days of THE LIP BAR was analogous to the mixology bartenders employ when making cocktails. (*See* 30 TTABVUE 48-50). Even the lipstick colors offered under Opposer’s Mark are named after drinks typically found where alcoholic beverages are served: “Merlot,” “Baby Bellini,” “Whiskey Sour,” “Mochajito,” “Chaitini,” “Club Soda,” “Chocolate Spritzer,” “Cocoa Cooler,” “Cosmo,” and “Gin-ger & Tonic.” (16 TTABVUE 71; *see also* 30 TTABVUE 71 (screenshot from Opposer’s website)). In contrast, “lab” is an abbreviation for “laboratory,” which is defined as “a place equipped for experimental study in a science or for testing and analysis.” (Merriam-Webster.com, 30 TTABVUE 371). Applicant’s General Manager, Diana Peinado, testified that Applicant “adopted the LIP LAB mark for its connotation of a ‘laboratory’ where customers can experiment to create their perfect lip product.” (28 TTABVUE 8-9). Considering these definitions, the screenshot from Opposer’s website, Ms. Butler’s deposition testimony, and Ms. Peinado’s declaration testimony, we find that the parties’ marks have different meanings and convey very different commercial impressions.

In their entirety, we find that THE LIP BAR and LIP LAB are dissimilar in appearance, sound, and connotation. Thus, the overall commercial impressions of THE LIP BAR and LIP LAB are distinct.

E. Evidence of Actual Confusion

Now we turn to Opposer's allegations of actual confusion. (37 TTABVUE 46-48). Under the seventh *DuPont* factor, we consider "[t]he nature and extent of any actual confusion." 476 F.2d at 1361.

Opposer points to the deposition testimony of Ms. Butler and the declaration testimony of Ms. Robinson in support of its argument. (37 TTABVUE 46-47). Applicant, however, states that it is not aware of any instances of actual confusion, emphasizing that Opposer's actual confusion evidence focuses on custom lip product services rather than the lipstick and cosmetics identified in the involved application for LIP LAB. (36 TTABVUE 35-42).

The relevant portions of Ms. Butler's deposition testimony detailing alleged actual confusion have been stricken from the record. Ms. Robinson, the Detroit store manager, testified that in her experience, customers frequently visit or call the store under the mistaken belief that Lip Lab is affiliated with Opposer and its Detroit store. (18 TTABVUE 4). She estimates that she has addressed seventy-five similar mistaken inquiries from customers since January 2022. (*Id.*). We find Ms. Robinson's declaration testimony as to actual confusion is not hearsay,³⁰ but is vague and unsupported by any documentary evidence, including any business records. *See, e.g., Marshall Field & Co. v. Mrs. Fields Cookies*, 1992 WL 421449, at *6, 16 (TTAB 1992) (inquiries of affiliation not actual confusion); *Elec. Water Conditioners, Inc. v. Turbomag Corp.*, 1984 WL 63085, at *4 (TTAB 1984) ("That questions have been raised as to the relationship between firms is

³⁰ *See* J. Thomas McCarthy, 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:15 (5th ed.) (Nov. 2024 Update).

not evidence of actual confusion of their trademarks.”) (citations omitted); *Toys “R” Us, Inc. v. Lamps R Us*, 1983 WL 50152, at *8 (TTAB 1983) (“The fact that questions have been raised as to the possible relationship between firms is not by itself evidence of actual confusion of their marks.”).

Overall, we do not find Opposer’s evidence, comprised solely of Ms. Robinson’s declaration testimony, to be sufficiently probative of actual confusion of the parties’ marks. As a result, the seventh *DuPont* factor is neutral.

F. Any Other Established Fact Probative of the Effect of Use

For completeness, we consider Applicant’s argument that it has adopted and used LIP LAB in good faith.

Opposer argues that Applicant’s website, online webstores, and social media pages are styled in a “nearly identical fashion” as Opposer’s website and social media pages, allegedly by using the identical stylized font, same “lush pink color scheme,” and the same “model image format.” (37 TTABVUE 43). This nearly identical stylization would, Opposer contends, likely “cause consumers to wrongfully associate” Applicant’s Goods with Opposer’s Goods. (37 TTABVUE 43). In turn, Applicant disputes Opposer’s argument as “an attempt to establish bad faith intent,” and preemptively, contends that it adopted, and has used, its LIP LAB mark in good faith. (36 TTABVUE 34-35).

“A party’s bad faith in adopting a mark is relevant to the thirteenth *DuPont* factor, which includes ‘any other established fact probative of the effect of use.’” *QuickTrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 1036 (Fed. Cir. 2021) (citing *DuPont*, 476 F.2d 1361). “[A]n inference of ‘bad faith’ requires something more than mere knowledge of a prior similar mark.” *Id.* at 1036 (quoting *Sweats Fashions, Inc. v. Pannill Knitting Co.*,

833 F.2d 1560, 1565 (Fed. Cir. 1987)). “It requires an intent to confuse.” *Id.* (citation omitted).

We have considered the testimony of Ms. Peinado, (*see* 28 TTABVUE 8-9), along with the parties’ promotional materials and pages from their websites. (*Compare* 19 TTABVUE 26-27 *with* 19 TTABVUE 35-38). While there are some similarities, we do not find that they necessarily relate to the intentional copying of Opposer’s Mark. In addition, the record lacks specific evidence of Applicant’s intent to confuse or deceive consumers. Therefore, the thirteenth *DuPont* factor is neutral.

IX. Conclusion

Weighing and balancing the applicable *DuPont* factors based on the arguments and evidence presented, *In re Charger Ventures LLC*, 64 F.4th 1375, 1383 (Fed. Cir. 2023), we find that the parties’ respective goods are in-part identical and overlapping, and therefore, related; and the parties’ goods travel through the same channels of trade to the same class of purchasers. However, we weigh strongly our determination that the marks THE LIP BAR and LIP LAB are very different in their overall commercial impressions, even though they share the word “LIP.” And, the *DuPont* factors pertaining to actual confusion (seventh factor) and bad faith (arising under the thirteenth factor) are neutral.

Overall, based on this record, we conclude that a likelihood of confusion between the parties’ marks does not exist.

Decision: The opposition to the registration of LIP LAB, Serial No. 90768628, is dismissed.