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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	88434221
Applicant	Cosmo Spa Lounge & Supply, Inc.
Applied for Mark	GEL-LYS
Correspondence Address	BOYANA BOUNKOVA SUTTER LAW, P.C. 447 SUTTER STREET, STE 506 SAN FRANCISCO, CA 94108 UNITED STATES Primary Email: boyana@sutterlegal.com Secondary Email(s): info@sutterlegal.com, boyanaboumkova@gmail.com 415-341-2888
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Filer's Name	Boyana Bounkova
Filer's email	boyana@sutterlegal.com
Signature	/boyana bounkova/
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Serial No. 88434221

Mark: Gel-Lys

Applicant: Cosmo Spa Lounge & Supply, Inc.

Examining Attorney: Sahar Nasserghodsi,
 Law Office 115

APPLICANT'S EX PARTE APPEAL BRIEF

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COMES NOW Applicant, Cosmo Spa Lounge & Supply, Inc., ("Applicant") by and through its counsel of record, and hereby respectfully appeals the Examining Attorney's refusal to register the mark GEL-LYS in standard characters.

DESCRIPTION OF RECORD

A) PROSECUTION HISTORY

Applicant's standard character mark was filed on May 16, 2019, seeking registration on the principal register for the mark GEL-LYS ("Applicant's Mark") in connection with "*Artificial eyelash tweezers; Tweezers*" in International Class 8 and "*Battery-powered applicators for applying cosmetics to eyelashes; Motorized applicators for applying cosmetics to eyelashes*" in International Class 21.

The mark Application for GEL-LYS was initially refused on August 2, 2019 in a non-final Office Action because of likelihood of confusion with the marks GEL'ISS, Registration No. 4728364 ("Registered Mark" or "Registrant's Mark") and GELEZE, Serial No. 86263573, which mark was subsequently abandoned. Applicant filed Response to the Office Action on February 2, 2020. Final Refusal for the Registration for the mark GEL-LYS was issued by the Examining Attorney on February 20, 2020, due to likelihood of confusion with the mark in U.S. Registration No. 4728364, GEL'ISS under Trademark Act Section 2(d) 15 U.S.C. § 1052(d). On August 13, 2020 Applicant filed Request for Reconsideration which was denied by the Examining Attorney with Final Notice/ Denied Request For Reconsideration After Final Action dated August 28, 2020. Applicant's Notice of Appeal was timely filed on August 20, 2020.

B) EXAMINING ATTORNEY'S EVIDENCE

August 2, 2019, Office Action

The evidence attached to the Office Action consists of screen prints of the registration and application for the marks GEL'ISS and GELEZE, and screen shots from the websites "Revlon", "Kiss", "MAC", "Azaredo", and "Sephora" containing search results for eyelashes, eyelash applicators and lipstick sold by other brands.

February 20, 2020 Final Office Action

The Final Office Action contained the previously submitted examples from "Revlon", "Kiss", "MAC", "Azaredo", and "Sephora" and screenshots from the websites "Lilly Lashes", "Moxielash", and "House of Lashes", and the websites <https://www.made-in-china.com/showroom/yvonnechong79/product-detailAbNJkylCthq/China-Electrical-Rotating-Mascara-Brush-IT-1248-.html>, <https://www.ebay.com/c/1831542691> ; https://www.alibaba.com/product-detail/Factory-Price-Professional-Electric-RotatingBrush_60773619272.html?spm=a2700.7724857.normalList.87.2c50cce9FuTHIf, showing a variety of search results for artificial eyelashes, eyelash sets, eyelash and mascara brushes, curlers, etc. sold by different brands.

August 28, 2020 Final Letter /Denied Request for Reconsideration After Final Action

The Denial of the Request for Reconsideration after Final Action contained Internet evidence from "Anastasia Beverly Hills", "Benefit Cosmetics", "KBL Cosmetics", "Lancome", "SallyHansen", "Twinkle Apothecary", "Ulta Beauty", articles from "Cosmopolitan" and "Beauty Blvd.", and the previously submitted Internet evidence showing electrical or battery operated cosmetic applicators used with mascara and other cosmetics.

C) APPLICANT'S EVIDENCE

February 2, 2020, Response to Office Action

Contained in Exhibit 1, 2, 3, and 4 to Applicant's Response to Office Action, Applicant offered: Screen print from Registrant's website showing there is no product for sale with the name GEL'ISS and screen prints from Applicants website showing that Applicant's product is for sale for professionals only and that those professionals need to be registered licensed professionals.

August 13, 2020, Request for Reconsideration

Contained in Exhibit 1, 2 and 3, Applicant offered screen prints from dictionaries for the definitions of the words 'cosmetics' and 'gel', a list of 17 third party registered marks similar to the marks GEL-LYS and GEL'ISS for cosmetic products and/or services and examples of third party use of marks similar to GEL'ISS for similar products from 'Walmart', 'Amazon', 'Beyond Polish, and 'Universal Nail Supplies'.

ARGUMENT

A) LEGAL STANDARD

The U.S. Trademark Act § 2(d), 15 U.S.C. §1052(d) precludes registration of an applied-for mark that is so similar to a registered mark that it is likely consumers will be confused, mistaken or deceived as to the commercial source of the goods and/or services of the parties. Likelihood of confusion between two marks is determined on a case by case basis by review of the relevant factors under the so-called DuPont test (See *In re E.I. Du Pont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973) including factors such as:

- The similarity or dissimilarity of the marks in their entirety;
- The similarity or dissimilarity and nature of the goods or services such that one party's goods will be mistaken for those of the other party;
- The channels of distribution of the goods or services;
- The conditions under which the goods or services are purchased (i.e. impulse buying versus purchases made after careful consideration);
- The sophistication of the purchasers of the goods or services;
- The nature and extent of any actual confusion, and others;

The question of likelihood of confusion between marks is related not to the nature of the mark but to its effect "*when applied to the goods of the applicant.*" *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

B) ANALYSIS

There is no likelihood of confusion between Applicant's Mark and the cited Registered Mark. On comparison the marks are clearly not at all similar within the meaning of *DuPont, supra*. They differ in sound, appearance, meaning and connotation, and while they may share a common syllable, this similarity is weak and diluted at best and on its own can hardly serve as a basis for denial. Moreover, the goods offered under the respective marks are different, and of particular note

is the fact that Applicant's goods are offered to sophisticated customers in different channels of distribution from those bearing the Registered Mark.

1. ***Comparison of the Marks.***

When determining whether the marks are similar, we turn to the first of the above factors comparing the similarity or dissimilarity of the marks. Under *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973), the first factor requires examination of "*the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.*" The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar that there is a likelihood of confusion as to the source of the goods or services. See *Zheng Cai v. Diamond Hong, Inc.*, F.3d, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018); *Midwestern Pet Foods, Inc., v. Societe Des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010). When comparing the marks, "*[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar.*" *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000).

(a) ***Marks are not similar; they differ in Appearance, Sound, Meaning and Commercial Impression.***

Similarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a determination that confusion is likely even if the goods are identical or closely related; rather, taking into account all of the relevant facts of a particular case is essential to the analysis

The purpose of the marks not being assessed for likelihood of confusion on the basis of a side-by-side comparison, but rather upon whether the marks in the entireties of how they exist are sufficiently similar in terms of their overall commercial impression, is well known to serve the purpose of ensuring that confusion as to the source of the goods offered under the respective marks is not likely to result. This requires us, among other things, to keep in mind the fallibility of memory of the average purchaser over a period of time resulting in their normally retaining a

general overall impression of the mark or of the theme generated by the mark rather than relying upon a specific recollection of a trademark alone. See *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Grandpa Pidgeon's of Mo., Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973); *Johann Maria Farina Gegenuber Dem Julichs-Platz v. Chesebrough-Pond, Inc.*, 470 F.2d 1385, 176 USPQ 199, 200 (CCPA 1972); *In re Solar Energy Corp.*, 217 USPQ 743, 745 (TTAB 1983); *Carl Karcher Enters., Inc. v. MTS Franchise Corp.*, 213 USPQ 254, 257-58 (TTAB 1980); *In re Barnhardt Farms, Inc.*, 196 USPQ 309, 311 (TTAB 1977). Thus, when comparing Applicant's and Registrant's marks, the focus is on the overall commercial impression conveyed by such marks.

In the present case, there is no likelihood of confusion because, even though both marks share the common term 'GEL', the additional elements added to both marks are different 'ISS' and 'LYS'. In Registrant's mark due to the apostrophe used, one has the impression that the word is one: 'GELISS' (a sound-alike of jealous), which calls attention to a very different meaning and connotation. At the same time Applicant's mark GEL-LYS is a combination of two words – the word 'GEL' and the word 'LYS', which means 'light' in languages such as Danish, Hebrew, Norwegian, Western Frisian, and Yiddish.

(b) The Common Term in the Parties' Marks is Weak.

Under §1207.01(b)(viii) TMEP if the common element of two marks is "weak" in that it is generic, descriptive, or highly suggestive of the named goods or services, it is unlikely that consumers will be confused. See, e.g., *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-40, 115 U.S.P.Q.2d 1671, 1674-75 (Fed. Cir. 2015) (remanded for consideration of whether and to what degree the phrase PEACE & LOVE was suggestive or descriptive in the food-service industry); *In re Bed & Breakfast Registry*, 791 F.2d 157, 159 229 U.S.P.Q. 818, 819 (Fed. Cir. 1986) (reversing TTAB's holding that contemporaneous use of BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes, and BED & BREAKFAST INTERNATIONAL for room booking agency services, is likely to cause confusion, because, inter alia, the descriptive nature of the shared wording weighed against a finding that the marks are confusingly similar); *In re FabFitFun, Inc.*, 127 U.S.P.Q.2d 1670, 1675 (T.T.A.B. 2018) (holding I'M SMOKING HOT for cosmetics and related non-medical personal care items and SMOKIN' HOT SHOW TIME for cosmetics not likely to cause confusion based on a totality of the evidence

showing that the shared wording is somewhat weak in view of its suggestiveness and that the marks overall convey different commercial impressions); *U.S. Shoe Corp. v. Chapman*, 229 U.S.P.Q. 74 (T.T.A.B. 1985) (holding COBBLER'S OUTLET for shoes, and CALIFORNIA COBBLERS for footwear and women's shoes, not likely to cause confusion); *In re Istituto Sieroterapico E Vaccinogeno, Toscano "SCLAVO" S.p.A.*, 226 U.S.P.Q. 1035 (T.T.A.B. 1985) (holding ASO QUANTUM for diagnostic laboratory reagents, and QUANTUM I for laboratory instruments for analyzing body fluids, not likely to cause confusion).

In the present case the common term used by both marks is 'GEL'. This term is not descriptive of Applicant's product, however it is highly suggestive and descriptive of Registrant's goods, which based on the registration are '*cosmetics and cosmetic preparations*'. According to the definition in the dictionary cosmetic is "*a powder, lotion, lipstick, rouge, or other preparation for beautifying the face, skin, hair, nails, etc.*" (See Exhibit 1 submitted with Applicant's Request for Reconsideration). The definition for the term '*gel*' in the Cambridge dictionary is "*a thick, clear, liquid substance, especially one used on the hair or body*" and according to dictionary.com it is "*a semirigid colloidal dispersion of a solid with a liquid or gas, as jelly, glue, etc.*" (See Exhibit 1 submitted with Applicant's Request for Reconsideration). Based on those definitions and the description of the goods on the Registered mark, we can assume that the mark describes a quality of the goods it is registered for, as most cosmetics and their preparations exist in the form of gels. Additionally the specimen submitted for the registration of GEL'ISS is nail polish, which also has a gel-like substance. As a comparison, the use of the word GEL in connection with Applicant's goods is not descriptive, as it does not describe a quality or a characteristic of the goods.

Marks that are descriptive or highly suggestive are entitled to a narrower scope of protection, i.e. they are less likely to generate confusion over source identification, than their more fanciful counterparts. See, e.g., *Nat'l Data Corp. v. Computer Sys. Eng'g, Inc.*, 940 F.2d 676, at (Fed. Cir. 1991) (un-published); *Drackett Co. v. H. Kohnstamm & Co.*, 404 F.2d 1399, 1400 (CCPA 1969) ("*The scope of protection afforded such highly suggestive marks is necessarily narrow and confusion is not likely to result from the use of two marks carrying the same suggestion as to the use of closely similar goods.*" *Id.*)

Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted. See, e.g., *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d

1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (affirming TTAB's holding that contemporaneous use of applicant's CAPITAL CITY BANK marks for banking and financial services, and opposer's CITIBANK marks for banking and financial services, is not likely cause confusion, based, in part, on findings that the phrase "City Bank" is frequently used in the banking industry and that "CAPITAL" is the dominant element of applicant's marks, which gives the marks a geographic connotation as well as a look and sound distinct from opposer's marks).

The common element 'GEL' as such cannot be perceived by purchasers as distinguishing source, because of Registrant's descriptive use of the word. In addition the use of the word GEL in connection with the Registered mark is highly diluted by third party registrations and uses. Under §1207.01(b)(ix) TMEP the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that merely descriptive and weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-39, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005)".

Under § 1207.01(d)(iii) TMEP active third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. *See, e.g., In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-40, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015); *In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012). Properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used. *See, e.g., Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1976); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *United Foods Inc. v. J.R. Simplot Co.*, 4 U.S.P.Q.2d 1172, 1174 (TTAB 1987).

Evidence of third-party use falls under the sixth du Pont factor – the "*number and nature of similar marks in use on similar goods.*" *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it "*is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.*" *Palm Bay Imps., Inc. v. Veuve*

Clicquot Ponsardin Maison Fondée en 1772, 396 F.3d 1369, 1373-74, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005); see also *In re FabFitFun, Inc.*, 127 U.S.P.Q.2d 1670, 1675 (TTAB 2018) (finding the component term SMOKING HOT in the marks I'M SMOKING HOT and SMOKIN' HOT SHOW TIME to be "somewhat weak" based in part on evidence of third-party use of the term on similar cosmetics goods, noting that such uses "tend to show consumer exposure to third-party use of the term on similar goods"); *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 U.S.P.Q.2d 1464, 1470 (TTAB 2016) (noting that evidence that third parties had adopted marks that were the same as or similar to opposer's mark for use in connection with food products "may show that a term carries a highly suggestive connotation in the industry and, therefore, may be considered weak").

In the present case the term GEL is used in roughly 345 registered and pending marks in International Class 003. A list of some of those marks has been submitted as Exhibit 2 to Applicant's Request for Reconsideration.

The cited registrations show that the term GEL is widely and commonly used in the industry for marks in the field of cosmetics, cosmetic preparations, nail polish, makeup preparations, etc. This means that the term GEL is weak as it carries highly suggestive connotation in the cosmetic industry, additionally consumers have been exposed to numerous third party use of the said term for cosmetic goods and are not likely to be confused.

Sufficient evidence of third-party use of similar marks can "show that customers 'have been educated to distinguish between different marks on the basis of minute distinctions.'" McCarthy on Trademarks and Unfair Competition §11:88 (4th ed.2015) (quoting *Standard Brands, Inc. v. RJR Foods, Inc.*, 192 U.S.P.Q. 383 (T.T.A.B. 1976)). More broadly, evidence of third party use bears on the strength or weakness of an opposer's mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005). The weaker an opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection. *Id.*; *In re Coors Brewing Co.*, 343 F.3d 1340, 1345 (Fed. Cir. 2003) (third-party use can establish that mark is not strong); *Fleetwood Co. v. Mende*, 298 F.2d 797, 799 (CCPA 1962) ("Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.") Exhibit 3, submitted by Applicant with its Request for Reconsideration contains evidence of the extensive use of the mark GELISH, which is highly similar to the Registered Mark and is widely advertised, marketed and available through Amazon, Walmart, Beyond Polish, Universal Nail Supplies, etc. Based on the cited authority and the

submitted evidence, the Registered Mark shall be given narrow protection for cosmetic preparations only. Since Applicant's Mark does not seek registration for goods in those categories, it shall be granted protection.

In her denial of the Applicant's Request for Reconsideration the Examining Attorney contends that all those third party marks convey different commercial expression and are different than each other. We disagree, the mark GEL'ISS (a soundalike of jealous) is very similar to GELISH, GEL IT, GELLY – phonetically, conceptually and visually, in addition the products with the mark GELISH are so widely available, that the average consumer should be educated well enough to distinguish between the different marks resembling that brand.

According to *Juice Generation, Inc. v. GS Enters., LLC*, No. 14-1853 (Fed. Cir. 2015), such extensive evidence of third-party use and registrations is "*powerful on its face*," even where the specific extent and impact of the usage has not been established.

2. Applicant's Goods Are Different than the Goods Of the Registered Marks.

The next factor to be reviewed under the *Du Pont* test is the similarity of the goods. Examining Attorney considers that Applicant's goods are related to the goods in the Registered mark, claiming that the compared goods do not need to be identical or competitive to find a likelihood of confusion, they only need to be "*related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods] emanate from the same source*" (citing *Recot Inc. v. Becton*, 214 F.3d 1322 (Fed. Cir. 2000)).

There is no per se rule that goods or services sold in the same field or industry are similar or related for purposes of likelihood of confusion. See *Cooper Industries, Inc. v. Repcoparts USA, Inc.*, 218 USPQ 81, 84 (TTAB 1983); *Lloyd's Food Products, Inc. v. Eli's, Inc.* 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

Applicant is looking to register the mark GEL-LYS for "*Artificial eyelash tweezers; Tweezers*" in International Class 8 and "*Motorized applicators for applying cosmetics to eyelashes; Battery-powered applicators for applying cosmetics to eyelashes*" in International Class 21. The mark GEL'ISS is registered for "*Cosmetics and cosmetic preparations*" in International Class 3.

As it is obvious from the description of the goods in the listed application and registration, Applicant's goods do not overlap with Registrant's goods. Applicant has developed a proprietary

and patent pending method for eyelash extension, which is used in Applicant's beauty salon, the device used in that method is the patent pending device 'Gel-Lys', which is a gel curing device that bonds eyelash extensions instantly, the device features a Light Emitting Diode (LED). Registrant on the other side has registered their mark for cosmetics and cosmetic preparations, however there is no information and evidence available about the products that are marketed under this mark. According to the specimen provided by Registrant the mark was used on nail polish, however our extensive search for products (including nail polish) with the mark GEL'ISS did not return any results, we could not locate even nail polish with this brand, Registrant's website did not contain information about the brand either.

In its refusal to register the mark Examining Attorney relies on the ruling in *Recot Inc. v. Becton*, however this ruling is not applicable to the present case, as Registrant's Mark is not famous, also we do not have information and evidence of this particular mark being marketed in a way that could somehow be related to eyelash extension devices.

Based on the examples provided by the Examining Attorney from the various internet sources marketing eyelashes and eyelash related products and other cosmetics she contends that that the goods listed on the application and the Registered Mark are related due to the fact that other entities manufacture goods similar to those of Applicant and Registrant. She also claims that Applicant's battery-powered applicators for applying cosmetics to eyelashes and motorized applicators for applying cosmetics to eyelashes are goods that can be used with Registrant's cosmetic goods. We disagree, as already explained Applicant's products can be used with Applicant's bonds and glues, they can only be used by professionals. None of the products from the submitted internet evidence does not even remotely resemble Applicant's patent pending device, most of the devices from the submitted evidence are mascara applicators, which are quite different than Applicant's product. Also none of the submitted evidence shows that Registrant sells eyelash related cosmetics under the brand GEL'ISS.

Under §1207.01(a)(vi) TMEP the Examining Attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion. See, e.g., *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) Evidence of relatedness might include news articles and/or evidence from computer databases showing that the relevant goods/services are used together or used by the same purchasers; advertisements showing that the relevant goods/services are advertised together or sold by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both applicant's goods/services and the

goods/services listed in the cited registration. The evidence provided by the Examining Attorney does not show any of these things and therefore the rejection on this basis must fail. The goods and the services sold by Applicant and Registrant are not sold by the same dealers, used by the same purchasers nor advertised together.

Goods are related not because they co-exist in the same broad industry, but are related if the services are marketed and consumed such that buyers are likely to believe that the services, similarly marked, come from the same source, or are somehow connected with or sponsored by the same company. (See *Daddy's Junky Music Stores, Inc. v. Big Daddy' Family Music Center*, 109 F.3d at 283-84). "*The question is, are the [goods or services] related so that they are likely to be connected in the mind of a prospective purchaser?*" (See *Fleischmann Distilling Corp. v. Maier Brewing Co.*, 314 F.2d 149, 159 (9th Cir.1963)).

The fact that Applicant's and Registrant's products can be categorized in the same broad field of 'cosmetology' does not, in and of itself, provide a basis for regarding their products as related. See *In re Digirad Corp.*, 45 U.S.P.Q.2d 1841 (holding that despite some industry 'overlap', DIGIRAY and DOGORAD are not confusingly similar for high tech medical diagnostic apparatus used to different ends); *Cooper Industries, Inc. v. Repcoparts USA, Inc.*, 218 USPQ 81,84 (T.T.A.B. 1983) ("*the mere fact that the products involved in this case (or any products with significant differences in character) are sold in the same industry does not of itself provide an adequate basis to find the required 'relatedness'.*")

Even where the marks are identical, which is not the case here, and the products can be effectively marketed to the same customers, which is also not the case here, sufficient differences between the products and services negates likelihood of confusion. (See *MacGraw-Hill, Inc. v. Comstock Partners Inc.*, 743 F.Supp. 1029, 1034 (S.D.N.Y 1990)), (COMSTOCK for computer network for providing "real time" stock quotes was held not likely to be confused with COMSTOCK for money management of large investment portfolios, and the mere fact that the products sold under both marks were "related to the broad field of finance" was held insufficient to demonstrate that the products are related).

For the above stated reasons, the Applicant's goods should not be considered similar to the goods of the Registered Mark.

3. The Goods in Question Are Used in Different Channels of Trade and Distribution and Require High Degree of Purchaser's Care.

Even where two marks are identical, courts and the TTAB routinely hold that there is no likelihood of confusion "if the goods or services in question are not related in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source." TMEP § 1207.1(a)(i) (citing *Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 U.S.P.Q.2d 1156 (T.T.A.B. 1990) (LITTLE PLUMBER for drain opener not confusingly similar to LITTLE PLUMBER and Design for advertising services). See also *Reynolds & Reynolds Co. v. I.E. Systems, Inc.*, 5 U.S.P.Q.2d 1749, 12 (T.T.A.B. 1987) (no confusion where "applicant is offering a specific type of software for operational uses while the products and services offered by opposer are applications software aimed at a very narrow field.").

Courts consider the respective marketing channels of the parties to a trademark infringement action to determine "how and to whom the respective goods and services of the parties are sold". (See *Gen. Motors Corp. v. Keystone Auto. Indus., Inc.* 453 F.3d 351, 357). There is less likelihood of confusion where the goods are sold through different avenues. *Gen. Motors Corp., supra*.

There is no overlap between the distribution channels of Applicant's and Registrant's goods. In the present case the Marks are not identical and the parties' respective products and services are distinct, the products under the Registered and Applicant's Marks have different functions and serve different purposes. In the evidence submitted, the Examining Attorney fails to show that Applicant's product and Registrants' products use the same channels of distribution. None of the internet examples submitted with the office actions and the denied request for reconsideration show Applicant's or Registrant's products being sold through those same channels.

On the contrary, as the differences in the respective product offerings would suggest, the parties market their products to very different marketplaces in distinct channels of trade. Applicant's products are marketed and sold to licensed professionals only, who possess State Board Licenses for eyelash extension or are enrolled in beauty programs for eyelash extension professionals. For this reason Applicant has the following disclaimer on her website under each product/ services offered:

"Licensed Professionals and Beauty College students only. Only registered State-board Licensed Professionals can see prices and purchase our products. Please apply for

an account. Only state board licensed professionals are legally certified to service eyelash extensions in selected US states, and internationally."

As such, Applicant's products have been marketed in highly specific and limited channels of trade to sophisticated customers, and they are offered and sold directly to customers either by Applicant or by trained and pre-approved resellers of Applicant. Due to the nature of the product Applicant's customers are highly knowledgeable about the products they purchase and their source and exercise a high degree of care with regard to those products. Sophisticated consumers generally exercise greater care in their field of expertise and are less likely to be confused (See *Toro Co. v. TorHead Inc.*, 61 U.S.P.Q.2d 1164 (T.T.A.B. 2001)).

In assessing the degree of purchaser's care, courts usually use a "*typical buyer exercising ordinary caution*" standard. (See *Daddy's Junky Music Stores, Inc. v. Big Daddy' Family Music Center*, 109 F.3d at 285). When potential buyers possess special expertise or are sophisticated purchasers of the goods at issue, a higher standard is appropriate and the likelihood of confusion decreases. *Id.*

As opposed to that Registrants' products presumably do not require a special knowledge or expertise to use, we do not have evidence as to the manner those products are marketed, however from the specimen submitted with their application, it seems that they are intended to be sold through the common retail chains to ordinary consumers; also it is obvious that the use of those products does not require special knowledge, research and preparation.

For these reasons all potential clients and customers of Applicant's goods are highly unlikely to be confused as to the source and origin of Registrants' and Applicant's goods and vice versa. As such, confusion between the Registered and Applicant's Marks is highly unlikely. Additionally Registrant's customers are highly unlikely to be confused as to the source of Applicant's products as they are not available to average consumers.

Examining Attorney points to 1207.01(d)(vii) claiming that "*the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune to source confusion*", however according to the same provision if the goods are available to sophisticated purchasers only (which is exactly the case here), that would negate likelihood of confusion. See, e.g., *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase

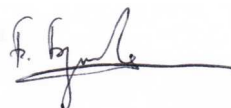
the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED.)

C) CONCLUSION

In sum, the differences between the commercial impressions, appearance, and sound created by the Registered Mark GEL'ISS and Applicant's Mark GEL-LYS would be sufficient to prevent a likelihood of confusion. Further, Applicant's goods are separate and distinct from the cited Registrant's goods and are not likely to be purchased by the same consumers. Applicant's goods are targeted to a specific group of customers, they require special professional qualification and knowledge in order to be used, therefore consumers would exercise a higher degree of care when buying and using those products and would literally not be looking for any product other than from the same compatible source, as opposed to a product that has nothing to do with the same. For all these reasons confusion is unlikely and therefore Registrant would not be subject to an adverse commercial impact due to use and registration of Applicant's Mark. Accordingly, Applicant respectfully requests that the refusal to register the mark GEL-LYS be withdrawn and that the application be permitted to proceed to publication.

WHEREFORE, Applicant respectfully requests that the Board REVERSE the refusal to register pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d), and allow the Application to proceed to publication.

Dated this 26 day of October, 2020.



Boyana Bounkova
Sutter Law, P.C.
447 Sutter Street, Suite 506
San Francisco, CA 94108
Attorney for Applicant