

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: September 9, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Make Great Sales Limited
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Serial No. 88719345
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Brent D. Sausser of Sausser Summers, PC,
for Make Great Sales Limited.

Nicholas K.D. Altree, Trademark Examining Attorney, Law Office 107,
J. Leslie Bishop, Managing Attorney.

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Before Taylor, Larkin, and Coggins,
Administrative Trademark Judges.

Opinion by Coggins, Administrative Trademark Judge:

Make Great Sales Limited (“Applicant”) seeks registration on the Principal
Register of the mark **URANUS** (in standard characters) for:

personal hygiene products in the nature of non-medicated
sanitary preparations being toiletries for the care of skin,
hair and scalp, namely, hair shampoos and conditioners,
bar soaps, bath soaps, and bath soaps in liquid, solid or gel
form; none of the aforementioned goods being personal
lubricants; in International Class 3.¹

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¹ Application Serial No. 88719345 was filed on December 9, 2019, under Section 1(b) of the
Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a bona fide
intention to use the mark in commerce.

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as applied to the personal hygiene goods identified in the application, so resembles the mark **WET URANUS** registered on the Principal Register for "gels for use as personal lubricant; personal lubricants; personal sexual lubricants; silicone-based personal lubricants; water-based personal lubricants," in International Class 5,² as to be likely to cause confusion, to cause mistake, or to deceive.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed and briefed. We affirm the refusal to register.

I. Likelihood of Confusion

Our determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as "*DuPont* factors"); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). The Board considers those *DuPont* factors for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *see also Stratus Networks, Inc. v. UBTA-UBET Commc'ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at

² Registration No. 4362322, issued July 2, 2013; Sections 8 and 15 combined declaration accepted and acknowledged.

*3 (Fed. Cir. 2020) (“Not all *DuPont* factors are relevant in each case”). Two key considerations are the similarities between the marks and the relatedness of the goods. See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

A. Relatedness of the Goods

We begin with the second *DuPont* factor, which “considers [t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). The issue is not whether purchasers would confuse the goods, but whether there is a likelihood of confusion as to the source of the goods. *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *5 (TTAB 2020); *L’Oreal v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012). The goods need not be identical or even competitive to find a likelihood of confusion. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). They need only 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 they emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724

(TTAB 2007)); *see also In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993).

Evidence of relatedness may include news articles or evidence from computer databases showing that the goods are used together or used by the same purchasers; advertisements showing that the goods are advertised together or sold by the same manufacturer or dealer; and copies of prior use-based registrations of the same mark for both applicant's goods and the goods listed in the cited registration. *In re Embiid*, 2021 USPQ2d 577, at *22-23 (TTAB 2021) (citing *Ox Paperboard*, 2020 USPQ2d 10878, at *5; and *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (evidence that "a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis"))).

As indicated above, the goods in the application include non-medicated shampoos, conditioners, bar soaps, and bath soaps in liquid, solid, or gel form; and the goods in the cited registration include personal lubricants. The Examining Attorney argues that these goods are "highly related" because they often emanate from a single source. 10 TTABVUE 9.³

In support of that position, the Examining Attorney cites to copies of third-party webpages made of record in the July 16, 2020 and March 10, 2021 Office Actions showing various third-parties offering for purchase under the same mark one or more goods of the types identified in both Applicant's application and the cited registration.

³ Citations to the briefs in the appeal record refer to the TTABVUE docket system. Citations to the prosecution file refer to the .pdf version of the TSDR system record. *See In re Consumer Protection Firm PLLC*, 2021 USPQ2d 238, at *3 n.3 (TTAB 2021).

10 TTABVUE 10-11. *See* July 16, 2020 Office Action at 60-61 (squeeze pod.com: personal lubricant, shampoo, soap); March 10, 2021 Reconsideration Letter at 24-25 (luvenacare.com: soap, personal lubricant), and 33-55 (goodcleanlove.com: personal lubricant, soap). We find that the third-party webpage evidence showing the same mark used for both sets of goods is probative to demonstrate that Applicant's goods and Registrant's goods are related for likelihood of confusion purposes. *See, e.g., Detroit Athletic Co.*, 128 USPQ2d at 1051 (relatedness supported by evidence that third parties sell both types of goods under same mark, showing that "consumers are accustomed to seeing a single mark associated with a source that sells both."); *In re Anderson*, 101 USPQ2d 1912, 1920 (TTAB 2012) (Internet excerpts from "several third-party car dealerships offering 'tires' for sale on their websites" was "evidence that consumers expect to find both 'tires,' . . . "and 'automobiles' . . . emanating from a common source.").

The Examining Attorney also made of record over 40 used-based registrations covering both sets of goods. *See, e.g.*, March 6, 2020 Office Action at 11 (Registration No. 4598157: non-medicated toiletries, lubricants), 28 (Registration No. 5252347: personal lubricant, body wash), 31-32 (Registration No. 5745934: soap, shampoo, conditioner, skin lubricants); July 16, 2020 Office Action at 6 (Registration No. 2736259: body soaps, personal lubricants), 9 (Registration No. 2878370: soaps, personal lubricants), 15 (Registration No. 3737652: soaps, personal lubricant), 18 (Registration No. 3663612: shower gels, personal lubricant); and March 10, 2021 Reconsideration Letter at 4-5 (Registration No. 6240241: shampoos, bar soap, liquid

bath soaps, personal lubricants), 7 (Registration No. 6240306: hair conditioner, hair shampoo, soap bars, personal lubricants), 17 (Registration No. 6201670: shampoo, conditioner, personal lubricants), 20 (Registration No. 6275784: shampoos with aloe vera, hair conditioners with aloe vera, aloe vera-based personal lubricants). The registrations have probative value to the extent that they serve to suggest that the listed goods are of a type that may emanate from the same source. *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *8 (TTAB 2019); *In re I-Coat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018); *Albert Trostel & Sons*, 29 USPQ2d at 1785-1786; TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1207.01(d)(iii) (July 2021).

Half-heartedly suggesting that confusion is unlikely due to the classification of the goods, Applicant notes that the goods in its application are in a different International Class than the goods in the cited registration. *See* 9 TTABVUE 10 n.1. Classification, however, is irrelevant in our analysis. “The classification system was established for the convenience of the [Patent and Trademark] Office rather than to indicate that goods in the same class are necessarily related or that classification in different classes indicates that they are not related.” *Nat’l Football League v. Jasper All. Corp.*, 16 USPQ2d 1212, 1216 n.5 (TTAB 1990); *see also* *Detroit Athletic Co.*, 128 USPQ2d at 1051 (quoting *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993) (classification is for the convenience of the Office and is “wholly irrelevant to the issue of registrability under section 1052(d), which makes no reference to classification”)).

Applicant argues that it expressly excluded personal lubricants from its identification of goods, “resulting in the only commonality between the [goods being] that the two are used on the body.” 9 TTABVUE 10. Consumers are, of course, unaware of this limitation in the application, and it is “not controlling of public perception.” *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1188 (TTAB 2018) (citing *In re The Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 340 (CCPA 1978) (“[T]he locus of potential confusion is [not] in the files of the PTO.”)). In any event, despite the limitation, Applicant’s goods remain related to those in the cited registration as demonstrated by the evidence of record. As set forth above, the second *DuPont* factor considers not whether goods are legally identical or even competitive, but whether they are sufficiently related such that consumers might believe they come from the same source when sold under the same or similar marks. *See On-line Careline*, 56 USPQ2d at 1475; *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989). As noted above, the issue is not whether consumers will confuse the goods themselves, but rather whether consumers will confuse their source. *Ox Paperboard*, 2020 USPQ2d 10878, at *5; *L’Oreal S.A. v. Marcon*, 102 USPQ2d at 1439.

In another effort to persuade us that the goods are unrelated, Applicant notes that it “owns an approved trademark application for similar goods (toiletries, namely, toothbrushes) for the mark URANUS.” 8 TTABVUE 11 n. 2. This argument implies that because the Examining Attorney did not cite Registrant’s mark against Applicant’s other application, which covers goods that were divided out of the current

application, *see* December 27, 2019 Request to Divide and February 6, 2020 Notice that Processing of Request to Divide Application is Completed, personal lubricants also should not be found to be related to other toiletries. However, it is well established that the Board is not bound by the prior decisions of examining attorneys, and each case must be decided on its own merits. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). While there is no evidence in the current appeal that toothbrushes are related to personal lubricants, there is ample evidence that Applicant's "non-medicated sanitary preparations being toiletries for the care of skin, hair and scalp" are related to personal lubricants.

In view of the evidence demonstrating that the goods frequently emanate from a single source and are advertised under the same mark by the same entity, the second *DuPont* factor weighs in favor of finding that confusion is likely.

B. Similarity of the Marks

The first *DuPont* factor considers the "similarities or dissimilarities of the marks in their entireties as to appearance, sound, connotation and commercial impression." *Detroit Athletic Co.*, 128 USPQ2d at 1051 (quoting *DuPont*, 177 USPQ at 567). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd mem.*, 777 F. App'x. 516 (Fed. Cir. 2019).

Consumers often do not have the opportunity of making side-by-side comparisons between marks, and must instead rely upon their imperfect recollections. *In re 1st*

USA Realty Pros. Inc., 84 USPQ2d 1581, 1587 (TTAB 2007). Therefore, “[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (citing *Coach Servs.*, 101 USPQ2d at 1721).

The marks “must be considered . . . in light of the fallibility of memory” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)). Our focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of service marks. *See Neutrogena Corp. v. Bristol-Myers Co.*, 410 F.2d 1391, 161 USPQ 687, 688 (CCPA 1969) (many consumers “may have but dim recollections from having previously seen or heard one or the other of the involved marks.”); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *In re Assoc. of the U.S. Army*, 85 USPQ2d 1264, 1268 (TTAB 2007).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be

dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). Further, “[n]o element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone.” *In re Electrolyte Labs. Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (citing *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (CCPA 1974)). Nonetheless, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014).

We note that Applicant’s mark URANUS is incorporated within Registrant’s mark WET URANUS. While there is no explicit rule that likelihood of confusion automatically exists where one mark incorporates the entirety of another mark, the fact that the one mark is subsumed within the other increases the similarity between the two. *See, e.g., Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660 (TTAB 2014) (“Likelihood of confusion often has been found where the entirety of one mark is incorporated within another.”). The marks are similar in appearance and sound to the extent that each is comprised of or contains the word URANUS. We add that because both Applicant’s mark and Registrant’s mark are standard character marks, we must consider that both may be presented in the same font, size, and color,

increasing their similarity in appearance. *See Aquitaine Wine USA*, 126 USPQ2d at 1186.

Applicant argues that, given the nature of Registrant's goods, the cited mark will be pronounced as WET YOUR ANUS, while its own mark will be pronounced as YUR-UN-US, one of the alternate pronunciations of "the planet-oriented use" of the mark which Applicant intends. 8 TTABVUE 9. However, there is nothing in the nature of Applicant's identified personal hygiene products that would lead us to believe that the pronunciation of URANUS, comprising Applicant's mark, would be different than the pronunciation of URANUS in the cited mark. To the extent the word URANUS is suggestive of "your anus" for personal lubricants, the same may be said for Applicant's bar and bath soaps which are used to clean the body. *See 1st USA Realty Pros.*, 84 USPQ2d at 1586-87 (finding that the respective marks carry the identical suggestive connotation).

Regardless of how Applicant wishes its mark to be pronounced, "there is no correct pronunciation of a trademark." *In re Belgrade Shoe Co.*, 411 F.2d 1352, 162 USPQ 227, 228 (CCPA 1969). *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012) ("[T]here is no correct pronunciation of a trademark, and consumers may pronounce a mark differently than intended by the brand owner."); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 n.3 (TTAB 1987) ("[C]orrect pronunciation as desired by the applicant cannot be relied upon to avoid a likelihood of confusion."). We must consider all reasonable possibilities for the pronunciation of URANUS. *Inter IKEA Sys. B.V.*, 110 USPQ2d at 1740 n.19. URANUS, while the name of a planet, may

possibly be pronounced as “your anus” even in that setting, and it is common knowledge that URANUS is often the object of off-color potty humor and sexual innuendo regarding “your anus.”

As the Examining Attorney notes, 10 TTABVUE 6, the word WET is highly suggestive when used in connection with Registrant’s goods – personal lubricants. We are not persuaded by Applicant’s argument that “WET will be impressed upon a consumer[']s mind because it [is] the first term that they focus on when making a purchasing decision.” 8 TTABVUE 9. To the contrary, we find the term URANUS to be the dominant portion of the cited mark. URANUS is the only term comprising Applicant’s mark, and it is the most distinctive element of Registrant’s mark. As explained just above, the innuendo accompanying URANUS makes it a word not easily overlooked or forgotten. While Registrant’s mark includes the term WET, and thus differs from Applicant’s mark, likelihood of confusion is not necessarily avoided between otherwise confusingly similar marks merely by adding or deleting other distinctive matter, or a term that is descriptive or suggestive of the identified goods; if the dominant portion of both marks is the same, then the marks may be confusingly similar notwithstanding peripheral differences. *See, e.g., Stone Lion*, 110 USPQ2d at 1161; *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

The Examining Attorney argues that “[A]pplicant’s mark is likely to appear to prospective purchasers as a shortened form of [R]egistrant’s mark.” 10 TTABVUE 7. We agree. *See In re United Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (“Applicant’s

mark [CAREER IMAGE] would appear to prospective purchasers to be a shortened form of registrant's mark [CREST CAREER IMAGES]."); *see also, e.g., In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010). Consumers with an imperfect recollection of Registrant's WET URANUS mark for personal lubricants who subsequently encounter Applicant's URANUS mark for related personal hygiene products such as shampoo, conditioner, and soap are likely to mistakenly believe that the mark is a companion mark that identifies a product line extension. *In re Apparel Ventures, Inc.*, 229 USPQ 225, 226 (TTAB 1986) (SPARKS BY SASSAFRAS (stylized), for clothing, and SPARKS (stylized), for footwear, likely to cause confusion, because "[t]hose already familiar with registrant's use of its mark in connection with its goods, upon encountering applicant's mark on applicant's goods, could easily assume that 'sassafras' is some sort of house mark that may be used with only some of the 'SPARKS' goods").

We agree with Applicant that there are differences between the marks, and we must consider them. While the additional word WET in Registrant's mark creates some differences in appearance and sound, we find the marks overall more similar than dissimilar, particularly because we must consider the marks "in light of the fallibility of memory." *See St. Helena Hosp.*, 113 USPQ2d at 1085. When we do so, we find Registrant's mark and Applicant's mark in their entireties to be more similar than they are different in sound, appearance, and overall commercial impression. The

similarities of the marks, the first *DuPont* factor, support the conclusion that confusion is likely.

C. Summary

When analyzing the *DuPont* factors, the overriding concern is not only to prevent buyer confusion as to the source of the goods, but also to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *Country Oven*, 2019 USPQ2d 443903, at *2-3 (citing *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993)). We have found that the goods are related, and that although there are differences between the marks, they are more similar than dissimilar in all means of comparison. Accordingly, we find that when Applicant's mark URANUS is used on the identified personal hygiene products, it is likely to cause confusion with Registrant's mark WET URANUS for the identified personal lubricants.

II. Decision

The refusal to register Applicant's mark URANUS is affirmed.