

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: August 22, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Lip Bar, Inc.

v.

Metro1 Solutions, LLC

Opposition No. 91289231

Staci R. DeRegnaucourt and Chelsea P. Everson of Varnum LLP
for The Lip Bar, Inc.

Morris E. Turek of YourTrademarkAttorney.com
for Metro1 Solutions, LLC.

Before Goodman, Allard and Stanley,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Metro1 Solutions, LLC (Applicant) seeks registration on the Principal Register of the mark LIP TAR (in standard characters, LIP disclaimed), identifying “Lip gloss” in International Class 3.¹



¹ Application Serial No. 97841454 was filed on March 15, 2023 based on bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

The Lip Bar, Inc. (Opposer) opposes registration on the ground of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on its use and Principal Register registrations² of THE LIP BAR (stylized and standard characters, LIP disclaimed) for a variety of cosmetics including lip repairers and lip balm, lip cream, lip gloss, lip gloss palette, lip liner, lip polisher, lipstick, lipstick cases, lipstick holders, and lipsticks in International Class 3³ and for THE LIP BAR (standard characters, BAR disclaimed, Section 2(f) claim as to the mark in its entirety) and TBL THE LIP BAR (standard characters, BAR disclaimed, Section 2(f) in part as to THE LIP BAR) for retail or online retail store services featuring cosmetics, including lipsticks, lip primer and lip repairers, lip balms, lip creams, lip glosses, lip gloss palettes, lip liners, and lip polisher in International Class 35.⁴

In the answer, Applicant denies the salient allegations in the notice of opposition.

The parties filed cross-motions for summary judgment stipulating that the Board may render a decision on the merits based solely on the summary judgment submissions of the parties (6, 10 and 11 TTABVUE) on the likelihood of confusion

² Opposer included plain copies of the certificate of registrations with the notice of opposition, but not status and title copies or an electronic printout from the USPTO database.


³ Registration No. 4160619, , issued June 19, 2012, renewed. The mark consists of the wording "THE LIP BAR" in stylized font." Color is not claimed as a feature of the mark. Registration No. 5579335, THE LIP BAR, issued October 9, 2018.

⁴ Registration No. 6933120, THE LIP BAR, issued December 27, 2022.

Registration No. 6933121, TLB THE LIP BAR, issued December 27, 2022.

claim.⁵ The parties also stipulated that the Board may decide any genuine disputes of material facts.⁶ *Id.* Therefore, we treat these stipulations as an agreement for the Board to decide this matter under accelerated case resolution procedures. *See generally* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 528.05(a)(2); 702.04(b) (2024).

Additionally, in its motion for summary judgment, Applicant stipulated to the following relating to entitlement to oppose, priority, and likelihood of confusion, all discussed *infra*:

- 1) Applicant stipulates that Opposer has established an entitlement to bring a statutory cause of action.
- 2) Applicant stipulates that Opposer is the owner of all four trademark registrations pleaded in Opposer's Notice of Opposition and that all registrations are valid and subsisting.
- 3) Applicant stipulates that Opposer has priority in this opposition proceeding.
- 4) Applicant stipulates that the products recited in its application are identical, similar, and/or strongly related to the products/services for which Opposer's LIP BAR Marks are registered.
- 5) Applicant stipulates that the products recited in its application could be offered/sold throughout the United States and used by individuals throughout the United States.
- 6) Applicant stipulates that the products/services for which Opposer's LIP BAR Marks are registered could be offered/sold throughout the United States and used by individuals throughout the United States.

⁵ Applicant's motion for summary judgment is at 6 TTABVUE; Opposer's [combined response brief and] cross-motion is at 9 TTABVUE (confidential)/10 TTABVUE (public); Applicant's [combined reply and response] is at 11 TTABVUE. Only Applicant filed a reply.

⁶ Record citations in this decision are to TTABVUE, the Board's electronic docket system. The number preceding "TTABVUE" corresponds to the docket entry, and any number(s) (if any) following "TTABVUE" refer to the page number(s) of the docket entry.

- 7) Applicant stipulates that the channels of trade for the products recited in its application could be identical to the channels of trade for the products/services for which Opposer's LIP BAR Marks are registered.
- 8) Applicant stipulates that the products recited in its application could be advertised via the same means and methods and sold in the same physical and online outlets as the products/services for which Opposer's LIP BAR Marks are registered.
- 9) Applicant stipulates that the products recited in its application could be sold to the same types and classes of consumers as the products/services for which Opposer's LIP BAR Marks are registered.
- 10) Applicant stipulates that the products recited in its application could be used by the same types and classes of consumers as the products/services for which Opposer's LIP BAR Marks are registered.
- 11) Applicant stipulates that the consumers who would purchase/use the products recited in its application, as well as the consumers who would purchase/use the products/services for which Opposer's LIP BAR Marks are registered, are of ordinary sophistication and intellect.
- 12) Applicant stipulates that the products recited in its application are relatively inexpensive and could be sold at the same price points as the relatively inexpensive products/services for which Opposer's LIP BAR Marks are registered.
- 13) Applicant stipulates that consumers would only exercise ordinary care in selecting and purchasing the products recited in its application, as well as the products/services for which Opposer's LIP BAR Marks are registered.

6 TTABVUE 3-5.

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the involved application.

In addition, under the stipulation, the parties' evidence submitted in connection with the parties' cross-motions for summary judgment is of record. This evidence consists of Opposer's "notice of reliance" on internet webpages and social media

webpages (8 TTABVUE) and Applicant's exhibits on summary judgment (6 TTABVUE).

II. Evidentiary Issue

Applicant objects to Opposer's notice of reliance, filed May 16, 2024, prior to the submission of its motion for summary judgment on May 21, 2024 as "outside the testimony period." 11 TTABVUE 3. The objection is overruled and we consider this evidence. Applicant otherwise states that if the Board considers the exhibits contained in the notice of reliance, because they are unaccompanied by testimony, they are only probative for what they show on their face as they are otherwise hearsay.

"As for articles, whether from the Internet or printed publications, Applicant is correct that because they are not accompanied by testimony, they may not be considered for the truth of the matters asserted therein ... and are admissible for what they show on their face." *Ricardo Media Inc. v. Inventive Software, LLC*, Opp. No. 91235063, 2019 TTAB LEXIS 283, at *4-6 (TTAB 2019) (citing *Safer, Inc. v. Oms Invs*, Opp. No. 91176445, 2010 TTAB LEXIS 51, at *15 and *29 (TTAB 2010)).⁷

Nonetheless, these exhibits offered under notice of reliance can be considered evidence for purposes of public exposure and not for the truth. *See e.g., Harry Winston, Inc. v. Bruce Winston Gem Corp.*, Opp. No. 91153147, 2014 TTAB LEXIS

⁷ The citation form in this opinion is in a form provided in TBMP § 101.03, which practitioners also should adhere to and employ. 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 by citation to the Federal Reporter. For decisions of the Board, this opinion employs citation to the LEXIS database.

284, at *23 & *79-80 n.131 (TTAB 2014) (Third-party websites “are frequently competent to show, on their face, matters relevant to trademark claims (such as public perception), regardless of whether the statements are true or false.”).

Applicant also objects to the Board’s consideration of facts and figures not offered by testimony. 11 TTABVUE 3. Those deficiencies are discussed *infra*.

III. Statutory Entitlement

To establish entitlement to a statutory cause of action under Trademark Act Section 13, 15 U.S.C., § 1063, a plaintiff must demonstrate “an interest falling within the zone of interests protected by the statute and ... proximate causation.” *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1304-1305 (Fed. Cir. 2020) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 129-134 (2014)); *see also Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 1374-75 (Fed. Cir. 2020) (a plaintiff is entitled to bring a statutory cause of action by demonstrating a real interest in the proceeding and a reasonable belief of damage).

Opposer’s entitlement to a statutory cause of action has been established by Applicant’s stipulation. *Kemi Organics, LLC v. Gupta*, Can. No. 92065613, 2018 TTAB LEXIS 149, at *9 (TTAB 2018).

IV. Priority

To establish priority on a likelihood of confusion claim, a party must prove that, vis-à-vis the other party, it owns a mark or trade name previously used in the United States and not abandoned. Trademark Act Section 2(d), 15 U.S.C. § 1052(d).

Opposer has alleged ownership of four registrations for THE LIP BAR (stylized and standard characters) and variant (TBL THE LIP BAR), and Applicant has not counterclaimed to cancel these pleaded registrations.

Applicant stipulated to Opposer's ownership of these registrations and that they are valid and subsisting. Therefore, Opposer's priority has been established by stipulation as to these marks and their identified goods or services. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1402 (CCPA 1974).

V. Likelihood of Confusion

Our determination under Trademark Act Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (setting forth factors to be considered, referred to as "*DuPont* factors").

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.").

We discuss the *DuPont* factors for which there is relevant argument and evidence.⁸ *See In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019); *see also Herbko Int'l*

⁸ Applicant's motion was solely directed to the first *DuPont* factor, while Opposer's motion addressed the first, fifth and sixth *DuPont* factors. 6 TTABVUE and 10 TTABVUE.

v. Kappa Books, Inc., 308 F.3d 1156, 1164 (Fed. Cir. 2002) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods [or services].’”).

We focus our analysis on the registered standard character mark THE LIP BAR for goods (Registration No. 5579335) because this mark is closest to Applicant’s LIP TAR mark.⁹ See *Sock It To Me, Inc. v. Fan*, Opp. No. 91230554, 2020 TTAB LEXIS 201, at *20-21 (TTAB 2020) (confining Section 2(d) analysis to most similar pleaded mark); *In re Max Cap. Grp. Ltd.*, Ser. No. 77186166, 2010 TTAB LEXIS 1, at *5 (TTAB 2010) (same). If we find a likelihood of confusion as to THE LIP BAR mark for goods, we need not find it as to the other pleaded registrations; conversely, if we do not find a likelihood of confusion as to these marks, we would not find it as to the other pleaded registrations either. *Sock It To Me*, 2020 TTAB LEXIS 201, at *21.

A. Similarity or Dissimilarity of the Goods

Under the second *DuPont* factor we consider the “similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *Dupont*, 476 F.2d at 1361.

Applicant has stipulated that “the products recited in its application are identical,

⁹ We note that the stipulations Applicant provided go to all of the pleaded marks. Applicant focuses its argument on the standard character THE LIP BAR mark (Reg. No. 5579335) as well because it states that the “lip gloss” goods identified in its involved application are identical to the “lip gloss” goods in this pleaded registration. 6 TTABVUE 6-7.

similar, and/or strongly related to the products/services” identified in Opposer’s pleaded registrations. 6 TTABVUE 3. Thus, Applicant’s stipulation establishes that the goods are identical or related.

This *DuPont* factor weighs in favor of likelihood of confusion. *Leb. Seaboard Corp. v. R & R Turf Supply*, Opp. No. 91197241, 2012 TTAB LEXIS 29, at *1 (TTAB) (relying on parties’ stipulation for *DuPont* factor 2).

B. Similarity or Dissimilarity of Trade Channels, Consumers and Conditions of Sale

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

Applicant stipulated that for the identified goods in the application and the identified goods and services in the pleaded registrations, the channels of trade “could be identical.” 6 TTABVUE 4.

Applicant also stipulated that the identified goods in the involved application and the goods and services in the pleaded registrations could be:

- advertised “via the same means and methods”
- “sold in the same physical and online outlets”
- “offered/sold throughout the United States”
- “used by individuals throughout the United States”
- “used by the same types and classes of consumers”
- “sold to the same types and classes of consumers.”

Id.

Thus, the similarity of the channels of trade and classes of consumers has been established by Applicant's stipulation.

Applicant also stipulates that the parties' identified products and services "are relatively inexpensive and could be sold at the same price points," "the consumers who would purchase/use the parties' products and services are of ordinary sophistication and intellect," and "would only exercise ordinary care in selecting and purchasing the identified products and services." *Id.*

Thus, the conditions of sale and buyers to whom the goods and services are directed has been established by Applicant's stipulation.

In view of these stipulations, we find the third and fourth *DuPont* factors weigh in favor of likelihood of confusion.

C. Strength of the Mark

Opposer argues that its marks are "conceptually and commercially strong" and famous. 10 TTABVUE 16, 21.

We consider the strength of Opposer's THE LIP BAR mark under the fifth and sixth *DuPont* factors in order to evaluate the scope of protection to which Opposer is entitled. *DuPont*, 476 F.2d at 1361. *See Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1362 (Fed. Cir. 2023) ("Two of the *DuPont* factors (the fifth and sixth) consider strength."). The fifth *DuPont* factor enables Opposer to prove that its pleaded mark is entitled to an expanded scope of protection by adducing evidence of "[t]he 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 “[t]he number and nature of similar marks in use on similar goods.” *DuPont*, 476 F.2d at 1361.

In determining the strength of a mark, we consider both its inherent strength, based on the nature of the mark itself, and if there is probative evidence in the record, its commercial strength or fame, based on marketplace recognition of the mark. *See In re Chippendales USA Inc.*, 622 F.3d 1346, 1353-54 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength ... and its marketplace strength”); *Top Tobacco, L.P. v. North Atl. Operating Co., Inc.*, Opp. No. 91157248, 2011 TTAB LEXIS 367, at *25 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength). We also consider, if there is evidence in the record, whether the mark has commercial weakness in the marketplace. *DuPont*, 476 F.2d at 1361.

a. Conceptual Strength

As to conceptual strength, we evaluate the intrinsic nature of Opposer’s THE LIP BAR mark, that is, where it lies “along the generic-descriptive-suggestive-arbitrary (or fanciful) continuum of words.” *In re Davia*, Ser. No. 85497617, 2014 TTAB LEXIS 214, at *11 (TTAB 2014); *see also Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210-211 (2000) (“[W]ord marks that are [arbitrary, fanciful, or suggestive] are held to be inherently distinctive.”). “Marks that are descriptive or highly suggestive are entitled to a narrower scope of protection, i.e., are less likely to generate confusion over source identification, than their more fanciful counterparts.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339 (Fed. Cir. 2015).

Opposer's mark THE LIP BAR, taken as a whole, is inherently distinctive, although its strength is somewhat limited by its disclaimer of LIP which is descriptive or generic for cosmetics for the lips such as lip gloss or lipstick. We presume the mark THE LIP BAR is inherently distinctive—at least suggestive—because it is registered on the Principal Register. Trademark Act Section 7(b), 15 U.S.C. § 1057(b); *Sock It to Me*, 2020 TTAB LEXIS 201, at *30-31. But the registration's disclaimer of "LIP" tacitly admits that the word LIP is not inherently distinctive. *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, Can. No. 92050879, 2013 TTAB LEXIS 347, at *40 (TTAB 2013), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014).

There is no third-party registration evidence in the record as to Opposer's mark as a whole or its component terms to demonstrate weakness in the industry. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, Opp. No. 91173963, 2016 TTAB LEXIS 151, at *34 (TTAB 2016) ("even where the record lacks proof of the extent of third-party use, this evidence still may show that a term carries a highly suggestive connotation in the industry and, therefore, may be considered weak"). As Opposer points out, the expired LIP TAR registration¹⁰ submitted by Applicant is not probative under the sixth *DuPont* factor. 10 TTABVUE 21.

We find that Opposer's mark, although inherently distinctive, has some conceptual weakness in view of the disclaimed term LIP.

¹⁰ Submitted as an electronic copy from USPTO's Trademark Status and Document Retrieval (TSDR) database. 6 TTABVUE 14-17.

b. Commercial weakness

There is no third-party use evidence in the record “to show that [THE LIP BAR] mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005).

c. Commercial Strength or Fame

“Fame for purposes of likelihood of confusion is a matter of degree that ‘varies along a spectrum from very strong to very weak.’” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1367 (Fed. Cir. 2012) (citations omitted). Fame or commercial strength for likelihood of confusion purposes may be measured indirectly by, for example, “the volume of sales and advertising expenditures of the goods sold under the mark” “and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the products identified by the marks; and the general reputation of the products and services.” *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, Opp. No. 91199352, 2014 TTAB LEXIS 2, at *18-19 (TTAB 2014). *See also Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002) (recognizing indirect evidence as appropriate proof of strength). Because fame plays a dominant role in the likelihood of confusion analysis and famous marks are entitled to a wide scope of protection, a plaintiff is obligated to clearly prove the fame of its mark. *Coach Servs.*, 668 F.3d at 1367 (holding that it is opposer’s burden to prove fame of its mark). Fame or commercial strength for likelihood of confusion purposes arises as long as a “significant portion of the relevant consuming public ... recognizes the mark as a source indicator.” *Palm Bay Imps.*, 396

F.3d at 1375.

Opposer has provided no testimony as to length of use, the volume of sales, or advertising expenditures in connection with its goods and services. Applicant notes this in its reply (“none of the facts and figures are properly of evidence”) and objects to the Board’s consideration of this information because it was offered without supporting testimony. 11 TTABVUE 3. The length of use, volume of sales/units sold (provided confidentially), the outlets where the goods are offered (and the number of outlets), among other information, were provided as part of attorney statement or argument in Opposer’s brief. “Attorney argument is not evidence.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1371 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005)).

Opposer otherwise relies on internet website articles, YouTube pages, social media printouts, and its website showing its product offerings for its showing of commercial strength or fame.

Opposer provided website printouts for national retailers Target, Walmart and CVS as well as regional retailer Meijer. NOR, 8 TTABVUE 180-204. While this evidence cannot go to the truth of the matter, this evidence shows on its face that the relevant public may have been exposed to Opposer’s brand by a search of the websites for the goods Opposer offers at these retail stores.

Opposer provided a number of articles relating to Opposer’s Shark Tank appearance. NOR, 8 TTABVUE 9-16. Most of these articles are episode recaps where Opposer is listed as one of many companies making a pitch. Additionally, these

articles are more directed to viewers of Shark Tank which may or may not include the relevant market; many appear to be obscure blogs where the readership is unknown.

Opposer also provided YouTube screen shots of Opposer's principal's appearance on segments on three talk shows (Bethany as Bethany in Your Business, College Edition (March 19, 2014), The Real (May 13, 2020) and The Drew Barrymore Show (November 18, 2020). NOR, 8 TTABVUE 17-20. This evidence also shows on its face national exposure of Opposer's products on television, although the amount of audience reach for these shows is not available. One of these appearances is from 2014, more than 10 years ago.

Opposer provided social media pages from its TikTok, Facebook, Instagram, and YouTube accounts, also unaccompanied by testimony. To the extent that these social media page printouts bear figures that would purport to show the exposure of these pages to the public, these figures are hearsay and do not establish the truth of the matter.¹¹ NOR, 8 TTABVUE 206-220. Opposer also provided pages from its website but there is no testimony about consumer exposure to the website. Without such testimony, we cannot determine whether consumers are aware of Opposer's website and the extent of exposure, if any, to consumers.

Opposer also relies on third-party media mentions for commercial strength. Six of the articles are not of a resolution that allows the text to be readable, even when

¹¹ In any event, the Facebook, Instagram and TikTok accounts on their face do not indicate broad exposure to the relevant public, listing between 43,000 and 90,500 followers; the YouTube account images do not show on their face any subscriber or video view figures.

enlarged, and the dates are not viewable. 8 TTABVUE 27, 40, 46, 47, 52, 63. We have considered the readable portions of these articles (which is mainly the title). Some of the sources appear to be national publications (Ebony and WWD) but there also are more obscure blogs or websites (BlackEnterprise, The Odyssey Online, Freep.com, The Monroe Misfit, and The Zoe Report) for which we do not know the extent of public exposure or reach. Two legible articles (Marie Claire and Vogue) are undated, and the Marie Claire article mentions Opposer's lipstick product along with other beauty products. NOR, 8 TTABVUE 83-86, 88-111. Four of the articles (Elle (2020), Cosmopolitan (2021), Wallstreet Journal (2021), and People (2022)) mention Opposer's lipstick in connection with other lipstick brands; these types of articles would have less impact on the consumer as Opposer's brand is one of many lipstick brands discussed. NOR, 8 TTABVUE 65-74, 114-164.

The remaining articles are mostly from publications national in scope: one article from February 2022 (Essence), one article from September 2020, (Allure; this article also appears to have been picked up by news aggregator Yahoo.com¹²), two articles from 2018 (Forbes and CNBC), one article from 2017 (Black Enterprise), and one article from 2016 (The Detroit News).

d. Conclusion as to Strength

Opposer's mark, although inherently distinctive for the identified goods, has some conceptual weakness due to the disclaimer of LIP. There is no third-party use evidence to contract the scope of protection to which Opposer's mark is entitled.

¹² The Yahoo.com article appears to be a complete republication of the Allure article.

As to commercial strength, we find that Opposer's evidence, taken as a whole, does indicate some commercial success but does not establish fame. We lack testimony regarding length of use, advertising information, Opposer's social media and website analytics, and sales. The media mentions and television exposure are limited in frequency and time, with some examples from obscure publications (as well as being illegible), and some media mentions listing Opposer's goods as one of many lipstick products, which also is less probative.

In view of the foregoing, we find Opposer's mark is entitled to a normal scope of protection of an inherently distinctive mark. The fifth and sixth *DuPont* factors are neutral.

D. Similarity or Dissimilarity of the Marks

We compare Applicant's LIP TAR mark to Opposer's THE LIP BAR mark for similarities or dissimilarities in appearance, sound, connotation and commercial impression. *See Palm Bay Imps.*, 396 F.3d at 1371.

Similarity in any one of these factors is sufficient to support a determination of likelihood of confusion. *See Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 731 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion."); *In re White Swan Ltd.*, Ser. No. 91617169, 1988 TTAB LEXIS 37, at *3 (TTAB 1988) ("In appropriate cases, a finding of similarity as to any one factor (sight, sound or meaning) alone 'may be sufficient to support a holding that the marks are confusingly similar.'") (citations omitted).

The similarity or dissimilarity of the marks is determined based on the marks in their entireties; the analysis cannot be predicated on dissecting the marks into their

various components. *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). On the other hand, different features may be analyzed to determine whether the marks are similar. *Id.* (there is nothing improper in giving more or less weight to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Inter IKEA Sys. B.V. v. Akea, LLC*, Opp. No. 91196527, 2014 TTAB LEXIS 166, at *17 (TTAB 2014); *Sealed Air Corp. v. Scott Paper Co.*, Opp. No. 91055167, 1975 TTAB LEXIS 236, at *6 (TTAB 1975).

The test, under the first *DuPont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather, whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. *Coach Servs.*, 668 F.3d at 1368 (quoting *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, Opp. No. 91160856, 2007 TTAB LEXIS 35, at * 14 (TTAB 2007)).

Applicant's mark is LIP TAR and Opposer's mark is THE LIP BAR.

Both marks are in standard characters and can be displayed in any font style, size and color. Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a); *In re Viterra Inc.*, 671 F.3d 1358, 1363 (Fed. Cir. 2012).

As to the term THE in Opposer's mark, the definite article "the" has no trademark significance. *See, e.g., In re Thor Tech, Inc.*, Ser. No. 78634024, 2009 TTAB LEXIS

253, at *3 (TTAB 2009). Both parties' marks disclaim the term LIP, making BAR in Opposer's mark and TAR in Applicant's mark the dominant portion. *See In re Allegiance Staffing*, Ser. No. 85663950, 2015 TTAB LEXIS 180, at *11 (TTAB 2015) ("Because descriptive words have little source-indicating significance, it is appropriate that we give less weight ... simply put, the presence of this word in Applicant's mark is not sufficient to distinguish the marks"); *see also In re Code Consultants*, Ser. No. 75645560, 2001 TTAB LEXIS 685, at *12 (TTAB 2001) (disclaimed matter is often "less significant in creating the mark's commercial impression").

The marks are similar visually, with both marks containing the term LIP, with the dominant portion of each mark differing by one letter, BAR/TAR. The marks also sound similar because although Opposer's mark includes THE, both marks contain the descriptive if not generic term LIP followed by a three-letter word with a similar "AR" construction—BAR/TAR. "Applicant concedes that its LIP TAR mark is somewhat similar to Opposer's THE LIP BAR mark in terms of appearance and sound" and agrees that THE in Opposer's mark has no trademark significance "and would probably be overlooked by consumers." 6 TTABVUE 7.

Although the dominant terms BAR and TAR in the parties' marks differ by their first letter, marks with different letters at the first part of each mark have nonetheless been found confusingly similar. *See Krim-Ko*, 390 F.2d at 732 ("There is virtually no distinction in sound or visual impression between the words" BEEP and VEEP); *Am. Cyanamid Co. v. United States Rubber Co.*, 356 F.2d 1008, 1009 (CCPA

1966) (CYGON and PHYGON similar in spelling and sound); *Inter IKEA Sys.*, 2014 TTAB LEXIS 166, at *20 (AKEA is similar to IKEA); *Interlego AG v. Abrams/Gentile Entm't, Inc.* Opp. No. 91103612, 2002 TTAB LEXIS 200, at *3 (TTAB 2002) (MEGO and LEGO similar, differing by one letter; “many adults would not notice this very minor difference in the two marks.”); *Apple Comput. v. TVnet.net Inc.*, Opp. No. 91168875, 2007 TTAB LEXIS 80, at *10 (TTAB 2007) (letter “v” is insufficient to distinguish the dominant portions of the parties’ ITUNES and VTUNES marks).

Although acknowledging the similarity in appearance and sound, Applicant argues that there is a difference in connotation and commercial impression which avoids confusion. 6 TTABVUE 7. Applicant submits that Opposer’s mark connotes that it is sold in bar form or is manufactured or sold by a retail store called “The Lip Bar.” *Id.* at 8. Applicant argues that THE LIP BAR is distinct in meaning from LIP TAR because “tar’ in Applicant’s mark “suggests to consumers that its lip gloss is a viscous and durable substance that fully covers and sticks to one’s lips.” *Id.* Applicant argues that

Applicant’s lip gloss will desirably remain on one’s lips for an extended period of time due to its thick and tacky nature. The word ‘tar’ refers to ‘a thick, black, sticky substance that is used especially for making roads’ or ‘a substance in some respects resembling tar.’¹³

Id.

With respect to meaning, we recognize that the words BAR and TAR added to THE LIP or LIP gives each mark a somewhat different connotation.

¹³ Applicant submitted dictionary definitions for “tar.” MERRIAM-WEBSTER DICTIONARY and COLLINS COBUILD ADVANCED LEARNERS DICTIONARY. 6 TTABVUE 12-13.

Nonetheless, we find that when considered in their entirety, the similarities in sound and appearance outweigh the differences in meaning resulting from the words BAR/TAR, or the addition of THE in Opposer's mark, particularly because "the average customer ... retains a general rather than specific impression of marks." *In re i.am.symbolic, llc*, Ser. No. 85916778, 2018 TTAB LEXIS 281, at * 11 (TTAB 2018) (citations omitted). *See e.g., In re Microsoft Corp.*, Ser. No. 78013678, 2003 TTAB LEXIS 442, at *14 (TTAB 2003) (OFFICENET and OFFICE.NET are similar in sound and appearance and these similarities outweigh possible differences in connotation); *Breon Lab'y. Inc. v. Vargas*, 1971 TTAB LEXIS 132, at *13 (TTAB 1971)¹⁴ (BRONCO-FEDRIN and BRONKEPHRINE considered confusingly similar, because even though they may possess different suggestive connotations, they are not unlike in appearance and susceptible of a strikingly similar pronunciation).

We find the parties' marks are similar. The first *DuPont* factor weighs in favor of likelihood of confusion.

E. Co-Existence of Expired Third-Party LIP TAR Registration

Under *DuPont* factor thirteen, we consider "any other established fact probative of the effect of use." *DuPont*, 476 F.2d at 1361.

Applicant points out that Opposer's mark previously co-existed with a LIP TAR mark on the trademark register and that Opposer was not harmed by its co-existence.¹⁵ 6 TTABVUE 9; 11 TTABVUE 4.

¹⁴ Proceeding number unavailable.

¹⁵ Applicant attached a TSDR printout which reflects a different owner than Applicant for the LIP TAR mark for lip gloss, expired May 21, 2021 (10 years). 6 TTABVUE 15-17. We further note that the underlying application for that now-expired registration was filed on

In making this argument, Applicant acknowledges that expired registrations have no probative value, and that the Board is not bound by prior examining attorney decisions. 6 TTABVUE 9. However, Applicant submits that consistency and predictability in examination should be considered. 6 TTABVUE 9. Applicant argues that if the marks co-existed in the past they should be able to co-exist now. 11 TTABVUE 4.

As Applicant acknowledges, an expired registration has no probative value. The LIP TAR registration owned by a third-party is now cancelled and presently there are no co-existing LIP TAR registrations. The fact that Opposer's THE LIP BAR mark co-existed on the trademark register with another LIP TAR mark does not prove that they coexisted during that time without confusion in the marketplace.¹⁶

We find the thirteenth *DuPont* factor neutral.

VI. Conclusion

The similarity of the marks, the goods, the trade channels, the classes of consumers, and conditions of sale all favor likelihood of confusion. The strength of the mark is neutral as is any other established fact probative of the effect of use. *In re Charger Ventures LLC*, 64 F.4th 1375, 1381 (Fed. Cir. 2023). We find confusion likely based on Opposer's pleaded Registration No. 5579335.

May 18, 2009 and issued on October 5, 2010 (*id.* at 15), well before Opposer filed the underlying applications to its pleaded registrations, and before the earliest claimed first use date in any of Opposer's pleaded registrations.

¹⁶ There was no inconsistency in examination here because Applicant's mark was approved for publication but opposed during the opposition period.

Opposition No. 91289231

Decision:

The opposition is sustained under Section 2(d).