

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Hearing:
September 20, 2005

Mailed:
January 20, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re GoSMILE, INC.

Serial No. 76518244

H. Jay Spiegel of H. Jay Spiegel & Associates for GoSMILE,
INC.

Henry S. Zak, Trademark Examining Attorney, Law Office 108
(Andrew Lawrence, Managing Attorney)

Before Hairston, Walters and Walsh, Administrative
Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On May 29, 2003, GoSMILE, INC. (applicant) filed an
intent-to-use application to register GOSMILE PM in
standard-character form on the Principal Register for goods
identified as "toothpaste marketed and sold in high end
retail department stores as well as in spas, salons,
resorts, doctors' offices, dentists' offices, and high end
hotels" in International Class 3. Applicant disclaimed

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"PM" in response to the examining attorney's requirement to do so.¹

The examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with Reg. No. 2574192 on the Principal Register for the mark P.M. in standard-character form for goods identified as "toothpaste and tooth gel" in International Class 3. The registration claims both first use anywhere and first use in commerce in September 1999. The registration issued on May 28, 2002, and is currently active.

Applicant responded to the refusal; the examining attorney made the refusal final; and applicant filed this appeal. The Board held an oral hearing in the case at applicant's request on September 20, 2005. We affirm.

Section 2(d) of the Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion . . ." Id. To determine whether there is a likelihood of confusion, we must

¹ Applicant also claimed ownership of Reg. No. 2566285 for GOSMILE for "tooth whitening system comprised of peroxide gels" which was assigned to applicant in a document recorded at Reel 2892, Frame 0509.

consider all evidence of record bearing on the factors delineated in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977). Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the goods of the applicant and registrant. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The Goods and Channels of Trade

Applicant does not argue that its goods differ from those of the registrant. Both the application and registration include "toothpaste." On that basis alone we conclude that the goods are, at least in part, identical. The registration also includes "tooth gel" which is not only closely related but functionally identical to applicant's goods.

Applicant also acknowledges explicitly that the trade-channels limitations set forth in its application fail to distinguish applicant's trade channels from those of the registrant because the registration does not specify any trade-channel limitations. Applicant states, ". . . as a matter of law, the Board must assume that the goods in the registration move in all channels of trade that would be normal for such goods and that the goods would be purchased by all potential purchasers for such goods. In re Elbaum,

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211 USPQ 639, 640 (TTAB 1981).” See CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991). The unrestricted trade channels for the “toothpaste and tooth gel” identified in the registration logically encompass the more specific trade channels set forth in the application. Therefore, we also conclude that the channels of trade for the goods of applicant and registrant are identical, at least in part.

In fact, applicant argues that the only du Pont factor we must consider is the similarity of the marks stating, “. . . in one respect Applicant and the Examining Attorney are in agreement - DuPont factor no. 1 [similarity of the marks] is dispositive of the issue of likelihood of confusion.” However, before moving to the discussion of the marks, we emphasize the importance of our conclusion that the goods and channels of trade for applicant and registrant are identical, as the examining attorney did. The conclusion is critically important in its own right and in our consideration of the marks. The Court of Appeals for the Federal Circuit has observed that the degree of similarity between the marks necessary to support the conclusion of likely confusion declines when the goods are identical. Century 21 Real Estate Corp. v. Century Life of

America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), cert. denied, 506 U.S. 1034 (1992).

The Marks

To determine whether the marks are confusingly similar, we must consider the appearance, sound, connotation and commercial impression of each mark. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Applicant summarizes its argument regarding the marks, as follows:

- (1) The dominant feature of Applicant's mark is GOSMILE;
- (2) The feature in common between the two marks in question has been disclaimed in the Appellant's mark as descriptive. "P.M." is an extremely weak mark;
- (3) The first portion of a composite mark is often that which catches the consumer's eye;
- (4) While the Board considers the mark as a whole in determining the issue of likelihood of confusion, the Board is permitted to give greater weight to the dominant portion of a mark in likelihood of confusion analysis.

The essence of the examining attorney's argument is, as follows, ". . . the addition of the applicant's house mark to two otherwise identical marks will not obviate likelihood of confusion under the provisions of Section 2(d) of the Trademark Act. Furthermore, the addition of GOSMILE does not substantially alter the meaning or

commercial impression of the letters PM shared in each mark."

We begin by discussing the "meaning or commercial impression of the letters PM." As indicated above, the examining attorney required applicant to disclaim "PM" and applicant complied. In its brief applicant quotes from the examining attorney's explanation of the requirement to disclaim "PM": "The wording is merely descriptive because it identifies the period of use of the toothpaste - in the evening and afternoon hours or in the PM." Applicant then concludes, "Thus, the descriptive subject matter 'PM' has been disclaimed by the Appellant." Later in the brief applicant states further, "There is no finding in this appeal that Church & Dwight's [registrant] mark P.M. has acquired secondary meaning. . . . there is no evidence that the mark has been used substantially exclusively and continuously in commerce, for at least five years, as required by the Lanham Act for a showing of acquired distinctiveness."

These arguments serve as the foundation for applicant's core argument that the cited mark, "P.M.," is weak. However, applicant has neither offered evidence indicating that PM is merely descriptive for toothpaste or tooth gel, nor has applicant offered any explanation of its

own as to why PM would be perceived as merely descriptive of these goods. Instead applicant relies on the explanation in the office action. While the examining attorney offered an explanation for the disclaimer requirement, he did not offer any evidence to support the requirement. Accordingly, there is no evidence of record indicating that PM is merely descriptive of toothpaste or tooth gel. In the absence of such evidence there is no basis to conclude that the examining attorney's "explanation" accurately reflects the consumer perception of PM in connection with toothpaste or tooth gel.

Furthermore, contrary to applicant's argument, the mere fact that the examining attorney required a disclaimer and applicant provided one by no means establishes that PM is merely descriptive for toothpaste and tooth gel. As the Court of Appeals for the Federal Circuit cautioned,

The technicality of a disclaimer in National's application has no legal effect on the issue of likelihood of confusion. The public is unaware of what words have been disclaimed during the prosecution of the trademark application at the PTO. It appears that National voluntarily disclaimed these words, as a tactical strategy, believing it would assist in avoiding a holding of likelihood of confusion with the cited mark. However, such action cannot affect the scope of protection to which another's mark is entitled.

In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). This caution is particularly compelling

in a case such as this where there is no evidence that the disclaimed term is merely descriptive of the goods in question. Id. at 752. Cf. In re Dixie Restaurants, Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997).

More importantly, the cited registration for the mark P.M. by itself in standard-character form is on the Principal Register. As such the registered mark, P.M., must be accorded all of the presumptions under Trademark Act Section 7(b), 15 U.S.C. § 1057(b), including the presumption of its validity and of the registrant's exclusive right to use the registered mark. Id. Applicant's arguments that the mark is merely descriptive is an impermissible collateral attack on the validity of the cited registration. In re Dixie Restaurants, Inc., 41 USPQ2d at 1534. Likewise, applicant's argument that the registrant should be required to show acquired distinctiveness is misplaced. That suggestion too implies that the cited registration is not valid. Therefore, we reject applicant's argument that "P.M." is merely descriptive, and therefore, weak.

Applicant also attempted to establish that "P.M." is weak through the use of Patent and Trademark Office ("PTO") records. With its appeal brief applicant for the first time provided a list of PTO applications and registrations

for marks which included "PM" with "PM" disclaimed. The examining attorney objected to this evidence in his brief and otherwise did not treat it as being of record. In response to the objection, applicant provided certified copies of certain of these records. We reject this evidence as untimely and have not considered it.² Trademark Rule 2.142(d) requires that evidence be submitted before appeal. See also In re Psygnosis Ltd., 51 USPQ2d 1594, 1596 (TTAB 1999). Applicant could have submitted the evidence in its response to the initial refusal or with a request for reconsideration after the final refusal but failed to do so.³ Again, we conclude on this record that the mark in the cited registration is neither merely descriptive, nor highly suggestive, nor otherwise weak, but distinctive as applied to toothpaste and tooth gel.

² Applicant's submission of new evidence with its brief was both late and not in proper form. The subsequent submission of certified copies of PTO records addresses the form issue but does not and cannot cure the lateness issue.

³ Even though we reject the evidence as untimely we also note that, even if we had considered it, we would reach the same conclusions here. Many of the records relate to pending applications and would not be considered in any event. Glamorene Prods. Corp. v. Earl Grissmer Co., Inc., 203 USPQ 1090, 1092 n. 5 (TTAB 1979). Furthermore, none of the registrations submitted cover toothpaste or tooth gel, and consequently, would have little probative value on the strength or weakness of PM as applied to these goods.

Next we must consider whether the addition of GOSMILE is sufficient to distinguish applicant's mark from the registered mark. First, we note the examining attorney's characterization of GOSMILE as a house mark or trade name. Applicant has, in effect, acknowledged the accuracy of this characterization. Applicant is identified as GoSMILE, Inc. in this application, and applicant refers to "GOSMILE" as a "version of its house mark" in its brief. There is no actual evidence of record to show use of GOSMILE as a house mark or trade name. Whether or not GOSMILE is a house mark or trade name begs the question. The fundamental inquiry is whether the full mark GOSMILE PM would be perceived as identifying a different source than P.M. when used on the same goods, or whether it is likely to cause confusion with the registered P.M. mark.

GOSMILE and PM are not combined in a manner which in any way alters the impression of PM alone. Stated otherwise, in the case of applicant's mark the whole is no more than the sum of its parts. Consequently, the commercial impression applicant's mark projects is that of a combination of two elements which are distinct and each of which is distinctive. Therefore, we agree with the examining attorney that applicant's mark, consisting of GOSMILE combined with the cited registered mark in its

entirety, is likely to cause confusion.⁴ Saks & Co. v. TFM Indus. Inc., 5 USPQ2d 1762, 1764 (TTAB 1987); In re Christian Dior, S.A., 225 USPQ 533, 534 (TTAB 1985); Key West Fragrance & Cosmetic Factory, Inc. v. The Mennen Co., 216 USPQ 168, 170 (TTAB 1982); In re Cosvetic Laboratories, Inc., 202 USPQ 842, 845 (TTAB 1979). In fact, whether or not GOSMILE is characterized as a house mark, the combination of GOSMILE with PM here, as is often true with combinations of house marks with other marks, may aggravate rather than diminish the likelihood of confusion. See, e.g., In re Christian Dior, S.A., 225 USPQ at 534.

Contrary to applicant's argument, consumers are just as likely and perhaps even more likely to view GOSMILE PM as identifying another product from the owner of the P.M. mark as they are to view it as a new product from the owner of the GOSMILE mark.

Furthermore, the impact of applicant's GOSMILE mark combined with the registered mark on the commercial impression is such that the placement of GOSMILE first in applicant's mark in no way diminishes the likelihood of

⁴ We recognize that the registered mark is P.M. and that applicant's mark is PM, without periods. For purposes of evaluating likelihood of confusion, this is an inconsequential difference because consumers typically retain a general rather than a specific impression of trademarks. Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975).

confusion. Cf. Presto Prods. Inc. v. Nice-Pak Prods. Inc., 9 USPQ2d 1895 (TTAB 1988).

There are, of course, differences between the marks in appearance and sound. However, the similarities in appearance, sound, connotation, and particularly the similarity in commercial impression, resulting from the addition of GOSMILE to the registered P.M. mark override those differences.⁵ Saks & Co. v. TFM Indus. Inc., 5 USPQ2d at 1764. Whether PM is the dominant element in applicant's mark is not the ultimate question. The ultimate question is whether the combination of GOSMILE with PM alters the registered mark in a way which will avoid confusion. We conclude that it will not. Therefore, we conclude further that the marks, when viewed in their entireties, are similar.

Lastly, applicant has gone to great lengths to discuss and distinguish cases cited by the examining attorney. Suffice it to say that we have considered this discussion carefully and found it unpersuasive. In the end we must decide each likelihood-of-confusion case on its unique

⁵ In determining whether marks create similar or distinct commercial impressions, any doubt must be resolved in favor of registrant. Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983).

facts. See In re Cosvetic Laboratories, Inc., 202 USPQ at 843-44 and cases cited therein.

Conclusion

After considering all of applicant's arguments and evidence bearing on the du Pont factors, we conclude, on this record, that there is a likelihood of confusion between applicant's mark and the cited registered mark. We conclude so principally: (1) because the goods and channels of trade for the goods of applicant and registrant are, at least in part, identical, and (2) because the cited mark consists of the distinctive letters P.M. alone and applicant's mark consists of GOSMILE PM, a combination which fails to distinguish applicant's mark from the cited P.M. mark. Finally, to the extent that any of applicant's arguments raise any doubt regarding likelihood of confusion we note that any doubt on this issue must be resolved in favor of the prior registrant. In re Hyper Shoppes (Ohio) Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Decision: The refusal to register applicant's mark under Section 2(d) of the Act is affirmed.