

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Mailed:
July 7, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bare Escentuals, Inc.

Serial No. 76527476

Michelle J. Hirth of Sheppard, Mullin, Richter & Hampton
LLP for Bare Escentuals, Inc.

Lesley LaMothe, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Seeherman, Rogers and Kuhlke, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Bare Escentuals, Inc. has appealed from the final
refusal of the Trademark Examining Attorney to register
WEARABLE LIP, with the word WEARABLE disclaimed, for
"cosmetics, namely, lipsticks and non-medicated lipbalms."¹
Registration has been refused pursuant to Section 2(d) of

¹ Application Serial No. 76527476, filed July 3, 2003, based on
Section 1(b) of the Trademark Act (intent-to-use).

the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark WEARABLE TREATMENT, with TREATMENT disclaimed, registered on the Supplemental Register for "lipstick, non-medicated lip balms, cosmetic creams and exfoliants for hair and skin, skin lotions and skin gels,"² that, if used on applicant's identified goods, it is likely to cause confusion or mistake or to deceive.³

Applicant and the Examining Attorney have filed appeal briefs. Applicant did not request an oral hearing.

We must first address some procedural points. In its request for reconsideration, applicant argued that there were sufficient differences in the marks and in the marketing of the involved goods to make confusion unlikely, but offered, in the alternative, to amend its application to reflect the trade channels through which its goods are offered, i.e., "for distribution only directly from Applicant, in Applicant's retail stores, by certain vendors that provide interactive retail services via computer, cable and satellite television and the Internet, by certain vendors that provide computerized on-line retail stores,

² Registration No. 2593254, issued July 9, 2002.

³ The Examining Attorney had previously also refused registration on the ground that applicant's mark was merely descriptive, but subsequently withdrew that refusal and instead required applicant to submit a disclaimer of WEARABLE. Applicant submitted the disclaimer with its request for reconsideration of the final refusal.

and through selected beauty and skin care salons." In denying the request for reconsideration, the Examining Attorney stated that such a restriction would not obviate the likelihood of confusion, and therefore did not enter it into the record.

In the last section of its appeal brief, applicant has stated that "in the event that the Board determines that Applicant's mark and the Cited Mark are confusingly similar, Applicant requests that the identification of goods in its Application be amended to limit the channels through which Applicant's goods are marketed and thereby obviate any potential likelihood of confusion." The proposed identification is the same as that offered in the request for reconsideration. Applicant is advised that once the Board renders a decision on appeal, the application may not be reopened (except on order by the Commissioner, or to enter a disclaimer). See Trademark Rule 2.142(g). Therefore, applicant may not, in a single application, obtain a decision from the Board on the issue of likelihood of confusion based on its current identification and then, if that decision is unfavorable, have the Examining Attorney and ultimately the Board decide the same issue of likelihood of confusion with respect to a more limited identification. If applicant had wished the

Board to consider the registrability of its mark with its identification limited as to trade channels, it should have amended its application accordingly during the course of the prosecution of the application, and not as part of its appeal brief.⁴ Accordingly, the issue of likelihood of confusion will be decided on the basis of the original (and operative) identification of goods: cosmetics, namely, lipsticks and non-medicated lipbalms.

The second procedural point is an objection made by the Examining Attorney to materials, Exhibits B and C, submitted by applicant with its appeal brief. Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the filing of an appeal. The Examining Attorney's objection is well-taken, and these materials have not been considered.

This brings us to the substantive issue before us in this appeal: likelihood of confusion. Our determination of this issue is based on an analysis of all of the probative facts in evidence that are relevant to the factors set

⁴ For example, after receiving the Examining Attorney's denial of its request for reconsideration, applicant could have requested that its identification be amended, and submitted such request with a request for remand. In that situation, if the Examining Attorney had found the proposed identification acceptable, but still maintained the refusal of registration, the issue of likelihood of confusion would have been briefed based on the new identification of goods, and the Board would have made its determination based on that identification.

forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). Each of these factors may, from case to case, play a dominant role. *du Pont*, 177 USPQ at 567.

In this case, we think the strength of the cited registration, or rather the lack of strength, plays a significant role in our analysis. The cited registration, as noted above, is on the Supplemental Register. Marks that are not registrable on the Principal Register, such as those that are merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act, may be registrable on the Supplemental Register. The registration of WEARABLE TREATMENT on the Supplemental Register, rather than on the Principal Register, indicates that it is a merely descriptive term, and therefore is entitled to a limited scope of protection. See *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 1299, 172 USPQ 361, 363 (CCPA 1972) (an application for Supplemental Registration of a particular term is an admission of descriptiveness).

The level of descriptiveness of a cited mark may influence the conclusion that confusion is likely or unlikely. *In re The Clorox Co.*, 578 F.2d 305, 198 USPQ 337 (CCPA 1978). That is, the descriptiveness of a mark may

result in a more narrow scope of protection. As the Court stated in *Sure-Fit Products Company v. Saltzson Drapery Company*, 254 F.2d 158, 117 USPQ 295, 297, in which no likelihood of confusion was found between SURE-FIT and RITE-FIT for ready-made slip covers:

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. 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. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

When marks are registered on the Supplemental Register because they are descriptive, the scope of protection accorded to them has been consequently narrow, so that likelihood of confusion has normally been found only where the marks and goods are substantially similar. In *re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

With this in mind, we consider the similarity of the marks. The Examining Attorney points to the fact that both marks start with the identical word WEARABLE, and that insofar as this word is concerned, the marks have the same appearance, pronunciation and connotation. She also asserts that the terms LIP and TREATMENT do not distinguish

the marks because they are either highly suggestive or merely descriptive. Applicant, on the other hand, noting that the registrant has disclaimed the word TREATMENT while applicant has disclaimed the word WEARABLE, has argued that WEARABLE is the dominant element of the registrant's mark while LIP is the dominant element of its mark, and that these different dominant elements create different commercial impressions.

We disagree with applicant that LIP is the dominant element of the mark WEARABLE LIP, while WEARABLE is the dominant element of the mark WEARABLE TREATMENT. Although disclaimed material in a mark may have less source-indicating value and therefore be given less weight when marks are compared, in this case consumers are likely to view the marks as a whole and, despite the disclaimers, give equal weight to the various elements. We therefore also disagree with the Examining Attorney that the word WEARABLE which is common to both marks causes the marks to be similar in appearance, pronunciation and connotation.

The word "wearable" in applicant's mark WEARABLE LIP indicates that the lipstick will look good when it is on. Although applicant disclaimed exclusive rights to the word WEARABLE because of the Examining Attorney's position that "the term is routinely used to describe lipstick and makeup

including foundation," the evidence submitted by the Examining Attorney in support of that position (in connection with the later-withdrawn refusal that the mark was merely descriptive) shows that "wearable" has been used to describe shades of lipstick:

The aim is to give skin care benefits in a lipstick—along with long-lasting, very wearable colors....

"WWD," December 19, 2003

The line includes 12 classic, wearable shades of Luxury Lipstick....
"Cosmetics," September 2002

our best selling lipstick! - a sheer wearable rusty red that looks great on EVERYONE!
www.ramybeautytherapy.com

When the word WEARABLE is combined with LIP, the word WEARABLE conveys this meaning referring to the color of the lipstick, and the resulting mark WEARABLE LIP suggests that the lipstick will look good on the wearer, or will go with outfits of different colors. On the other hand, when WEARABLE is used in the mark WEARABLE TREATMENT, it conveys the idea that the treatment is something that can be worn, and the mark as a whole describes a product that has a therapeutic effect when worn.

Thus, not only does the word WEARABLE have a different meaning in the respective marks, but when the marks are

compared as a whole, they convey different connotations and commercial impressions.

Given the limited scope of protection to which the registrant's Supplemental Registration is entitled, we find that the differences in the marks are sufficient to avoid a likelihood of confusion, despite the fact that applicant's goods are identical to two of the goods listed in the cited registration; that the goods are deemed to travel in the same channels of trade; and that goods of this type are purchased by the public at large who will exercise only an ordinary standard of care. See *In re Haddock*, 181 USPQ 796 (TTAB 1974) (no likelihood of confusion between MINI-BASS and LIL' BASS, both for fishing lures).

Decision: The refusal of registration is reversed.