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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Oralabs, Inc.

Serial No. 76569020

John L. Welsh of Welsh & Flaxman LLC for Oralabs, Inc.

William T. Verhosek, Trademark Examining Attorney, Law Office 114  
(K. Margaret Le, Managing Attorney).

Before Hohein, Holtzman and Kuhlke, Administrative Trademark  
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Oralabs, Inc. (applicant)  
to register the mark GENTLE LIPS ("LIPS" disclaimed) for "non-  
medicated lip balm" in International Class 3.<sup>1</sup>

The trademark examining attorney has refused registration  
under Section 2(d) of the Trademark Act on the ground that  
applicant's mark, when applied to applicant's goods, so resembles

<sup>1</sup> Application Serial No. 76569020 was filed on March 14, 2005, based on  
an allegation of a bona fide intention to use the mark in commerce.

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the registered mark GENTLE GEL ("GEL" disclaimed) for "non-medicated lip and gum gel" in International Class 3 as to be likely to cause confusion.<sup>2</sup>

When the refusal was made final, applicant appealed. Briefs have been filed. An oral hearing was not requested.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue, including the similarities of the marks and the similarities of the goods. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We turn first to a consideration of the goods. Applicant argues that the goods are not similar and are not sold in the same channels of trade. Pointing to a page from registrant's website, applicant argues that, unlike applicant's product which is a balm for lips, registrant's product is a gel used by dentists to desensitize the affected area of a patient's mouth after dental surgery, and that the gel, in fact, has nothing to do with lips. Applicant has also submitted the original drawing page from the file of the cited registration showing that registrant's goods were originally identified as "non-medicated gel for use by dental professionals in combination with a dental electro-surgical product." Based on the above evidence,

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<sup>2</sup> Registration No. 2655354, issued December 3, 2002.

applicant concludes that, in contrast to applicant's goods which would be sold to the public at retail stores and used for treating chapped lips, registrant's gel product would be used and sold by professionals, i.e., dentists, and that consumers would not request registrant's goods by name from dentists. Further, according to applicant, while applicant's goods would be considered an impulse purchase, registrant's product would not, because a consumer "does not impulsively run to their dentist and buy products." Brief, p.7.

It is well settled that goods need not be similar or competitive in nature to support a finding of likelihood of confusion. It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Applicant's "non-medicated lip balm" and registrant's "non-medicated lip and gum gel" are very closely related, if not virtually identical, products. We take judicial notice of the definition of "balm" in *The New Oxford American Dictionary* (2<sup>nd</sup> ed. 2005) as meaning, "a fragrant ointment or preparation used to heal or soothe the skin" and from that same dictionary, a

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definition of "gel" as meaning, "a jellylike substance containing a cosmetic, medicinal or other preparation."<sup>3</sup> Registrant itself refers to its lip and gum gel on the website as a "balm" that "soothes...the affected area and helps promote healing...." It is clear that both applicant's and registrant's products are lip care preparations with soothing and healing properties. Thus, the respective goods are very similar products having overlapping, if not interchangeable, functions and purposes.

In addition, the examining attorney has submitted a number of use-based third-party registrations showing, in each instance, that the same mark has been registered for lip balm, on the one hand, and for lip gel, on the other. Although such third-party registrations are not evidence of use of the marks in commerce, the registrations have probative value to the extent that they suggest that the respective goods are of a type which may emanate from the same source. See *In re Albert Trostel & Sons Co.*, supra; and *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988).

These closely related, if not virtually identical, goods are presumed to be marketed through the same channels of trade to the same retail consumers. In this regard, we note that the Internet

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<sup>3</sup> We will not take judicial notice of the dictionary definitions from *encarta.msn.com* and *dictionary.com* attached to the examining attorney's brief because there is no indication that those dictionaries exist in printed form. See *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999).

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printouts submitted by the examining attorney show that lip balms and lip gels are advertised and displayed together on the same websites, often under the same or similar marks. For example, *www.dermadoctor.com* offers "English Ideas Hint of Color SPF 18 Lip Balm" as well as English Ideas Lip solution Hydrating Lip Gel"; and *www.westons.com* offers both "Chapstick Lip Balm" and "Chapstick Lip Gel."

In arguing that the goods are not similar and are not in the same channels of trade, applicant has read impermissible limitations into the application and registration. As our primary reviewing court has often stated, the question of likelihood of confusion is determined on the basis of the identification of goods set forth in the application and registration, rather than on what any extrinsic evidence might show the actual nature or function of the goods or their channels of trade to be. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1464, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783 (Fed. Cir. 1990); and *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

Registrant's product, as described, includes a lip gel. There are no limitations on the function or purpose of registrant's lip gel or the channels of trade for those goods. Nor is there anything inherent in the nature of registrant's

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goods which would limit the channels of trade to dispensing by dentists or other professionals. We must assume that applicant's as well as registrant's lip care products are sold through all normal channels of trade for those goods, including all the usual retail outlets, and that the goods reach all the usual classes of purchasers. In this regard, we note that the purchasers of these products are ordinary members of the general public who, especially considering the inexpensive nature of these products, would not be expected to exercise a high degree of care and thus would be more prone to confusion.

It is clear that these nearly identical lip care products, if offered under similar marks, would be perceived as emanating from the same source.

We turn then to a consideration of the marks. Applicant contends that GENTLE LIPS and GENTLE GEL are different in appearance, arguing that the marks are different in style, length and composition; that applicant's mark is composed of ten letters whereas the registered mark is nine letters; and that the words GEL and LIPS look nothing alike. Applicant further argues that the marks have different tones and inflections; and that while applicant's mark suggests that "gentle lips" can be achieved by use of its product, the mark GENTLE GEL suggests that the product itself is gentle when used.

While marks must be considered in their entirety, it is well settled that "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 consideration of the marks in their entirety." See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). When registrant's mark GENTLE GEL and applicant's mark GENTLE LIPS are compared in their entirety, giving appropriate weight to the features thereof, we find that the marks are similar in sound, appearance, meaning and overall commercial impression, and that the similarities far outweigh their differences.

The shared term, GENTLE, is visually and aurally the most significant portion of both marks. It is the first word in each mark and, moreover, it is the only nondescriptive portion of the marks. See *In re National Data Corp.*, supra at 751 ("That a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark"). See also *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (noting the importance of the first part of a mark as "most likely to be impressed upon the mind of a purchaser and remembered."). The identical first word GENTLE is followed in both marks by short, one-syllable words, LIPS and GEL, having

only one letter difference in length. As a result, the two marks as a whole have a visually similar structure and a similar sound and cadence.

The word GENTLE is also significant in conveying the meaning of the marks and their overall commercial impressions. While the individual words GEL and LIPS have specifically different meanings, when GENTLE LIPS and GENTLE GEL are viewed as a whole and in the context of the goods, the two marks suggest products with similar or at least complementary benefits, i.e., preparations that provide soothing or healing relief to injured lips. Keeping in mind that the comparison of the marks is not made on a side-by-side basis and that recall of purchasers is often hazy and imperfect, it is the overall "gentleness" concept and impression that purchasers are likely to remember when seeing these marks at separate times on virtually identical goods, not the slight difference in meaning.

Applicant argues that the term GENTLE is weak in the cosmetics field and is used "by many others" to describe their cosmetic products. Brief, p. 8. In support of this contention, applicant has submitted six third-party registrations of marks that include the word "GENTLE" for various cosmetic products;<sup>4</sup>

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<sup>4</sup> Applicant submitted printouts of five of these six third-party registrations for the first time with its appeal brief, and the examining attorney has objected to the printouts as untimely. During prosecution, applicant had initially submitted only a list of these registrations. When applicant was advised by the examining attorney in

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and printouts from two third-party websites showing use of the term "Gentle Gel" for cosmetics.<sup>5</sup> The website of *walgreens.com* offers "Almay Moisturizing Gentle Gel Eye Makeup Remover" and an unidentified website offers "Gentle Gel Cleanser," also a makeup remover.

While GENTLE is suggestive of registrant's lip gels, the evidence fails to establish that the term is highly suggestive or weak in relation to these goods.<sup>6</sup> Of the marks in the third-party registrations, one is for completely unrelated goods (Registration No. 2830135 for "dental bleaching gel"); at least one other mark conveys a completely different commercial impression than the marks herein (Registration No. 2647243 for GENTLE BREEZE); and none of the marks in the third-party registrations is as similar to the cited mark as applicant's mark. In addition, third-party registrations are not evidence of

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his final refusal that a list is insufficient to make the third-party registrations of record, applicant responded in a request for reconsideration that "it now provides copies of the ... registrations." The copies were apparently not provided, as applicant claimed, but the examining attorney did not mention the omission in his denial of the request for reconsideration. Under the circumstances, the objection is considered waived, and the printouts are treated as properly of record.

<sup>5</sup> The examining attorney's objection to the additional Internet evidence submitted by applicant for the first time with its appeal brief (as exhibit D) is sustained. This evidence is untimely and will not be considered. Trademark Rule 2.142(d).

<sup>6</sup> Relying on *Sears Mortgage Corp. v. Northeast Savings, F.A.*, 24 USPQ2d 1227 (TTAB 1992), applicant argues that having the same word does not, in itself, establish a likelihood of confusion. However, in that case, unlike the present one, the only shared portion of the marks ("APPROVAL") was found to be merely descriptive of the parties' services, not distinctive of the goods as is the case here.

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use, and merely because other marks containing the suggestive term GENTLE exist on the register does not mean the public could distinguish the two marks at issue here, which are very similar and are used for virtually identical goods. Furthermore, evidence of two third-party uses of GENTLE GEL is insufficient to show widespread use of the term to establish that registrant's mark is weak in relation to the identified goods, or that the public is so familiar with marks containing the word GENTLE that they will rely on other portions of the marks to distinguish them. In addition, there is no information as to how extensive the two third-party uses are or the extent of public exposure to the sites.

We find, in view of the similarity of the marks, and because the marks are used in connection with at least very closely related goods that are sold in the same channels of trade to the same ultimate consumers, that confusion is likely.

**Decision:** The refusal to register under Section 2(d) of the Trademark Act is affirmed.