

THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Gillette Canada Inc., d.b.a Oral-B Laboratories

v.

Mas Marketing, Inc.

Opposition No. 99,522
to application Serial No. 74/589,153
filed on October 21, 1994

Marie V. Driscoll and Robert A. Becker of Fross Zelnick
Lehrman & Zissu, P.C. and Judith D. Cohen of The Gillette
Company for Gillette Canada Inc., d.b.a. Oral-B Laboratories

Michael J. Garvin of Hahn Loeser & Parks LLP for Mas
Marketing, Inc.

Before Seeherman, Walters and Bottorff, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Gillette Canada Inc., d.b.a. Oral-B Laboratories, has
opposed the application of Mas Marketing, Inc. to register
ORAL COMPARE as a trademark for toothbrushes.¹ As grounds

¹ Application Serial No. 74/589,153, filed October 21, 1994,
asserting first use and first use in commerce on October 5, 1994.

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for opposition, opposer alleges that it is the prior user of first, the trade name and mark ORAL B and, since 1977, of the trade name and mark ORAL-B, for toothbrushes, denture brushes and other dental cleaning items; that its ORAL-B brand toothbrushes have attained the number one share position in the United States and its trademark is a very well known indication of source; that it owns seven registrations for ORAL-B marks for, inter alia, toothbrushes; that applicant uses the word "compare" in its mark descriptively to evoke comparison of its product with toothbrushes sold under the mark ORAL-B and other marks, such that ORAL is the dominant part of applicant's mark; and that applicant's mark so resembles opposer's trademark and trade name as to be likely, when used in connection with applicant's products, to cause confusion and mistake and to deceive.

In its answer applicant has denied the salient allegations of the notice of opposition.

The record includes the pleadings; the file of the opposed application; the stipulated testimony, with exhibits, of Jonathan Kalan;² the testimony deposition, with

² This testimony merely authenticates the 28 exhibits which were submitted with it, consisting of various market research reports. Each of these reports numbers in the hundreds of pages, with summaries of particular points scattered throughout the reports. We would point out that the submission of evidence in this manner, without any testimony highlighting those specific portions of the report that opposer deemed relevant to the proceeding, is very burdensome to the Board.

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exhibits, of opposer's witness Alan A. Michaels and of applicant's witness Robert F. Glaser; and the depositions upon written questions, taken by applicant, of representatives of Chesebrough-Pond's USA (Beth Posner Rothman), KMART (Jerry Tschura), Wonder Laboratories-Tennessee (Harry Hester), Carewell Industries (Ralph D'Angelo) and Oralgene USA (Steven Kofsky). In addition, opposer has submitted, under a notice of reliance, status and title copies of its pleaded registrations, as follows:

| Mark | Goods |
|--------|--|
| | Toothbrushes ³ |
| | Dental floss dispensers and dental floss ⁴ |
| | Toothbrushes ⁵ |
| ORAL-B | Topical fluoride gels for application to the teeth, medicated mouthrinse preparations ⁶ |

³ Registration No. 547,130, issued August 26, 1951; Section 8 affidavit accepted; Section 15 affidavit received; renewed twice.

⁴ Registration No. 1,106,587, issued November 21, 1978; Section 8 affidavit accepted; Section 15 affidavit received; renewed.

⁵ Registration No. 1,197,304, issued June 8, 1982; Section 8 affidavit accepted; Section 15 affidavit received.

⁶ Registration No.1,501,858, issued August 30, 1988; Section 8 affidavit accepted; Section 15 affidavit received.

| | |
|--------|---|
| ORAL-B | Dental floss and trays for topical application of fluoride compositions and other preparations to the teeth ⁷ |
| ORAL-B | Toothpaste and dental prophylaxis preparation ⁸ |
| | Dentifrice; dental prophylaxis preparations—namely, non-medicated mouthwash; medicated mouth rinse preparation, topical fluoride gels for application to the teeth, dental amalgam; dental floss, disposable trays for topical application of dental medications; toothbrushes, denture brushes, interdental brushes ⁹ |

Applicant has submitted, under a notice of reliance, various advertisements for the "Mentadent Oral Care Brush";¹⁰ copies of various third-party registrations for marks containing the word ORAL, e.g., ORAL PURE for, inter alia, toothbrushes; and dictionary definitions of the word "oral."

The parties have fully briefed the case; an oral hearing was not requested.

⁷ Registration No. 1,502,069, issued August 30, 1988; Section 8 affidavit accepted; Section 15 affidavit received.

⁸ Registration No. 1,502,752, issued September 6, 1988; Section 8 affidavit accepted; Section 15 affidavit received.

⁹ Registration No. 1,608,762, issued August 7, 1990; Section 8 affidavit accepted; Section 15 affidavit received.

¹⁰ Although applicant refers to most of these advertisements as being for the "Mentadent Oral Brush," the phrase actually used contains the word "Care."

The record shows that Oral-B Laboratories is a division of Gillette Canada, the opposer herein, and that it manufactures and sells various types of oral health and oral care products. Hereafter, we will use the terms "opposer" and "Oral-B Laboratories" interchangeably. Opposer's witness Alan Michaels testified that to his personal knowledge ORAL-B has been used since 1971 as a trademark for opposer's products, including toothbrushes.¹¹ In connection with toothbrushes, opposer generally uses ORAL-B with another trademark, such as ORAL-B INDICATOR, ORAL-B ADVANTAGE, ORAL-B GRIPPER.

At retail, opposer sells its ORAL-B toothbrushes in all types of food stores, drugstores and mass merchandisers. It has 100% distribution of its toothbrushes in drugstores and mass merchandisers, and 97% in the food trade, i.e., ORAL-B toothbrushes are sold in the stores that do 97% of the volume of toothbrushes in the food trade.¹² The brushes are

¹¹ Most of the evidence regarding opposer's use of its ORAL-B trademark, and sales and advertising of its products, comes from Mr. Michael's testimony. In its brief, applicant has raised concerns about some of Mr. Michael's testimony, specifically relating to his opinions as to likelihood of confusion in view of what applicant characterizes as inconsistencies and evasiveness in terms of Mr. Michael's knowledge of third-party uses of the term "oral." We are satisfied that the factual information indicated in our opinion is accurate (and, indeed, applicant does not take issue with it). As for Mr. Michael's opinions as to likelihood of confusion, they have minimal value, since it is our role to determine, as a legal conclusion, whether confusion is likely.

¹² Although much of the information regarding opposer's sales and advertising was submitted under seal, opposer recited this information in its brief, which was not marked confidential.

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sold in every state in the country, and range in price from about \$1.60 to \$3.00.

Opposer also sells and distributes its ORAL-B toothbrushes to the dental profession, and dentists and hygienists in turn distribute the brushes to patients at no charge. From 50,000 to 52,000 dental offices, out of 100,000 offices in the United States, buy ORAL-B brushes.

Opposer's ORAL-B toothbrushes rank Number 1 in retail sales, with a 27% market share. Sales are also ranked Number 1 for dental offices, with a 35% market share. In 1996 sales of ORAL-B toothbrushes amounted to \$160 million, the bulk of which represented retail sales.

Opposer advertises its ORAL-B toothbrushes in the free standing inserts found in Sunday newspapers, through cable and broadcast television commercials, in print ads directed to consumers and, for dental professionals, in trade

Accordingly, we see no reason not to refer to this information in our opinion. Further, as a general comment, it appears to us that much of the material that has been filed under seal is not actually confidential information. For example, whenever any confidential material appears on a page of the transcript of Mr. Michael's testimony, the entire page has been filed under seal, even though non-confidential material also appears on that page. It is the better practice, when submitting a page of a transcript under seal, to also submit for the public record the page with only the specific confidential portions redacted. Similarly, opposer has filed under seal exhibits 13 and 14, which include certain promotional materials including "consumer offers that have been placed either at retail or advertised through Sunday supplements." Michaels, p. 53. Because Board proceedings are open to the public, parties should take care in designating only materials which truly contain confidential information as confidential.

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magazines, through direct mail and at dental conventions. Mr. Michaels testified that, in the five-year period preceding his testimony in January 1997, opposer had spent \$47 million on mass media advertising, and in 1996 spent \$12 million on television and print advertising. Television commercials for ORAL-B brushes have aired on the "Today" and "Tonight" shows, as well as soap operas. Opposer also has done sporadic radio advertising.

Applicant markets oral care products, including toothbrushes and accessories. It sells them primarily to the secondary marketplace, e.g., off-price stores, dollar stores, and close-out retailers. It began using the mark ORAL COMPARE on toothbrushes in October 1994, and has made continuous sales since that time of approximately 5 million brushes per year, at an average retail price of \$1.00 or below.

The mark is used on four different styles of toothbrushes, and the original packaging of those brushes each includes a label with the notation, as appropriate, "Compare to Aquafresh Flex," "Compare to Crest Complete," "Compare to Colgate Plus" and "Compare to Oral-B." These labels, in which COMPARE TO is shown on one line, above the third-party trademarks which appear in somewhat smaller letters, appear in the middle part of the packing, on the blister pack portion (as opposed to the mark ORAL COMPARE,

which appears on the cardboard base of the packaging, above the part where the plastic blister is affixed, and above the top of the toothbrush). This packaging was subsequently changed and the "Compare To" label does not appear on new packaging.

Mr. Glaser, applicant's president, testified that the message of the trademark is that consumers should make a price comparison with other toothbrushes.

Priority is not in issue in view of opposer's pleaded registrations, which are of record. **King Candy Company v. Eunice King's Kitchen, Inc.**, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, the evidence shows that opposer began using its various ORAL-B marks for toothbrushes prior to applicant's first use.

We turn next to a consideration of the issue of likelihood of confusion. Our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Having reviewed all of the evidence in light of the duPont factors, we find that confusion is likely.

The parties' goods are identical: toothbrushes. As such, they must be deemed to be sold in the same channels of trade, and to the same classes of consumers. Applicant points out that its goods are sold in the secondary

marketplace, and that the vendors of its products are different from opposer's. However, because there is no limitation as to the channels of trade in either applicant's application or opposer's registrations, we must assume that the parties' goods are sold in the same channels of trade, which would include grocery stores and drugstores. See **Canadian Imperial Bank of Commerce v. Wells Fargo Bank, NA**, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in an opposer's registration, rather than what the evidence shows the goods and/or services to be).

Moreover, the evidence shows that toothbrushes are impulse purchases, and that the parties' toothbrushes are inexpensive. As a result, their purchase would not be the subject of a great deal of thought or analysis.

Further, Mr. Michaels has testified that toothbrushes are often offered for sale on racks, with different brands displayed next to each other. He also stated that it is difficult to keep the brands of brushes in their correct segments because consumers tend to pick up a brush and then put it back on a different peg.

Opposer has demonstrated that its ORAL-B mark is famous, as shown by the sales and advertising figures recited above. Nor does applicant contest this fame. Fame, of course, plays a dominant role in cases featuring a famous or strong mark. Famous or strong marks enjoy a wide latitude of legal protection. As the Court said in **Kenner Parker Toys Inc. v. Rose Art Industries, Inc.**, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992), "the Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark."

With these points in mind, we turn to a consideration of the parties' marks, keeping in mind as well that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." **Century 21 Real Estate Corp. v. Century Life of America**, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Both parties have argued that one element of the marks should be given greater weight than the remaining element, although they differ as to which element should be considered dominant. Applicant asserts, essentially, that the term ORAL is suggestive, and that the other elements—the "-B" in opposer's mark, and the word "COMPARE" in applicant's mark, are sufficient to distinguish the marks.

There is no question that ORAL has a suggestive significance for dental hygiene products such as toothbrushes. The dictionary definitions¹³ and the third-party registrations for marks containing the term ORAL,¹⁴ submitted by applicant, demonstrate this. Even opposer's witness, Alan Michaels, has described opposer as a manufacturer and seller of "oral health and oral care products." Michaels, p. 6.

Opposer, on the other hand, argues that COMPARE in applicant's mark is used descriptively, and it is the word ORAL which must be viewed as the dominant element in applicant's mark. We agree that, as used in ORAL COMPARE, COMPARE is not an arbitrary term, but has a suggestive connotation. As applicant's president testified, the message of its mark is "the obvious," which he contends is "to make a comparison and it's usually a comparison of price." Glaser, p. 22.

In view of the suggestiveness of both parties' marks, it is not helpful to engage in an analysis of which element of each is the more suggestive. Rather, the marks must be

¹³ See The American Heritage Dictionary, 2d coll. ed. © 1991, in which "Oral" is defined as "of or pertaining to the mouth: *oral hygiene*".

¹⁴ The third-party registrations covering toothbrushes are for the marks ORAL PURE, ORALGIENE, MEDORAL and ORALDENT (expired 1998). Third-party registrations for other dental hygiene products include ORALGARD and ORALGUARD for mouthwash and ORALGARD for dentifrice (same registrant), ORALIEF for medicated mouth rinse and ORA-CARE for medicated mouth wash.

compared in their entireties, giving weight to all of the elements.

Although there are obvious differences in the marks because of the second elements of each, given the other factors we have discussed above, we find that these differences are not sufficient to avoid the likelihood of confusion. In particular, because of the fame of opposer's ORAL-B mark; the identical goods involved; the impulsive nature of the purchase of toothbrushes and the limited thought that would go into such purchases; and the manner in which toothbrushes are sold, with different brands located side-by-side, and with the tendency for the brand segments to be commingled, consumers are likely to be confused as to source by applicant's use of the ORAL COMPARE mark.

Consumers may, because of the similarity in structure of the parties' marks, misread applicant's ORAL COMPARE mark. Both marks begin with the word ORAL, followed by the word COMPARE in applicant's mark, and a hyphen and the capital letter "B" in opposer's mark. The impression created by the hyphen and capital letter is that ORAL is the first word of a two word mark.¹⁵

¹⁵ We are not persuaded by applicant's argument that the marks are different in appearance because the term ORAL-B in opposer's mark appears in white lettering on a blue cartouche, while applicant's mark is shown in block lettering on a colored field over a black background. There are several problems with applicant's position, most notably that applicant has applied for its mark as a typed drawing, and its rights in any registration

Even if consumers note the differences between the marks, they are likely to assume, because of the aforesaid factors, that ORAL COMPARE is a variant of opposer's ORAL-B trademark, perhaps used for a less-expensive of related line of ORAL-B brushes, rather than an indicator of a separate source.¹⁶

In reaching our conclusion we have considered applicant's evidence of third-party use of "Oral" marks. Third-party use of a particular term can be shown to demonstrate that the public is so used to seeing the term used in different trademarks that they distinguish the marks by their other elements. However, in this case the evidence of third-party use of "Oral" for toothbrushes is not sufficient for us to conclude that purchasers would look to the "-B" in opposer's mark and to COMPARE in applicant's mark, and distinguish them thereby.

Of the three asserted third-party uses, the evidence shows that K-Mart Stores had used the trademark ORAL PURE

that might issue are not limited to use of the mark in block lettering on a colored field over a black background. Further, opposer's registrations are not solely for ORAL-B on a blue cartouche background; aside from the fact that the registrations which include the background design do not limit it to the color blue, opposer also owns a registration for ORAL-B per se for toothbrushes, in which the mark is depicted in a plain upper-and-lower type format.

¹⁶ We have limited our finding of likelihood of confusion to consumers. Dental professionals are not likely to be confused because they do not buy toothbrushes in the same way as consumers. That is, they order toothbrushes in bulk, so these are not impulse or casual purchases, and they often deal directly with opposer's sales representatives or dealers.

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for toothbrushes beginning in November 1991, but that at the time of Mr. Tschura's deposition in July 1997, the company had phased out its use of the mark, although some inventory may have been available in some of its stores.

Chesebrough-Pond's USA uses the phrase "Oral Care Brush" in connection with its MENTADENT toothbrushes. However, we conclude, after reviewing the advertisements and packaging for the brushes, that the phrase would be perceived as a description, rather than a trademark, for the toothbrush.

The only evidence of on-going, relatively significant trademark use of an "Oral" mark for toothbrushes is that of ORALGIENE, and even that use is for a different category of toothbrush than the toothbrushes on which the parties herein use their marks. The record shows that Oralgiene USA has been selling electric toothbrushes under the mark ORALGIENE since 1992, and that, up until 1997, the time of the witness's deposition, approximately 85,000 brushes had been sold nationally.

We note that applicant has also submitted evidence of third-party use of ORABASE BABY for a teething gel, ORAJEL for a toothache pain reliever, and ORALBALANCE for a saliva substitute. Because of the differences in the goods, and the term ORA, as opposed to ORAL, in the first two marks, these third-party uses are not persuasive that consumers

would distinguish between ORAL-B and ORAL COMPARE for use on toothbrushes.¹⁷

We have also considered the lack of evidence of any actual confusion. At the time testimony was taken, there was contemporaneous use of the marks for only three years. More importantly, evidence of actual confusion is notoriously difficult to obtain. That would be particularly true in the case of toothbrushes, in view of the low cost of the products.

We do not mean to suggest by our decision that opposer has exclusive rights to the term ORAL for toothbrushes, and that any mark containing the element ORAL, used on toothbrushes, would be likely to cause confusion with opposer's mark. We confess that this is a close case. In contrast to **Gillette Canada Inc. v. Ranir Corp.**, 23 USPQ2d 1768 (TTAB 1992), in which this Board found likelihood of confusion between ORAL-B and ORAL-ANGLE, both used for toothbrushes, the second word in applicant's mark, COMPARE, is not a descriptive term for toothbrushes. Nevertheless, it is well-established that one who adopts a mark similar to the mark of another for the same or closely related goods or services does so at his own peril, and any doubt as to

¹⁷ Applicant has, in addition to the third-party uses noted above, referred in its brief to third-party registrations as indicating "widespread and unfettered use of 'oral' in the names of competing and related products." p. 11. However, third-party registrations are not evidence that the marks are in use.

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likelihood of confusion must be resolved against the newcomer and in favor of the prior user or registrant. **W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.**, 190 USPQ 308 (TTAB 1976). Accordingly, we have resolved our doubts in favor of opposer.

Decision: The opposition is sustained.

E. J. Seeherman

C. E. Walters

C. M. Bottorff
Administrative Trademark Judges
Trademark Trial and Appeal Board