

Dear Examiner,

Per the Office Action for the trademark application with the serial number 88501975 (the “Mark”) for the word mark “DR BRIGHTENING” (the “Mark”), the Examiner has refused registration of the mark due to the following issues: 1.) a disclaimer requirement; 2.) issues with the identification of goods; 3.) a specimen refusal for Class 3; and 4.) a Section 2(d) Refusal – Likelihood of Confusion with the mark “DR. BRITE” with registration number 4880716 (the “Prior Mark”) for use on “Cosmetics; Mouthwash; Non-medicated skin care preparations; Toothpaste” in Class 3.

Applicant respectfully requests that the Examining Attorney withdraw the aforementioned refusals and allow the application to proceed to publication for the reasons below.

Amendment of Applied for Identification of Goods

Applicant has removed Class 3 from its application. The identification of goods and services is now limited to Class 5. This resolves the identification of goods and specimen refusal issues surrounding Class 3.

Disclaimer Requirement

Per the Examiner’s suggestion, the following disclaimer has been added to the application, “No claim is made to the exclusive right to use “BRIGHTENING” apart from the mark as shown.

Identification of Goods

Per the Examining Attorney’s suggestion, the identification of goods (for the remaining goods class) has been amended as follows:

Class 5 – Medicated serums and creams for treatment of face, namely facial serum for the diminishing of dark spots.

Per the above, Applicant requests that the Examining Attorney lift the refusals related to the disclaimer, identification of goods, and specimen refusal.

The Section 2(d) Refusal for Likelihood of Confusion with the mark “DR. BRITE”

Applicant's mark and the registered mark are not likely to be confused for the following reasons:

1.) The products are unrelated. The Prior Mark covers cosmetics and non-medicated skin care preparations, whereas, as amended, the Mark covers medicated serums for the diminishing of dark spots. The goods are in different classes.

Cosmetics and medicated skin care preparations are unrelated and within a different categories of retail products. They are not found in the same retail stores (let alone in the same area/aisle of a single store), with cosmetics/non-medicated products being found with beauty products (at stores such as Sephora), and medicated products being found with other medications (at stores such as CVS and other pharmacies). Cosmetics and medicated skin care products are served by different brands (e.g., Maybelline and Estee Lauder vs. Bayer and Johnson & Johnson). The sale of one does not affect the sale of the other, and it is unlikely for a consumer to think that the maker of

one has entered into the market of the other. Even significant expansion of both product lines would present little to no likelihood of the maker of cosmetics entering into the market for medicated skin products, and vice versa.

The Examining Attorney has cited instances of third-parties offering both facial serums and creams and non-medicated skin care preparations under the same mark in the same trade channels to demonstrate that the products are related. However, these third-parties do not offer both non-medicated skin care preparations and medicated serums for the diminishing of dark spots. Consequently, per the amended identification of goods, the products are no longer related and are no longer offered in the same trade channels under the same mark.

Further, examination of the Dr. Brite website reveals that *all* of the products represented by the Prior Mark (other than hand sanitizer being offered in light of the current viral pandemic) are oral care products, ranging from toothpaste to mouth spray, which are further distinguishable from and unrelated to medicated skin lightening serum.

2.) The marks themselves are different. “DR BRIGHTENING” and “DR. BRITE” offer distinctive impressions – per the Dr. Brite website, “DR. BRITE” is presented in a stylized mix of uppercase and lowercase, in a thin font; whereas “DR BRIGHTENING” is presented in all caps. “DR. BRITE” gives the impression that it is a “fun natural product”, whereas “DR BRIGHTENING” is presented in a manner that emphasizes its clinical nature.

3.) Purchasers of the goods in question, medicated facial creams and cosmetics, exercise a high degree of purchaser care. They are highly concerned with the product branding (including its look and feel) and the ingredients contained therein. They are unlikely to be confused by the use of the different marks above for medicated skin lightening cream and non-medicated cosmetics.

Per the above, the Mark and Prior Mark are not likely to be confused.

In consideration of the above, Applicant respectfully requests that the Examining Attorney withdraw the refusals above and allow the application to proceed to publication.

Sincerely,
/Charles Kim/
Attorney of Record