

U.S. PATENT AND TRADEMARK OFFICE

Serial No. 88755342

Mark: SMILE FOR GOOD

Our Ref: CPC 2000481

RESPONSE TO OFFICE ACTION

This is response to the Office action issued February 20, 2020, which refused registration of Applicant's mark, under Section 2(d) of the Trademark Act, on the basis that Applicant's mark SMILE FOR GOOD for "Toothpaste; Non-medicated mouthwashes" in Class 3 and "Tooth brushes" in Class 21 is so similar to the mark SMILEGOODS in U.S. Registration No. 3,450,134 (the "Cited Mark") for "Toothbrushes" in Class 21, that it is likely to cause confusion. The Office action also required a verified statement from the Applicant because the application was filed unsigned, which Applicant submits with this Response.

For the reasons stated below, Applicant submits that based on the differences in the parties' respective marks, confusion is not likely. Therefore, Applicant respectfully requests that the refusal of registration be withdrawn.

ARGUMENTS

A. The Marks are Sufficiently Different to Avoid Confusion

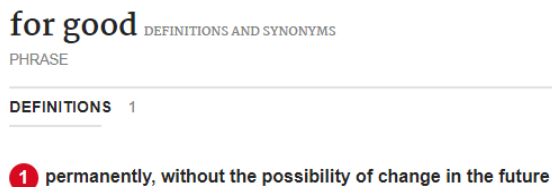
The Office action states that Applicant's mark is "highly similar" to the Cited Mark, and "[t]he only difference between the marks is that the applicant added the word 'FOR' to the registered mark and deleted the letter 'S' in the wording "GOODS." However, while the Office action attempts to minimize these differences, they are actually significant and their impact on the overall appearance, sound and commercial impression of the respective marks cannot be discounted or disregarded.

First, the shared element “GOOD” carries completely different meanings as used in each mark. Applicant’s mark uses the idiom, “for good,” while the wording in the Cited Mark is the noun, “goods.” As shown below, both “for good” and “goods” have dictionary definitions with unrelated meanings.

“GOODS” in the Cited Mark is a noun that means “objects produced for sale” (see **Exhibit A** – <https://www.macmillandictionary.com/us/dictionary/american/goods>):



In contrast, “FOR GOOD” in Applicant’ Mark is a phrase commonly used to express permanence (see **Exhibit B** – <https://www.macmillandictionary.com/us/dictionary/american/for-good>):



Applicant’s mark is also a play on words of the phrase “do good,” which means to act virtuously, especially by helping others (See **Exhibit C** - <https://www.lexico.com/en/definition/good>):

do good

1 Act virtuously, especially by helping others.

‘They both ask people to be virtuous, and they both do good to their followers.’

Both “GOODS” and “FOR GOOD” are commonly used words or phrases that consumers understand have different meanings. The use of GOODS in the cited mark is extremely suggestive of the identified goods (toothbrushes). Many consumers associate dental products such as toothbrushes with their smiles, or with having a “nice smile” or a “good smile.” The unitary nature of the Cited Mark thus creates an impression of an object, “smile *goods*,” namely, the toothbrushes identified in the registration.

Applicant’s mark, however, suggests to consumers that they may “smile *for good*,” which suggests smiling permanently. Additionally, in the context of the definition of “do good,” Applicant’s mark is suggestive of the products having a virtuous or otherwise positive effect. In fact, Applicant’s SMILE FOR GOOD toothpaste is packaged in a first-of-its-kind recyclable plastic tube, which has received recognition from The Association of Plastic Recyclers, which sets recyclability standards for North America. See **Exhibit D**, press release titled “Colgate® Launches Smile for Good Toothpaste With a New Level of Ingredient Transparency and a First-of-its-kind Recyclable Tube.” The press release states that this is one way in which “Colgate is improving the sustainability profile of its products to help achieve its aim of 100% recyclable packaging by 2025.”

Applicant’s sustainability efforts are well documented and have been recognized by industry stakeholders. The environmental and sustainability connotation is absent from the Cited Mark, which primarily conveys a meaning of “goods meant for a smile,” i.e., the toothbrushes specific in the registration.

Moreover, while the Cited Mark SMILEGOODS is a unitary mark that is comprised of two syllables, Applicant’s Mark SMILE FOR GOOD, in which the words “SMILE” and “GOOD” are separated by the word “FOR,” is a three-word phrase or idiom comprised of three

distinct words. The two marks are therefore aurally and structurally distinguishable, as well. Based on the different impressions created by each mark, notwithstanding the use of the term “GOOD” or “GOODS,” and the diluted nature of the term “SMILE,” as further explained below, the marks are sufficiently different in appearance, sound and connotation, such that confusion is not likely.

The Court of Appeals for the Federal Circuit has repeatedly instructed that (a) trademarks should be viewed in their entirety as they are perceived by consumers, and (b) trademarks should not be dissected into fragments, with entire elements disregarded. Focusing only on the shared terms “SMILE” or “GOOD” in the marks to the exclusion of other factors, such as the addition of the word “FOR” and the deletion of the letter “S,” is therefore an improper dissection of the mark. Instead, the marks *must* be viewed in their entirety, the way that they will be perceived by consumers, without focusing on single common elements. *See e.g., Keebler Co. v. Murray Bakery Products*, 9 U.S.P.Q.2d 1736 (Fed. Cir. 1989) (no likelihood of confusion between PECAN SANDIES and PECAN SHORTIES both for cookies).

A case that is particularly instructive is *In re Hearst Corp.*, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992), in which the Federal Circuit held that there was no likelihood of confusion between VARGA GIRL and VARGAS both for calendars, in effect, distinguishing marks based on their differing suffixes. In reversing the Trademark Trial and Appeal Board, the Federal Circuit stated:

The Board erred in its analytic approach. Although undoubtedly "varga" and "vargas" are similar, the marks must be considered in the way they are used and perceived. Marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight. *Id.* at 1239 (citations omitted).

So too in the present case, consumers will encounter the marks in their entirety, and the impressions that are created will be derived from the marks’ overall presentations. Thus, given

the dissimilarities in sight, sound and meaning between the marks, there is no likelihood of confusion between Applicant’s Mark and the Cited Mark.

B. The Term “SMILE” is Diluted on the Register.

The Office action considers the goods identified in Applicant’s mark and in the Cited Mark to be closely related, such that purchasers of Applicant’s goods could mistakenly assume such goods were produced by the registrant or that Applicant and registrant are related in some way.

However, there are numerous coexisting SMILE-formative marks on the Register for toothpastes, toothbrushes, mouthwashes and other oral care products. The dilution of the term SMILE is further evidence that consumers are not likely to be confused as to the source of the goods associated with each of the respective marks, SMILEGOODS and SMILE FOR GOOD, because consumers have become accustomed to the use of the term SMILE in marks used in connection with these types of oral care products. The Cited Mark coexists with more than 30 registrations for SMILE- formative mark in Classes 3 and 21, examples of which are in the chart below (TSDR records of the registrations are attached as **Exhibit E**):

TM/AN/RN/Disclaimer	Status/Key Dates	Goods/Services	Owner Information
GO SMILE RN: 3389326 SN: 76518246	Renewed February 26, 2018 First Use: July 31, 2007 Filed: May 29, 2003 Registered: February 26, 2008	(Int'l Class: 03) products for care and treatment of the teeth, lips and breath, namely, toothpaste, lip balm, and tooth whiteners comprised of peroxide gels (Int'l Class: 21) toothbrushes	Gosmile, LLC (Delaware Limited Liability Company) 555 East 5th Street, Suite 2712 Austin Texas 78701
GREAT SMILES FOREVER RN: 5045594 SN: 86932474	Registered September 20, 2016 First Use: September 19, 2008 Filed: March 8, 2016	(Int'l Class: 03) mouth washes; tooth gel; tooth whitening gels; toothpaste	Korwin, Robert (United States Citizen) Union Square 562

TM/AN/RN/Disclaimer	Status/Key Dates	Goods/Services	Owner Information
			Route 35 Red Bank New Jersey 07701
MIRACLE SMILE RN: 5808031 SN: 87903429	Registered July 16, 2019 First Use: November 10, 2013 Filed: May 2, 2018	(Int'l Class: 03) Teeth Whitening Kits, Toothpaste, Non-medicated mouthwash (Int'l Class: 05) Medicated Mouthwash	Spa Dent Inc. (Canada Corp.) 254-55 Northfield Dr E. Waterloo N2k3t6 Canada
I'M A SMILE RN: 5087049 SN: 86317141	Registered November 22, 2016 First Use: April 25, 2016 Filed: June 23, 2014	(Int'l Class: 03) oral health care products, namely, toothpaste (Int'l Class: 21) toothbrushes	Lohmann, Alicia H. (United States Citizen) 12700 Nicollet Ave. #218 Burnsville Minnesota 55337
POWERSMILE RN: 2664579 SN: 78023282	Renewed December 17, 2012 First Use: January, 2001 Filed: August 28, 2000 Registered: December 17, 2002	(Int'l Class: 03) toothpaste; tooth gel; tooth polish; breath fresheners	Jason Natural Products, Inc. (California Corp.) 1111 Marcus Avenue Lake Success New York 11042
SMILE FROM THE INSIDE OUT RN: 5443828 SN: 86897362	Registered April 10, 2018 First Use: August 1, 2017 Filed: February 4, 2016	(Int'l Class: 03) mouthwashes; toothpaste	Vingt Holdings, LLC (New York Limited Liability Company) 30 East 40 Street, #608 New York New York 10016
SMILE GURU RN: 5739766 SN: 88135809	Registered April 30, 2019 First Use: July, 2018 Filed: September 28, 2018	(Int'l Class: 03) Toothpaste; Teeth whitening preparations (Int'l Class: 21) Toothbrushes	Dr. Brite, Inc. (California Corp.) 2700 S Bristol St. Santa Ana California 92704
SMILE ILLUMINATOR RN: 4976349 SN: 86625235 Disclaimer: "ILLUMINATOR"	Registered June 14, 2016 First Use: March 9, 2015 Filed: May 11, 2015	(Int'l Class: 03) teeth whitening kits comprised of teeth whitening toothpaste, teeth whitening oral rinse, and teeth whitening serum sold as a unit	French Transit, LLC (California Limited Liability Company) 398 Beach Road Burlingame California 94010

TM/AN/RN/Disclaimer	Status/Key Dates	Goods/Services	Owner Information
SMILE NATURALLY RN: 4156398 SN: 85098797	Registered 8 Accepted August 23, 2017 Filed: August 3, 2010 Registered: June 12, 2012	(Int'l Class: 03) tooth bleaching gel; tooth whitening gel; tooth polishing cream; toothpaste; tooth gel; mouthwash; mouth rinse; preventative maintenance oral care products comprised of tooth whitening gel, gel applicators, gel trays, tooth cleaning gels, toothpaste, and rinses sold together as a unit	Valente, Sal (Canada Citizen) 6 Debra Crescent Barrie, Ontario L4n-3T1 Canada
SMILE OUT LOUD RN: 3978992 SN: 77922341	Registered 8 Accepted October 12, 2017 First Use: April 26, 2010 Filed: January 28, 2010 Registered: June 14, 2011	(Int'l Class: 03) mouthwashes; toothpastes	Narducci Dental Group, P.A. (Florida Corp.) 2801 St. Johns Bluf Road S #4 Jacksonville Florida 32246
SMILE WITH STRENGTH RN: 5623084 SN: 86840776	Registered December 4, 2018 First Use: January 31, 2018 Filed: December 7, 2015	(Int'l Class: 03) Toothpaste and mouthwash (Int'l Class: 21) Toothbrushes	Colgate-Palmolive Company (Delaware Corp.) 300 Park Avenue New York New York 10022
SMILEACTIVES RN: 4003406 SN: 77981921	Registered 8 & 15 October 28, 2017 First Use: October 15, 2010 Filed: April 4, 2008 Registered: July 26, 2011	(Int'l Class: 03) dental bleaching gel; home dental care products for dogs and cats, namely, toothpaste; non-medicated dental rinse; tooth bleaching preparations; tooth cleaning preparations; tooth gel; tooth paste; tooth whitening creams; tooth whitening gels; tooth whitening pastes; tooth whitening preparations; cosmetic preparations for the care of mouth and teeth	Oral Care Products, LLC (Delaware Limited Liability Company) 100 North Sepulveda Boulevard 16th Floor El Segundo California 90245
SMILESWAG RN: 5068925 SN: 85833458	Registered October 25, 2016 First Use: August 12, 2016 Filed: January 27, 2013	(Int'l Class: 03) mouthwash; toothpaste	Naini, Mehrnaz (United States Citizen) 9601 Newbridge Dr. Potomac Maryland 20854

TM/AN/RN/Disclaimer	Status/Key Dates	Goods/Services	Owner Information
SUPERSMILE RN: 3014779 SN: 78094087	Renewed November 15, 2015 First Use: January 1, 1981 Int'l Class: 10 First Use: January 1, 1990 Int'l Class: 21 First Use: January 1, 1989 Filed: November 19, 2001 Registered: November 15, 2005	(Int'l Class: 03) toothpaste, tooth gel, tooth powder, non-medicated mouthwash, non-medicated mouth rinse, dental whitening preparations, denture cleaning preparations (Int'l Class: 21) non-medicated dental floss, toothbrushes	Robell Research, Inc. (New York Corp.) 655 Madison Avenue, 24th Floor New York New York 10065
SUNSHINE SMILE RN: 5809027 SN: 79235403	Registered July 23, 2019 Filed: May 18, 2018 Int'l Reg Date: May 18, 2018	(Int'l Class: 03) Dental cosmetics; non-medicated toothpaste; mouthwashes, not for medical purposes (Int'l Class: 21) Toothbrushes; toothbrush holders; toothbrush cases; heads for electric toothbrushes; oral care kits comprising toothbrushes and floss	Sunshine Smile GmbH (Germany Gesellschaft Mit Beschränkter Haftung (GmbH)) Greifswalder Straße 223 10405 Berlin Germany
TWIST N SMILE RN: 5482270 SN: 87394406	Registered May 29, 2018 First Use: November 22, 2017 Filed: March 31, 2017	(Int'l Class: 03) toothpaste; non-medicated mouthwash; tooth whitening preparations	Martin Giniger & Company Inc (Florida Corp.) 101 Briny Ave Apt 2206 Pompano Beach Florida 33062
TOP SMILE RN: 5863779 SN: 87816881	Registered September 17, 2019 First Use: January 2, 2019 Filed: March 1, 2018	(Int'l Class: 03) Teeth whitening kit; Teeth whitening preparations; Tooth paste; Tooth whitening pastes	Urban Retail Channel LLC (Delaware Limited Liability Company) C/O Muhammad Shahadat Hossen 34 Somerville Road Romford, Essex Rm65be Great Britain
WINNING SMILE RN: 5487415 SN: 87225831	Registered June 5, 2018 First Use: August 30, 2017 Filed: November 3, 2016	(Int'l Class: 21) electric toothbrush; toothpaste squeezer; tongue cleaner, namely, tongue brushes; dental floss picks	Winning Smile Limited (Hong Kong Special Administrative Region of the People's Republic

TM/AN/RN/Disclaimer	Status/Key Dates	Goods/Services	Owner Information
			of China, the Limited Liability Company) Unit1109,11F,Kowloon Ctr.,33Ashley Road Tsim Sha Tsui, Kowloon Hong Kong Special Administrative Region of the People's Republic of China, The
PERFECT YOUR SMILE RN: 3874612 SN: 77812942	Registered 8 Accepted August 15, 2017 First Use: August 1, 2009 Filed: August 26, 2009 Registered: November 9, 2010	(Int'l Class: 03) toothpaste and mouthwashes	Narducci Dental Group, P.A. (Florida Corp.) 2801 St. Johns Bluff Road S #4 Jacksonville Florida 32246
PERFECT SMILE RN: 3208985 SN: 78868176	Renewed February 13, 2017 First Use: January 1, 1993 Filed: April 24, 2006 Registered: February 13, 2007	(Int'l Class: 03) toothpaste; mouth rinse; dentifrices in the form of chewing gum; kit consisting of tooth whitening and polishing preparation and applicator	Bioactives, LLC (Delaware Limited Liability Company) 1 Dix Street Worcester Massachusetts 01609
SMILE SAVER RN: 1436476 SN: 73620406	Renewed April 14, 2017 First Use: April, 1986 Filed: September 17, 1986 Registered: April 14, 1987	(Int'l Class: 21) disposable toothbrushes	Smile Saver, LLC (Michigan Limited Liability Company) 2883 Aero Park Drive Traverse City Michigan 49696

That these marks are able to coexist amongst each other and also with the Cited Mark suggests that Applicant's Mark SMILE FOR GOOD can also coexist without likelihood of confusion. Given that numerous SMILE-formative marks for identical or related goods already coexist and "GOODS" and "FOR GOOD" unmistakably differ in meaning, it must be the case that Applicant's Mark SMILE FOR GOODS can also coexist without likelihood of confusion.

The Board has consistently held that when a mark is weak, diluted and highly suggestive, it is entitled to only a narrow scope of protection, and thus even small differences in stylization or the addition of descriptive words will be sufficient to distinguish the mark. Thus in *In re Boston Juicery, LLC*, Ser. No. 86877537 (TTAB Aug. 21, 2018) (not precedential), the Board reversed the refusal to register due to the weak and diluted nature of the term SQUEEZE. At issue in that case was the applicant's mark SQUEEZE JUICE COMPANY (JUICE COMPANY disclaimed) for "fruit juices; vegetable juices; smoothies" in Class 32, and "juice bar services; smoothie bar services; café services" in Class 43, which was refused on the basis of a likelihood of confusion with the mark SQUEEZE and Design for "bar services; juice bar services" in Class 43. The services were considered to be identical, and both marks had SQUEEZE as the dominant element of the mark. The Board found that both marks were similar in sound, connotation, and commercial impression. However, in view of the twelve third-party marks with the term SQUEEZE for beverages or juice bars, the Board concluded (at p. 10):

Given the number of third-party registrations for the involved goods or services, consumers are conditioned to look for differences between SQUEEZE and SQUEEZE formative marks to determine the source of a given product and therefore less likely to be confused.

Thus, when the marks at issue here are viewed in their entirety and not by dissecting the marks to isolate particular terms, the differences in sound, appearance and commercial impression of each mark, in addition to the dilution of the wording "SMILE" on the Register, sufficiently demonstrate that no confusion is likely between the marks SMILE FOR GOOD and SMILEGOODS.

CONCLUSION

For the foregoing reasons, Applicant respectfully submits that all issues have been addressed and requests that the Section 2(d) refusal be withdrawn and this application be approved for publication.