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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Marshall Cavendish Corp.**

Serial No. 76/090,373

Leo Zucker, of Law Offices of Leo Zucker for **Marshall Cavendish Corp.**

William P. Jacobi, Trademark Examining Attorney, Law Office 110
(Chris A.F. Pedersen, Managing Attorney).

Before **Quinn, Hohein** and **Bottorff**, Administrative Trademark
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

Marshall Cavendish Corp. has filed an application to register the mark "WE CAN READ ABOUT NATURE!" for a "non-fictional nature book series for young readers featuring topics on camouflage, habitat, identification of species, and life cycles, and for enabling the reader to build vocabulary and strengthen phonic skills."¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that

¹ Ser. No. 76/090,373, filed on July 17, 2000, based on an allegation of a bona fide intention to use such mark in commerce. Applicant, on February 27, 2002, subsequently amended the application to set forth September 2000 as the date of first use anywhere and in commerce of its mark.

applicant's mark, when used in connection with its goods, so resembles the mark "I CAN READ ABOUT," which is registered for a "series of children's books,"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods and the similarity of the marks.³

Turning first to consideration of the respective goods, applicant attempts in its initial brief to distinguish such goods based upon asserted "differences in format, identifying symbols, cost and other [physical] characteristics." Specifically, applicant contends among other things that its books "are dimensioned higher than they are wide, while registrant's books measure wider than they are high" and that the former are

² Reg. No. 2,293,847, issued on November 23, 1999, which sets forth a date of first use anywhere and first use in commerce of September 29, 1992.

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."

"hardbound and are priced at \$14.95 each," while the latter "are softbound and are priced at \$4.95 each."

The issue of likelihood of confusion is determined, however, on the basis of the goods as identified in the respective application and cited registration, regardless of what the record may reveal as to the particular nature of those goods, their actual channels of trade, or the class(es) of purchasers to which they are in fact directed and sold. See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); and Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987). That is to say, it is well settled in this regard that, absent any specific limitations or restrictions in the identifications of goods as listed in the applicant's application and the registrant's registration, the issue of likelihood of confusion must be determined in light of consideration of all normal and usual channels of trade and methods of distribution for the respective goods and on the basis of all customary consumers therefor. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

Here, as the Examining Attorney correctly points out in his brief, "the identification of the registrant's goods is very broad" and, in consequence thereof, "the registration encompasses all goods of the type described, including those in the

applicant's more specific identification." Registrant's series of children's books thus covers goods which are identical in part to applicant's non-fictional nature book series for young readers and which are otherwise closely related thereto. Consequently, the respective goods would be sold through the same channels of trade, including bookstores, and would be marketed to the same classes of purchasers, including not only such sophisticated buyers as "individuals who work in the academic field," as argued by applicant, but also such ordinary consumers as parents of young children. Because the goods at issue are so closely related and, in part, are legally identical, the marketing thereof under the same or similar marks would be likely to cause confusion as to the source or sponsorship thereof.

Turning, therefore, to consideration of the respective marks, applicant raises two primary arguments. First, while acknowledging in its initial brief the obvious fact that "applicant's and registrant's marks ... share the common words CAN READ ABOUT," applicant additionally asserts that "such words are not particularly distinctive in relation to the subject goods, namely, a series of children's books." Applicant, in this regard, contends in particular that:

Because of this, purchasers will likely place more emphasis on the first words of the marks to distinguish them from one another. That is, because the common element of the marks is suggestive of the goods, consumers will tend to look to other, non-descriptive portions of the marks to avoid confusion. The use of distinctly different pronouns as first terms in the marks at issue allows consumers a means to distinguish the two marks from one another.

Applicant, in its initial brief, also notes that while the Internet evidence made of record by the Examining Attorney demonstrates that registrant's "I CAN READ ABOUT" series of children's books does indeed include books about nature, with such titles as "I CAN READ ABOUT REPTILES," "I CAN READ ABOUT EARTHQUAKES AND VOLCANOES" and "I CAN READ ABOUT WEATHER,"⁴ "[n]o publication of registrant entitled 'I CAN READ ABOUT NATURE' was identified." Moreover, in its reply brief, applicant argues that its "WE CAN READ ABOUT NATURE!" mark is further distinguished by the presence of the word "NATURE" and emphasizes that "[t]he registered mark is *not* 'I CAN READ ABOUT ----', where '----' denotes an unlimited number of subjects or topics, including nature" (italics in original).

As its other primary argument, applicant relies upon certain matter extraneous to the respective marks to support its contention that, in the marketplace, confusion as to origin or affiliation is not likely to occur. Specifically, applicant asserts in its initial brief that as evidenced by the declaration of record from its vice president of marketing and operations, Richard Farley, it has "published and sold a companion book

⁴ Other publications on the subject of nature in registrant's series include "I CAN READ ABOUT MANATEES," "I CAN READ ABOUT ALLIGATORS AND CROCODILES," "I CAN READ ABOUT BABY ANIMALS," "I CAN READ ABOUT BATS," "I CAN READ ABOUT CREATURES OF THE NIGHT," "I CAN READ ABOUT CREEPY, CRAWLY, CREATURES," "I CAN READ ABOUT DINOSAURS," "I CAN READ ABOUT DOGS AND PUPPIES," "I CAN READ ABOUT ELEPHANTS," "I CAN READ ABOUT FROGS AND TOADS," "I CAN READ ABOUT HORSES," "I CAN READ ABOUT INSECTS," "I CAN READ ABOUT PREHISTORIC ANIMALS," "I CAN READ ABOUT SEASONS," "I CAN READ ABOUT SHARKS," "I CAN READ ABOUT SPIDERS," "I CAN READ ABOUT THE OCTOPUS," "I CAN READ ABOUT THUNDER AND LIGHTNING," "I CAN READ ABOUT TREES AND PLANTS" and "I CAN READ ABOUT WHALES AND DOLPHINS."

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series under the mark WE CAN READ!" since September 1999. Such mark, applicant notes, is the subject of application Ser. No. 76/090,722, "wherein applicant's goods are identified as a 'book series for young readers featuring fictional stories and illustrations of animal characters, for enabling the reader to build vocabulary, strengthen phonic skills, and explore relationships with others.'" That application, the record reveals, was examined by the same Examining Attorney who handled the application which is the subject of this appeal and, as pointed out by applicant, has been published without, according to Mr. Farley, an opposition thereto being filed by "the owner of ... registration which is being cited as a bar to registration of applicant's present mark WE CAN READ ABOUT NATURE!"

In view thereof, and because it "has advertised and sold its WE CAN READ! Series in the same market to which the present WE CAN READ ABOUT NATURE! series is advertised and sold," applicant maintains that due to the use in each of its marks of "the pronoun 'WE' followed by 'CAN READ' as a series mark, persons familiar with applicant's WE CAN READ! series and registrant's I CAN READ ABOUT series are not likely to assume that applicant's newer WE CAN READ ABOUT NATURE! books are simply new additions to registrant's series." In a similar vein, applicant also submits that, as shown by the exhibits to the Farley declaration, "it is improper to assume that consumers familiar with registrant's mark will tend to believe that applicant's books are another in the series of 'I Can Read About' books from registrant" because:

As used on its books, applicant's mark is framed and stands alone as a series mark toward the top of the book covers. A specific book title, e.g., "ANIMAL TALK" or "BUSY BUILDERS" ... follows the mark. By contrast, registrant's mark is printed and used in such a manner as to form an overall title such as "I Can Read About Reptiles" or "I Can Read About Weather" Accordingly, a fairer test of likelihood of confusion ... would be to compare one of registrant's overall titles, for example, "I Can Read About Reptiles", with applicant's mark as combined with one of applicant's titles, e.g., "WE CAN READ ABOUT NATURE ANIMAL TALK". Such a comparison would leave no doubt that the § 2(d) issue should be resolved in favor of applicant.

We agree with the Examining Attorney, however, that confusion is likely from contemporaneous use of the respective marks in connection with the goods at issue. Among other things, the Examining Attorney accurately points out that, as to applicant's assertion that the words "CAN READ ABOUT," which are shared by the respective marks, "are not particularly distinctive in relation to the subject goods, namely, a series of children's books," it is the case that "applicant offers no evidence that this particular wording is weak in relation to these goods." In fact, as the Examining Attorney further correctly observes, the record indicates that "the registrant has the only mark on the register containing the wording 'CAN READ ABOUT'" and there is no showing of any third-party use of such wording for the same or similar goods.

Given the absence of evidence that the "CAN READ ABOUT" portion of registrant's "I CAN READ ABOUT" mark is weak and thus merits only a narrow scope of protection, the Examining Attorney maintains with respect to the marks at issue that:

It simply defines common sense and it is unsupported by case law to argue that the pronoun ["I" or "WE"] is the dominant portion in either of these marks, or that consumers will be able to distinguish these ... marks based upon the different pronouns. See *Henry J. Siegel Co., Inc. v. Highlander, Ltd.*, 183 USPQ 496 (TTAB 1974) (confusion not likely between "H.I.S." and "HE" for identical goods). The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The issue is whether the marks created the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b). Thus, considering these marks in their entirety, consumers retaining a general impression are not likely to make a distinction between the pronouns "I" and "WE". This is especially true considering that applicant's use of "WE" does not change the connotation of the mark. The pronouns "I" and "WE" (followed by the wording "CAN READ ABOUT") both suggest that the books are for the consumer(s) to learn about a certain subject.

The only other difference between the marks is that applicant has added the word "NATURE" to the end of its mark. However, the mere addition of a term to a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d). *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975). More specifically, given the open ended phraseology of registrant's mark "I CAN READ ABOUT", consumers would expect a specific subject matter to follow that phrase.

The Examining Attorney concludes, in view thereof, that "applicant's addition of the word "NATURE" is insignificant in distinguishing it from the registrant's mark" and that

"[c]onsumers familiar with the registrant's 'I CAN READ ABOUT' mark for a series of children's books, upon encountering applicant's 'WE CAN READ ABOUT NATURE[!]' mark for the same goods, are likely to believe that applicant's mark is just another subject matter in the series provided by the registrant."

As to the other primary argument advanced by applicant, the Examining Attorney confirms that he approved applicant's application for registration of the mark "WE CAN READ!" for publication. The Examining Attorney notes, however, that as to applicant's argument with respect thereto, such argument "appears to be that since no likelihood of confusion was found between 'WE CAN READ[!]' and 'I CAN READ ABOUT', then there should be no likelihood of confusion between 'WE CAN READ ABOUT NATURE[!]' and 'I CAN READ ABOUT'." The fallacy in applicant's contention, the Examining Attorney asserts, is that "'WE CAN READ[!]' creates an entirely different commercial impression than 'WE CAN READ ABOUT NATURE[!]' or 'I CAN READ ABOUT'." According to the Examining Attorney:

The "WE CAN READ[!]" mark suggests learning how to read. On the other hand, the "CAN READ ABOUT" marks do not suggest learning how to read. Rather, the connotation of these marks is learning about a specific subject matter. Consequently, it is likely that consumers would believe that the applicant's "WE CAN READ ABOUT NATURE[!]" book is a new addition to the registrant's book series of learning about new subjects, rather than an extension of applicant's book series on how to read.

With respect to applicant's assertion that "a fairer test of likelihood of confusion ... would be to compare one of registrant's overall titles, for example, 'I Can Read About

Reptiles', with applicant's mark as combined with one of applicant's titles, e.g., 'WE CAN READ ABOUT NATURE ANIMAL TALK'," the Examining Attorney properly points out that the correct comparison "is between the marks as they appear in the application and the registration." Here, the Examining Attorney accurately observes, the mark which applicant seeks to register does not contain any design element nor does it feature any wording other than "WE CAN READ ABOUT NATURE!"; similarly, registrant's mark does not display any design feature nor does it include any words other than "I CAN READ ABOUT." Moreover, according to the Examining Attorney, "[t]he fact that applicant's continued focus is to compare the marks by adding designing or wording that does not appear in either of the marks is a tacit admission by applicant that the marks as they appear in the application and registration are substantially similar."

While, as to the overall similarity of the marks at issue, we concur with applicant's argument in its reply brief that, strictly speaking, "applicant has not incorporated the 'entire' registered mark into its present mark," we disagree with applicant's further assertions that, except for sharing the words "CAN READ ABOUT," "[t]he marks at issue have no other commonality" and that confusion from the contemporaneous use thereof is therefore not likely. As is the case herein, our principal reviewing court in *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994), has stated that "[w]hen marks would appear on virtually identical goods ..., the

degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." In this instance, applicant's "WE CAN READ ABOUT NATURE!" mark and registrant's "I CAN READ ABOUT" mark have in common more than just the words "CAN READ ABOUT." Significantly, both marks are substantially similar in structure in that each begins with a first person pronoun in the nominative case⁵ which is followed by the identical phrase "CAN READ ABOUT." Although applicant's mark begins with the plural form of the first person pronoun as opposed to the singular form used in registrant's mark, and while applicant's mark also includes the term "NATURE!" which serves to emphasize

⁵ We judicially notice in this regard that, for example, Webster's Third New International Dictionary (1993) at 1119 defines "i" in relevant part as "**1** : The one who is speaking or writing ... -- used as a nominative pronoun of the first person singular by one speaking or writing to refer to himself as the doer of an action ..." and at 2588 lists "we" in pertinent part as "**1 a** : I and the rest of a group that includes me : you and I : you and I and another or others : I and another or others not including you -- used as a nominative pronoun of the first person plural as the subject of a verb ... **b** : people in general including the speaker or writer" Similarly, The Random House Dictionary of the English Language (2d ed. 1987) at 946 sets forth "I" in pertinent part as "**1.** the nominative singular pronoun, used by a speaker in referring to himself or herself" and at 2152 defines "we" in relevant part as "**1.** nominative pl. of **I.** **2.** (used to denote oneself and another or others) **3.** (used to denote people in general) **6.** Also called **the editorial we.** (used by editors, writers, etc. to avoid the too personal or specific *I* or to represent a collective viewpoint)" To the same effect, The American Heritage Dictionary of the English Language (4th ed. 2000) at 867 lists "I" as "*pron.* Used to refer to oneself as speaker or writer" and at 1947 sets forth "we" as "*pron.* **1.** Used by the speaker or writer to indicate the speaker or writer along with another or others as the subject **2.** Used to refer to people in general, including the speaker or writer **3.** Used instead of *I*, especially by a writer wishing to reduce or avoid a subjective tone. **4.** Used instead of *I*, especially by an editorialist, in expressing the opinion or point of view of a publication's management." It is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir.

the subject matter of its series of books for young readers, overall the marks "WE CAN READ ABOUT NATURE!" and "I CAN READ ABOUT" are substantially similar in sound, appearance and connotation. Both marks, when considered in their entireties, engender a substantially similar commercial impression, i.e., that the readers or reader will be able to read about the topic which is the general subject of each book. Such substantial similarity in the overall commercial impression conveyed by the respective marks remains true even if it is assumed-- notwithstanding the notable absence of any evidence in support thereof--that the phrase "CAN READ ABOUT" is highly suggestive or otherwise weak when used in connection with a series of children's books and even though registrant's mark lacks a term, like the word "NATURE" in applicant's mark, which describes or designates the general subject matter of registrant's publications.

In consequence thereof, and keeping in mind the fallibility of a consumer's memory, prospective purchasers of applicant's goods who are acquainted with registrant's "I CAN READ ABOUT" series of children's books, including the many which the record shows are on various nature topics, could readily believe upon encountering applicant's "WE CAN READ ABOUT NATURE!" series of non-fictional nature books for young readers featuring topics on camouflage, habitat, identification of species, and life cycles that such books are indeed part of registrant's series of children's books. Moreover, even if such purchasers

1983); and Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852,

were to notice the differences between applicant's "WE CAN READ ABOUT NATURE!" mark and registrant's "I CAN READ ABOUT" mark, they could still reasonably conclude that the former is a new series of books from the same source as the series of books marketed by registrant and vice versa.

Finally, as to applicant's remaining contention that any likelihood of confusion is dispelled either by the additional matter utilized in displaying the respective marks as actually used in connection with the respective goods or by the fact that it also sells a series of fictional animal character story books for young readers under the mark "WE CAN READ!," suffice it to say that the issue of likelihood of confusion, insofar as the registrability of applicant's mark is concerned, is determined on the basis of such mark and registrant's mark as they are respectively set forth in the application and cited registration. This is because Section 2(d) of the Trademark Act precludes registration of "a mark which so resembles a mark registered in the Patent and Trademark Office ... as to be likely ... to cause confusion" Thus, for instance, the fact that registrant presently appears from the evidence of record to use its "I CAN READ ABOUT" mark in conjunction with a word or words which name specific topical subject matter so as to form the titles of the various publications in its series of children's books is simply irrelevant and immaterial to the issue of likelihood of confusion. See, e.g., Sealy, Inc. v. Simmons Co., 265 F.2d 934, 121 USPQ 456, 459 (CCPA 1959); Burton-Dixie Corp. v. Restonic

860 n. 7 (TTAB 1981).

Corp., 234 F.2d 668, 110 USPQ 272, 273-74 (CCPA 1956); Hat Corp. of America v. John B. Stetson Co., 223 F.2d 485, 106 USPQ 200, 203 (CCPA 1955); and ITT Canteen Corp. v. Haven Homes Inc., 174 USPQ 539, 540 (TTAB 1972). Likewise, the fact that applicant also publishes a series of fictional animal character stories under the mark "WE CAN READ!" and actually uses its "WE CAN READ ABOUT NATURE!" mark in connection with a specific book title for each book in its series is irrelevant and immaterial, insofar as the issue of likelihood of confusion is concerned, inasmuch as the mark which it is seeking to register is "WE CAN READ ABOUT NATURE!" per se rather than with any other wording. See, e.g., Interstate Brands Corp. v. McKee Foods Corp., 53 USPQ2d 1910, 1914-15 (TTAB 2000).

Accordingly, we conclude that purchasers and potential customers, who are familiar or acquainted with registrant's "I CAN READ" mark for its "series of children's books," would be likely to believe, upon encountering applicant's substantially similar "WE CAN READ ABOUT NATURE!" mark for its "non-fictional nature book series for young readers featuring topics on camouflage, habitat, identification of species, and life cycles, and for enabling the reader to build vocabulary and strengthen phonic skills," that such legally identical in part and otherwise closely related goods emanate from, or are sponsored by or associated with, the same source. Consumers would be likely, in particular, to believe either that applicant's "WE CAN READ ABOUT NATURE!" series of non-fictional nature books for young readers are part of registrant's "I CAN RE ABOUT" series of children's

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books or that the former is a new series from the same source as the latter and vice versa.

Decision: The refusal under Section 2(d) is affirmed.