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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Atico International USA Inc.

Serial No. 76/323,759

Peter T. Cobrin of Gibbons, Del Deo, Dolan, Griffinger & Vecchione for Atico International USA Inc.

Steven W. Jackson, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Hohein, Rogers and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On October 10, 2001, Atico International USA Inc. (applicant) filed an application to register the mark BRAIN STORMS (in typed form) on the Principal Register for goods identified as an “electric novelty lamp” in International Class 11.[1]

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[1] Serial No. 76/323,759. The application is based on an allegation of a bona fide intention to use the mark in commerce.

The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of prior registrations for the mark BRAINSTORMS, one in typed form,[2] and the other with the design shown below.[3]

Both registrations are for the virtually identical services of "retail stores and mail order catalog services featuring novelty items[4] and toys" in International Class 35.

When the refusal was made final, applicant filed this appeal.

The examining attorney argues that "[w]ith regard to the cited typed mark, the only difference is the space between the first word and the second." Brief at 4. In the registration that also contained a design, the examining attorney determined that the design did "not

[2] Registration No. 2,344,269, issued April 25, 2000.
[3] Registration No. 2,344,268, issued April 25, 2000.
[4] Registration No. 2,344,269 omits the word "items" in the identification of services. This is apparently a typographical error.

obviate the similarity between the marks." Id. The examining attorney found that the "marks share the same basic meaning and project an identical commercial impression." Id. Regarding the services and goods, the examining attorney found that the "goods of the applicant's type would likely be marketed through retail and mail order services." Brief at 6. The examining attorney also included copies of registrations to show that various services sell lamps, toys, and/or novelty items. The examining attorney concluded that "there is a likelihood of confusion with Registration Numbers 2,344,268 and 2,344,269." Brief at 7.

In response, applicant argues that the examining attorney's evidence is "worthless" and "there is no evidence that registrant sells goods through its BRAINSTORMS retail stores or catalogs under the brand name BRAINSTORMS. That a BRAINSTORMS store may sell novelty lamps does not establish that it sells that lamp under a BRAINSTORMS brand." Brief at 4. In addition, applicant maintains that the "Examining Attorney proffered no marketplace analysis of the competing marks." Brief at 9. Finally, applicant accuses the examining attorney of applying an incorrect likelihood of confusion standard. As

a result, applicant seeks reversal of the refusal to register.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he 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." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We first look at the similarities and dissimilarities of the marks in the application and registrations. The word marks are virtually identical, BRAIN STORMS and BRAINSTORMS. Obviously, the marks would be pronounced identically and they would have the same meaning and commercial impression. The absence of the space does not significantly change the appearance of the marks. Stockpot, Inc. v. Stock Pot Restaurant, Inc., 220 USPQ 52, 54 (TTAB 1983), aff'd, 737 F.2d 1576, 222 USPQ 665 (Fed.

Cir. 1984) ("There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical"); In re Best Western Family Steak House, Inc., 222 USPQ 827, 827 (TTAB 1984) ("There can be little doubt that the marks [BEEFMASTER and BEEF MASTER] are practically identical"). Even the registrant's addition of a light bulb design in one registration does not significantly change the mark because the term "Brainstorms" is still prominently featured and it would be the term customers would use to identify the services. See In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Federal Circuit held that, despite the addition of the words "The" and "Cafe" and a diamond-shaped design to registrant's DELTA mark, there still was a likelihood of confusion). See also In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) (BIGG'S (stylized) for grocery and general merchandise store services found likely to be confused with BIGGS and design for furniture); Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products). Here, the virtually identical nature of the word portion of the marks is a

significant factor in our likelihood of confusion analysis. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) ("Without a doubt the word portion of the two marks are identical, have the same connotation, and give the same commercial impression. The identity of the words, connotation, and commercial impression weighs heavily against the applicant").

Regarding the goods and services, applicant argues that "[t]here is no sufficient relationship between Atico's goods and registrant's services." We note that applicant proposes to use its mark for goods identified as an "electric novelty lamp" and registrant's services include retail store and mail order services featuring novelty items. The question is whether prospective purchasers would be confused when virtually identical marks are used on these goods and services. It is sufficient that the goods and services are related in some manner, or that the circumstances of marketing are such that the branded goods or services are likely to be encountered by persons who would assume some relation or that they emanate from the same source. See, e.g., In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991); In

re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978).

The question then is whether consumers would believe that there is some relationship between the source of the novelty item and the source of the retail store and catalog services featuring novelty items. The Federal Circuit faced a similar question in a case involving the mark "bigg's" (stylized) for "retail grocery and general merchandise store services" and BIGGS and design for furniture.

> The only aspect of this case which is unusual is that the marks sought to be registered are for services while the prior registration on which their registration is refused is for wares. Considering the facts (a) that trademarks for goods find their principal use in connection with selling the goods and (b) that the applicant's services are general merchandising -- that is to say selling -- services, we find this aspect of the case to be of little or no legal significance.

Hyper Shoppes, 6 USPQ2d at 1026.

In this case, the connection between the services of registrant and the goods of applicant is even more direct because registrant's services involve the retail sale of the same type of goods as applicant, as opposed to the stores in the Hyper Shoppes case, that sold a wide variety of merchandise. We agree with the examining attorney's determination that "applicant's goods and registrant's

services are closely related because the goods of the applicant's type would often be sold in connection with services of the registrant's type. Specifically, retail stores featuring novelty items commonly sell novelty lamps. In fact, 'novelty lamps' are within the scope of the plain meaning of 'novelty' items." Brief at 4. Consumers would assume that there is some association or relationship between these goods and services. In addition, the potential customers of applicant and registrant would overlap to the extent that purchasers of novelty lamps at retail would use retail store services or its mail order equivalent. Schieffelin & Co. v. Molson Companies Ltd., 9 USPQ2d 2069, 2073 (TTAB 1989) ("[M]oreover, since there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective products travel in all normal channels of trade for those alcoholic beverages").

In response to the points raised by applicant, we note that the fact that the examining attorney has "specifically proffered no evidence of any company including the name BRAINSTORMS selling any product under an identical or highly similar brand name" (Brief at 7) is simply not necessary to support a finding that the goods and services are related. There is no requirement that the examining

attorney show that registrant is also using the cited mark on goods that are similar to applicant's. It is sufficient, as discussed above, to show that potential customer would likely believe that there is some association or relationship between the goods and services.

Applicant also maintains that the examining attorney's evidence is "worthless." Brief at 4. Again, the identifications of the goods and services themselves, on which we must rely in determining whether there is a likelihood of confusion, demonstrate the relationship between a novelty item and retail services selling novelty items. Nothing in the record contradicts this relationship. To the extent that the examining attorney has submitted additional evidence, it does show not only that businesses sell novelty items in general but also specifically lamps. See www.zowies.com and webwatchdog. Although as indicated above, the best indication of the relationship between applicant's goods and registrant's services is the fact that both the goods and services involve novelty items. The fact that one involves goods and the other services was held by the Federal Circuit "to be of little or no legal significance." Hyper Shoppes, 6 USPQ2d at 1026.

Applicant has referred to other registrations not of record in its reply brief. We do not consider new evidence submitted with appeal briefs. 37 CFR 2.142(d). Furthermore, references to registrations without submitting actual copies of the registrations are not proper evidence. In re Hub Distributing, Inc., 218 USPQ 284, 285 (TTAB 1983)("[W]e do not consider a copy of a search report to be credible evidence of the existence of the registrations and the uses listed therein"). In addition, even if these registrations were properly of record, "the third party registrations relied upon by applicant cannot justify the registration of another confusingly similar mark." In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987), quoting Plus Products v. Star-Kist Foods, Inc., 220 USPQ 541, 544 (TTAB 1983).

Lastly, we address applicant's argument that the examining attorney applied the wrong standard in this case. Applicant accuses the examining attorney of applying a "could be confused" standard, which it submits "is tantamount to the repeatedly rejected 'possibility of confusion' standard." Brief at 8. However, applicant itself states that the examining attorney in the first Office action "refused registration under 15 U.S.C. § 1052(d) on the basis that the proposed mark BRAIN STORMS,

when used in connection with the intended goods, 'so resembles the mark shown in U.S. Registration Nos. 2234268 and 2344269 as to be likely … to cause confusion, or to cause mistake, or to deceive.'" Applicant's Brief at 1-2. Applicant also stated that the examining attorney maintained this refusal to register. Brief at 3. In his appeal brief, the examining attorney maintained that "it is therefore reasonable to believe that the general public would likely assume that the origin of the novelty items and the services are the same. Thus considering the record as a whole, the likelihood of confusion in this case should be deemed substantial. The refusal to register should be affirmed." Brief at 7.

It is clear that the application in this case was refused registration on the ground that there is a likelihood of confusion and not a possibility of confusion. To the extent that there is any confusion about this issue, we emphasize that applicant's mark is refused registration on the ground that if applicant used the mark on its goods, there would be a likelihood of confusion with registrant's marks for the identified services.[5]

[5] The language that applicant refers to as indicating a possibility of confusion may have resulted from the examining attorney addressing the likelihood of confusion issue with a mark that had not been used in commerce.

Decision: The Examining Attorney's refusal to register applicant's mark for an "electric novelty lamp" on the ground that it is likely to cause confusion with the cited registered marks used in connection with the identified services under Section 2(d) of the Trademark Act is affirmed.