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June 11, 2007  
GDH/gdh

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re E.K. Success, Ltd.

Serial No. 76540506

Robert Haroun of Sofer & Haroun, LLP for E.K. Success, Ltd.

Chris Wells, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Hohein, Walsh and Wellington, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

E.K. Success, Ltd. has filed an application to register the mark "COLOR OASIS" on the Principal Register in standard character form for "stickers" in International Class 16.<sup>1</sup>

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "OASIS," which is registered on the Principal Register in standard character form for "posters and stickers" in

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<sup>1</sup> Ser. No. 76540506, filed on August 27, 2003, which is based on an allegation of a bona fide intention to use such mark in commerce. The word "COLOR" is disclaimed.

International Class 16,<sup>2</sup> as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed and briefs have been filed. 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 or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.<sup>3</sup>

Turning first to consideration of the respective goods, it is well settled that the issue of likelihood of confusion must be determined on the basis of the goods as they are respectively set forth in the particular application and the cited registration, and not in light of what such goods are asserted to actually be. See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir.

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<sup>2</sup> Reg. No. 2,327,042, issued on March 7, 2000, which sets forth a date of first use of such mark anywhere of June 1995 and a date of first use of the mark in commerce of March 1996; combined affidavit §§8 and 15.

<sup>3</sup> 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." 192 USPQ at 29.

1990); Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); 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). Moreover, where the goods in the application at issue and in the cited registration are broadly described as to their nature and type, such that there is an absence of any restriction as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of goods encompasses not only all goods of the nature and type described therein, but that the identified goods are provided in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

Here, as is obvious, registrant's goods are identical in part to applicant's goods in that both are identified as "stickers." Based upon the evidence which applicant made of record, which consists of samples of its products (although an amendment to allege use has not been filed) and its catalog, along with printouts from two websites which offer registrant's goods, applicant argues that because registrant's mark also is the name of a rock music band, registrant's stickers and those of applicant "differ in their nature and appearance." In particular, applicant insists that "[t]he essence of Applicant's goods is use in the craft and scrapbooking channels of trade,"

while "[t]he essence of the cited mark's goods is use with the promotion of the musical group 'Oasis' rather than craft products." "Craft stickers," applicant maintains, "are sold in stationary [sic] stores, specialty craft stores, and on stationary [sic] websites, while promotional stickers for rock bands are encountered at concerts and sold in music stores and music websites." Besides asserting that "[t]here is very little overlap between the channels of trade for these stickers," applicant also urges, although notably without any evidentiary support, that:

Scrapbooking is a sophisticated hobby. Those involved in the trade invest time and money into perfecting their scrapbooks and crafts. The customers of stationary [sic] and specialty craft stores are discerning and take the time to analyze the differences between the merchandise.

Music fans are also sophisticated buyers when purchasing band paraphernalia. Such consumers are enthusiasts who examine the merchandise associated with their favorite music group.

In view thereof, applicant contends that confusion as to the source or sponsorship of the respective goods is unlikely inasmuch as:

Applicant's stickers depict decorative designs varying in color and creating the impression of a texture. The stickers bearing the registered mark display the images of the band members and the band name. Applicant's stickers exude a soft impression, while the stickers bearing the cited mark have a harsher appearance and create a more stark impression. A purchaser is not likely to be deceived into thinking that the two sets of stickers emanate from the same source. The stickers used with the mark COLOR OASIS are artful creations invoking the feel of various beach retreats. Applicant's

goods are unrelated to the goods connected to the cited mark and it is unlikely that the owner of the cited mark will expand into the craft supplies market [served by applicant]. Due to the different nature of the goods at issue, it is unlikely that a consumer would think that the manufacturer of the stickers related to the hard rock band were also the manufacturers of Applicant's decorative design stickers. Although ... both marks recite stickers as goods, the stickers are of such a different character when encountered in the marketplace ... that a likelihood of confusion as to source is improbable.

The Examining Attorney, however, correctly points out in his brief that, as identified, applicant's and registrant's "stickers" must be considered legally identical goods. Among other things, he properly observes that "[n]o limitation appears in registrant's identification of goods" and, we note, the same is likewise the case with applicant's identification of goods. Accordingly, both applicant's and registrant's "stickers" encompass in legal contemplation all goods of the type described. Such goods would consequently be sold through the same channels of trade, including stationery stores and various other retail environments, to the identical classes of purchasers, including members of the general public who lack any expertise in the field as well as rock music fans seeking promotional items concerning their favorite bands. Conditions are therefore such that, if applicant's and registrant's stickers were to be offered under the same or similar marks, confusion as to the origin or affiliation of such goods would be likely to occur.

Turning, then, to consideration of the respective marks, applicant maintains that its "COLOR OASIS" mark is not similar to registrant's "OASIS" mark in sight, sound, meaning or

commercial impression. Viewed in their entireties and citing *du Pont, supra*, applicant insists that "all components [of the marks at issue] must be given appropriate weight," including any disclaimed portion, "since the public will not be aware of the disclaimer when considering the mark," and that "[t]here is no dominant part of a ... mark [which is] sought to be registered in plain block letters." Applicant, in light thereof, specifically asserts that:

Applicant's mark COLOR OASIS differs from the cited mark OASIS when viewed as a whole, in sound, appearance and meaning. The two marks differ in sound in that the cited mark contains one term, OASIS and Applicant's mark is comprised of two words COLOR and OASIS. Applicant's mark and the cited mark differ in appearance as well, since the subject mark appears as two words, COLOR and OASIS and the cited mark is merely one word. Applicant's mark, COLOR OASIS, refers to a sanctuary filled with various beautiful colors and textures. The cited mark refers to the name of a musical band and does not conjure the image of a color or textured filled haves. Hence the two marks differ in meaning as well.

We agree with the Examining Attorney, however, that applicant's "COLOR OASIS" mark is sufficiently similar to registrant's "OASIS" mark that confusion would be likely, especially since such marks are for use in connection with legally identical goods. As stated by 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), "[w]hen marks would appear on virtually identical goods ..., the degree of similarity necessary to support a conclusion of likely confusion declines." We also

observe that while applicant is correct that, under *du Pont, supra*, the marks at issue must be considered in their entirety and, thus, any descriptive term therein cannot be ignored, the Examining Attorney properly points out in his brief that such authority lends no support to applicant's further contention that "[t]here is no dominant part of a ... mark [which is] sought to be registered in plain block letters," as is the case with applicant's mark. To the contrary, we note, as does the Examining Attorney, that our principal reviewing court has indicated that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entirety." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "[t]hat a particular feature is descriptive ... with respect to the involved goods ... is one commonly accepted rationale for giving less weight to a portion of a mark" and that, "[i]ndeed, this type of analysis appears to be unavoidable." *Id.* In light of applicant's admission that its "stickers depict decorative designs varying in color" and, thus, that the word "COLOR" is descriptive of its goods, as further evidenced by its disclaimer thereof, we concur with the Examining Attorney that "[i]n this instance, the term OASIS is clearly the dominant feature of applicant's mark in that the remaining term [COLOR] is descriptive and, by itself, not an indicator of

source." Such feature, of course, is identical in all respects to registrant's "OASIS" mark.

The Examining Attorney additionally argues in his brief that "[t]he mere addition of a term to a registered mark is not sufficient to overcome a likelihood of confusion," citing *inter alia* TMEP Section 1207.01(b)(iii) (4th ed. 2005), which states that:

It is a general rule that likelihood of confusion is not avoided between otherwise confusingly similar marks merely by adding ... a house mark or matter that is descriptive or suggestive of the named goods or services. .... See, e.g., ... *In re Apparel Ventures, Inc.*, 229 USPQ 225 (TTAB 1986) (SPARKS BY SASSAFRAS (stylized) for clothing held likely to be confused with SPARKS (stylized) for footwear); ... [and] *In re Riddle*, 225 USPQ 630 (TTAB 1985) (RICHARD PETTY'S ACCU TUNE and design for automotive service stations held likely to be confused with ACCUTUNE for automotive testing equipment).

Exceptions to the above stated general rule regarding additions ... to marks may arise if: (1) the marks in their entirety convey significantly different commercial impressions, or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted. ....

In this case, applicant has in essence simply added the descriptive term "COLOR" to registrant's "OASIS" mark. The word "OASIS," as used in connection with stickers, is clearly arbitrary rather than suggestive or descriptive and, on this record, has not been shown to be diluted or otherwise in such widespread use that, as to its source-indicative significance, customers for stickers would distinguish marks which include the term "OASIS" by the remaining portions thereof. Thus, in light

of the fact that the marks at issue have in common the arbitrary term "OASIS," it is plain that, in their entireties, applicant's "COLOR OASIS" mark and registrant's "OASIS" mark are not only substantially similar in appearance, sound and connotation, but such marks also are substantially similar in overall commercial impression.

We accordingly conclude that, due to the shared arbitrary term "OASIS," customers and prospective purchasers who are familiar or acquainted with registrant's "OASIS" mark for "stickers" would be likely to believe, upon encountering applicant's substantially similar "COLOR OASIS" mark for "stickers," that such legally identical goods emanate from, or are sponsored by or associated with, the same source. In particular, consumers could reasonably believe that applicant's "COLOR OASIS" mark designates a new or expanded line of stickers from the same source as the stickers marketed under registrant's "OASIS" mark.

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