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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Stephen Wild

Serial No. 76580478

Myron Amer of Myron Amer, P.C. for Stephen Wild.

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(Andrew Lawrence, Managing Attorney).

Before Holtzman, Rogers, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On March 10, 2004, applicant Stephen Wild applied to register on the Principal Register the mark COLD DOG in standard character form for goods ultimately identified as "bulk ice cream" in Class 30. The application (No. 76580478) was based on an allegation of a bona fide intent 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 a prior registration for

the mark COOL DOG in standard character form for "frozen confections; candy; flavored ices containing small pieces of fruit; dessert food products for sale to food services and retail companies, namely ice cream, ice milk and frozen yogurt; frozen ice cream novelties; frozen flavored ices; frozen fruit bars; muffins; cakes" in Class 30.¹

The examining attorney maintains that the "mark COLD DOG gives the same meaning and connotation as COOL DOG because the marks both end with the term DOG and the terms COLD and COOL are synonymous." Brief at 3. Regarding the goods, the examining attorney points out that applicant's goods are identified as "bulk ice cream" and registrant's goods include "ice cream" so the goods would be "exactly the same" and the registrant's other goods would be closely related. Brief at 4. Applicant argues that the marks are "sufficiently dissimilar in sound, appearance and meaning ... to obviate any likelihood of confusion." Brief at 1. Applicant notes that "cool" can be defined as "socially adept" and therefore the marks "have different connotations or meanings, and this difference in conjunction with different pronunciations and appearances lead away from customer confusion." Brief at 2. When the examining attorney maintained the refusal, this appeal followed.

¹ Registration No. 2,565,648, issued April 30, 2002.

In likelihood of confusion cases, we consider the facts in relation to the thirteen factors discussed 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). More specifically, the Court of Customs and Patent Appeals, one of the predecessors of the Court of Appeals for the Federal Circuit, explained 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 begin our analysis by examining the similarities and dissimilarities of the marks. We consider whether the marks are similar in sound, appearance, meaning, and commercial impression. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Applicant’s mark is COLD DOG and the cited registration is for the mark COOL DOG. Neither mark is depicted as a stylized or design mark so the point of comparison is simply the words themselves.

Each mark consists of two words and one, "dog," is common to both marks. The initial word in applicant's mark is "cold" while the word "cool" is the first word in registrant's mark. The examining attorney quotes from *The American Heritage Dictionary of the English Language* entry under "cold": "Synonyms: *cold, arctic, chilly, cool, frigid, frosty, gelid, glacial, icy*. The central meaning shared by these adjectives is 'marked by a low or extremely low temperature': *cold air; an arctic climate; a chilly day; cool water; a frigid room; a frosty morning; gelid seas; glacial winds; icy hands*." Final Office Action at 2.

Applicant argues that whether "COOL is a synonym of COLD is an insignificant matter at best only because of the improper dissection. Of greater significance is that in the combination COOL DOG, the word COOL has the apt and more appropriate meaning of 'socially adept ... an executive noted for maintaining her cool under pressure' wherein the reference to DOG in the mark is understood to be her in the explanatory dictionary phrase quoted." Brief at 2 (emphasis omitted).²

² The examining attorney discusses applicant's definition and we take judicial notice of it. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

In addition to these dictionary references, we take judicial notice of the following definitions from *The American Heritage Student Dictionary* (1998):

Cold - Having a low temperature: *cold water; a cool day.*

Cool - Moderately cold; neither warm nor very cold: *cool fall weather.*

We begin by noting that both "cold" and "cool" have similar meanings to the extent that they both indicate "having a low temperature" although the meaning of cool would indicate that the low temperature would not be "very cold." We are also aware that, as common words in the English meaning, "cool" and "cold" have numerous other meanings. For example, "cold" can mean "aloof," "unconscious," and "without preparation or prior warning" and "cool" can mean "disdainful," "excellent," and "full." Id. However, both applicant's and registrant's goods include ice cream and other frozen confections so the definitions referring to low temperature are likely to be the ones that prospective purchasers associate with the marks. Therefore, the meaning of the mark is likely to be a reference to the low temperature associated with the "dog" and not to the dog being "socially adept."

Regarding the appearance and sound of the marks, both marks have the common second word "dog." In addition, the

first words, "cool" and "cold," have several similarities. Both words contain four letters and begin with the letters "co-" and have a third common letter, "l." While the marks do not sound very similar, the appearances of the marks are somewhat similar.

We also hold that the commercial impressions of the marks are very similar. Andrew Jergens Co. v. Sween Corp., 229 USPQ 394, 396 (TTAB 1986) ("`GENTLE TOUCH' and `KIND TOUCH' convey the same commercial impression"); Watercare Corp. v. Midwesco-Enterprises, Inc., 171 USPQ 696, 701 (TTAB 1971) ("`AQUA-CARE' and `WATERCARE' engender the identical commercial impression"). The word "dog" is an unusual term used in association with ice cream.³ "Cool" and "Cold" can both describe something that is "moderately cold" and their difference is simply a matter of degree, i.e., cold could indicate more intense cold than cool. This small degree of difference between the words is likely to suggest a common source rather than different sources for the goods.

³ With its Reply Brief, applicant has submitted sketches of its ice cream product in the shape of a hot dog. We will not consider this new evidence submitted for the first time on appeal. 37 CFR § 2.142(d). However, even if as applicant submits, its product is "a likeness to [a] frankfurter in a roll" (Reply Brief at 1), it is not clear why this would eliminate the likelihood of confusion. While the term "dog" would then probably be highly suggestive, costumers would still likely assume that these products had a common source.

Ultimately, we must determine whether the marks in their entirety are similar. In this case, we hold that the marks COLD DOG and COOL DOG are very similar. Prospective purchasers encountering these marks would understand that the marks are a play on the term "Hot Dog." To the extent that prospective purchasers would notice the difference between "cold" and "cool," they are likely to believe that they are slightly different versions of ice cream products from the same source.

In addition, while the words "cool" and "cold" are synonyms, this fact by itself does not demonstrate that the marks are similar. The examining attorney's dictionary excerpts indicate that artic, frigid, frosty, gelid, and glacial are also synonyms of cold. Obviously, whether these other synonyms used with "dog" would be confusingly similar to COOL DOG is an open question. In this case, however, not only are "cool" and "cold" synonyms, their meanings overlap, their appearances are similar, and their commercial impressions are very similar. Thus, we conclude that these marks, considered in their entireties, are similar.

Next, we must compare the similarities and dissimilarities in applicant's and registrant's goods. Applicant's goods are "bulk ice cream." Registrant's goods

include "ice cream." We must compare the goods as they are described in the identification of goods. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). We must also assume that the goods in the registration encompass "all goods of the nature and type described." In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). Indeed, the registrant's goods specifically include dessert food products for sale to food services and retail companies, namely, ice cream, ice milk and frozen yogurt. Dessert food products for sale to food services and retail companies, namely, ice cream would include bulk ice cream. Furthermore, bulk ice cream would also be closely related to registrant's frozen confections and flavored ices containing small pieces of fruit.

Also, to the extent that the goods are in part identical and otherwise closely related, we must assume that the channels of trade and prospective purchasers are the same. Genesco Inc. v. Martz, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be

offered and sold to the same classes of purchasers through the same channels of trade"); In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers"). Therefore, applicant's and registrant's ice cream would move through the identical channels of trade.

Regarding the sophistication of purchasers, we are aware that applicant's goods are described as "bulk ice cream." To the extent that the purchasers of these goods may be institutional buyers or at least not ordinary purchasers, we do not find that this factor eliminates the likelihood of confusion. Institutional buyers are not infallible or necessarily able to distinguish very similar marks used on identical goods. Here, even institutional buyers would not be expected to appreciate the difference between registrant's and applicant's marks when they encounter them for ice cream at different times.

Furthermore, even if they did remember the difference in the marks, it is not clear that they would appreciate that the sources of ice cream bearing these marks were also different. See In re Hester Industries, Inc., 231 USPQ 881, 883 (TTAB 1986) ("While we do not doubt that these institutional purchasing agents are for the most part

sophisticated buyers, even sophisticated purchasers are not immune from confusion as to source where, as here, substantially identical marks are applied to related products").

When we consider the record in light of the likelihood of confusion factors, we conclude that confusion is likely in this case. The goods are in part identical and when "marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992). The marks are also very similar with the only difference being the emphasis on the greater degree of coldness in applicant's mark (cold v. cool). When prospective purchasers encounter the marks COOL DOG and COLD DOG used in connection with ice cream, it is likely that they would assume that the goods originate from or are associated in some way with a common source.

Decision: The examining attorney's refusal to register applicant's mark on the ground that it is likely to cause confusion with the cited registered mark used in connection with the identified goods under Section 2(d) of the Trademark Act is affirmed.