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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Worldwise, Inc.

Serial No. 76602722

Michael E. Dergosits of Dergosits & Noah LLP for Worldwise, Inc.

Charles G. Joyner, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Hairston, Grendel and Holtzman, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark FISHBONZ (in standard character form) for goods identified as "cat toys."[1]

The Trademark Attorney has issued final refusals of registration on two grounds, i.e., mere descriptiveness under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1),

[1] Serial No. 76602722, filed July 19, 2004. The application is based on use in commerce, and January 13, 2003 is alleged to be

and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. §1052(d). We shall address the mere descriptiveness refusal first.

MERE DESCRIPTIVENESS

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *See, e.g., In re Gyulay,* 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp*., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. *See In re H.U.D.D.L.E.,* 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it

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the date of first use anywhere and the date of first use in commerce.

is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd*., 204 USPQ 591, 593 (TTAB 1979). Moreover, it is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc*., 64 USPQ2d 1314, 1316-17 (TTAB 2002). *See also In re Patent & Trademark Services Inc*., 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985).

We agree with the Trademark Examining Attorney's contentions that applicant's mark, FISHBONZ, is merely a misspelling of and thus is legally equivalent to the words FISH BONES; that FISH and BONES are defined as, and taken together would be understood to mean, a fish skeleton; and that FISH BONES or FISHBONZ is merely descriptive of a feature or characteristic of applicant's goods, i.e., their shape or appearance. In support of this last contention,

the Trademark Examining Attorney has made of record printouts from several pet toy retailer websites (hartz.com, cattoys.com, and petsmart.com) which show that cat toys often take the shape of various animals, such as mice, dogs, birds, etc., including toys shaped like fish.

Based on this evidence, we find that applicant's cat toy, is or could be (consistent with the identification of goods), shaped like a fish skeleton, be imprinted with the design of a fish skeleton, or otherwise have the appearance of fish skeleton. FISHBONZ, the legal equivalent of FISH BONES, merely describes this feature or characteristic of applicant's cat toys, i.e., their shape or appearance, and thus is merely descriptive of applicant's goods. *See, e.g., J. Kohnstam, Ltd. v. Louis Marx & Co*., 280 F.2d 547, 126 USPQ 362 (CCPA 1960)(MATCHBOX SERIES merely descriptive of toys sold in boxes having the size and appearance of matchboxes); *In re Metcal Inc*., 1 USPQ2d 1334 (TTAB 1986)(SOLDER STRAP merely descriptive of self-regulating heaters in form of flexible bands or straps); *In re H.U.D.D.L.E.,* 216 USPQ 358 (TTAB 1982)(TOOBS, the phonetic equivalent of "tubes," merely descriptive of bathroom and kitchen fixtures in the shape of tubes); and *In re Ideal Industries, Inc*., 134 USPQ 416 (TTAB 1962)(WING NUT

descriptive of electrical connecters shaped like a wing nut).

LIKELIHOOD OF CONFUSION

The Trademark Examining Attorney also has refused registration on the ground that applicant's mark, as applied to the goods identified in the application, so resembles two previously-registered marks (owned by a single owner) as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d). The first cited registration is of the mark FISHBONE (registered in standard character form) for a wide variety of goods in Class 28 including the goods cited by the Trademark Examining Attorney, i.e., "dog toys."[2] The second

[2] Registration No. 2774308, issued on October 21, 2003 pursuant to Trademark Act Section 44, U.S.C. §1126. The Class 28 goods identified in the cited registration are "games and playthings, namely dolls, bath toys, crib toys and pop up toys, stuffed toys, dog toys, plush toys, soft sculpture toys, talking toys, inflatable toys, gymnastic articles, namely gymnastic apparatus, horizontal and parallel bars, vaulting horses and training stools; sporting articles for climbing, golfing, surfing, sailing, diving, mountain skiing, cross-country skiing, snowboarding, and ice-hockey, namely surf fins, ski poles, climbing equipment, namely climbing ropes, nuts, expanders, chucks, carabiners, and pitons, golf balls, golf clubs, golf tees, golf gloves, golf bags, non-motorized golf carts, surf boards, surfboard leashes, surfboard wax, sail boards, sail board masts, sail board leashes, flippers for use in scuba diving, ice-hockey sticks, skis, ski goggles, and snowboards; ski bags, special bags in order to store and transport ski gear and snowboards; gloves for climbing, horseback riding, skiing, boxing, rowing and canoeing." The registration also includes various goods in Class 25.

cited registration is of the mark depicted below (hereinafter "FISHBONE and design"), for goods identical to those in the first cited registration, including "dog toys."[3]

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Company, Inc.,* 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

[3] Registration No. 2760570, issued on September 9, 2003 pursuant to Trademark Act Section 44.

We turn initially to the first *du Pont* factor, i.e., whether applicant's mark, FISHBONZ, and the cited registered marks, FISHBONE and FISHBONE and design, are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles.

The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In terms of appearance, we find that applicant's mark is similar to the cited standard character mark FISHBONE, and to the literal portion of the FISHBONE and design mark, to the extent that the registered marks begin with the letters FISHBON. Each of the marks is displayed as a single compound term. Applicant's mark and the cited registered marks are dissimilar to the extent that registrant's marks ends with an "E" while applicant's mark ends with an "Z." Applicant's mark also is dissimilar to the FISHBONE and design mark to the extent that the registered mark, but not applicant's mark, includes the design of a fish skeleton. However, the fish skeleton design element of the cited registered mark is but the pictorial representation of applicant's FISHBONZ mark. Viewing the respective marks as a whole, we find that the similarity which arises from the presence of their use of the letters FISHBON outweighs the points of dissimilarity.

In terms of sound, we find that the marks are essentially identical. Applicant's mark FISHBONZ is the legal equivalent of the term "fish bones." Although applicant's mark would be pronounced as the plural "fish bones" while the cited registered marks would be pronounced as the singular "fish bone," that difference is insufficient, in itself, to distinguish the marks in terms

of sound, when the marks are considered in their entireties.

In terms of connotation, we find that applicant's mark FISHBONZ is the legal equivalent of, and would be understood to mean, "fish bones," or the skeleton of a fish. The cited registered FISHBONE mark, although it would be understood to refer to a single fish bone rather than to an entire fish skeleton, is close enough to the meaning of the plural FISHBONZ or "fish bones" that the marks must be deemed to be similar rather than dissimilar in terms of connotation. That similarity is even more pronounced when we compare applicant's mark to the cited FISHBONE and design mark. That mark's pictorial representation of a fish skeleton would be understood as connoting the same thing that applicant's mark connotes, i.e., a fish skeleton.

In terms of overall commercial impression, we find that applicant's mark and each of the cited registered marks are similar rather than dissimilar. Each of the marks brings to mind the bones of a fish. As noted above, the appearance of the fish skeleton feature of the cited FISHBONE and design mark merely reinforces the similarity between that mark and applicant's mark. Also as noted above, each of the marks is presented as a compound word.

The points of dissimilarity, i.e., applicant's misspelling of the words "fish bones" as FISHBONZ, and applicant's use of the plural rather than the singular, do not suffice to distinguish applicant's mark from the cited registered marks.

For the reasons discussed above, we find that the applicant's mark is similar to each of the cited registered marks, and that the first *du Pont* factor weighs in favor of a finding of likelihood of confusion. We are not persuaded by applicant's arguments to the contrary.

We turn next to the second *du Pont* factor, i.e., the similarity or dissimilarity of the respective goods, i.e., the "cat toys" identified in applicant's application and the "dog toys" identified in the cited registrations.

It is settled that it is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. That is, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. It is sufficient that the goods be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken

belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods. *See 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); and *In re International Telephone & Telegraph Corp*., 197 USPQ 910 (TTAB 1978).

The Trademark Examining Attorney has made of record printouts from four third-party websites (busypettoys.com, hartz.com, kongcompany.com, and petsmart.com) showing that cat toys and products and dog toys and products are retailed by a single source. The Trademark Examining Attorney also has made of record printouts of fifteen third-party registrations[4] which include, in their respective identifications of goods, both "dog toys" and "cat toys." Although such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that the

[4] The Trademark Examining Attorney submitted seventeen third-party registrations in all, but we have not considered two of them. One of them is based on Trademark Act Section 44 and therefore is not evidence of use of the mark in this country. The other registration likewise is not evidence that the mark is used on the relevant goods in commerce, because the relevant goods have been deleted from the registration.

goods listed therein are of a kind which may emanate from a single source under a single mark. *See In re Albert Trostel & Sons Co.,* 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc*., 6 USPQ2d 1467 (TTAB 1988).

Based on this evidence, we find that "cat toys" and "dog toys" are related goods, and that the second *du Pont* factor weighs in favor of a finding of likelihood of confusion. We are not persuaded by applicant's arguments to the contrary.

Because neither applicant's nor registrant's respective identifications of goods are limited or restricted in any way, we must presume that their respective goods are marketed in all normal trade channels and to all normal classes of purchasers for such goods. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). We find that the trade channels for applicant's and registrant's goods are overlapping, and would include pet stores and supermarkets (where the respective goods are likely to be offered for sale in the same aisle). We also find that the classes of purchasers for the goods would be the same, i.e. ordinary consumers. It is not uncommon for such consumers to have both dogs and cats as pets. Finally, we find that dog toys and cat toys are inexpensive items that are likely to be purchased on impulse. Based on these findings, we find

that the third and fourth *du Pont* evidentiary factors weigh in favor of a finding of likelihood of confusion.

Having considered all of the *du Pont* factors relevant to this case, we conclude that a likelihood of confusion exists. Purchasers familiar with dog toys sold under registrant's marks are likely to assume that cat toys sold under applicant's mark originate from the same or a related source. To the extent that any doubts might exist as to the correctness of this conclusion, we resolve such doubts against applicant. *See In re Hyper Shoppes (Ohio) Inc.,* 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.,* 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusals to register under Trademark Act Section 2(e)(1) and 2(d) are affirmed.