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Mailed:
Aug. 29, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Shalom International, Inc.

Serial No. 76666376

Joseph Sutton of Ezra Sutton, P.A. for Shalom
International, Inc.

Benji Paradewelai, Trademark Examining Attorney, Law Office
101 (Ronald R. Sussman, Managing Attorney).

Before Grendel, Cataldo and Bergsman, Administrative
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Shalom International, Inc., applicant herein, seeks
registration on the Principal Register of the mark FAB
FRIENDS (in standard character form) for goods identified
in the application as "hair accessories, namely, hair

clips, pony tail holders, barrettes, and head bands," in Class 26.¹

At issue in this appeal is the Trademark Examining Attorney's final refusal to register applicant's mark on the ground that the mark, as applied to the goods identified in the application, so resembles the mark FAB FRIENDS, previously registered (in standard character form) for Class 16 goods identified in the registration as

printed materials, namely, stickers, sticker albums and books, notebooks, folders, binders, organizers for stationery and personal organizers, stationery-type portfolios, writing pads, memo pads, stationery, pencils, pencil cases, pencil sharpeners, pens, markers, coloring books, diaries, greeting cards, arts and crafts painting and drawing kits, and paper party goods, namely hats, invitations, napkins, tablecloths, streamers, confetti, and paper noisemakers,

as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

After careful consideration of the evidence of record and the arguments of counsel, we affirm the refusal to register.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in

¹ Serial No. 76666376, filed on September 21, 2006. The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a). January 2002 is alleged in the

evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The first *du Pont* factor requires us to determine the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc.*, *supra*. Here, applicant's mark FAB FRIENDS is identical to the cited registered mark FAB FRIENDS in terms of appearance, sound, connotation and commercial impression. Accordingly, we find that the first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

The second *du Pont* factor requires us to determine the similarity or dissimilarity of the goods as identified in the application and in the cited registration. It is settled that it is not necessary that the goods be

application to be the date of first use of the mark anywhere and the date of first use of the mark in commerce.

identical or even competitive in order to find that the goods are related for purposes of our likelihood of confusion analysis. 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. See *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). 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). Finally, in cases such as this where the applicant's mark is identical to the cited registered mark, there need be only a viable relationship between the respective goods in order to find that a likelihood of confusion exists. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Opus One Inc.*, 60

USPQ2d 1812 (TTAB 2001); and *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

The Trademark Examining Attorney has made of record two use-based third-party registrations which include in their identifications of goods both hair accessories like those identified in applicant's application and stationery and party items like those identified in the cited registration. 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 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).²

In response to the Trademark Examining Attorney's third-party registration evidence, applicant has submitted printouts of three listings of third-party registrations obtained from www.trademark.com. These lists identify the third-party registrations only by number, status and mark. According to applicant, the lists show that there are

² The third third-party registration submitted by the Trademark Examining Attorney is a Section 44 registration which is not based on use in commerce, and which therefore is not probative under *Trostel* and *Mucky Duck*.

18,223 third-party registrations in Class 16 for goods like those identified in the cited registration, 792 third-party registrations in Class 26 for goods like applicant's, and 104 third-party registrations which cover goods in both Class 16 and Class 26. Applicant argues that this evidence proves that out of the total of 19,015 third-party registrations for goods in Class 16 and in Class 26, only 104, or less than one percent, include in their identifications goods in both Class 16 and Class 26.

We sustain the Trademark Examining Attorney's objection to this purported third-party registration evidence submitted by applicant. Third-party registrations may not be made of record by submitting merely a list of them from commercial search services. *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1560 n.6 (TTAB 1996).³

Additional evidence in the record shows that hair accessories like applicant's and stationery and party items like registrant's are types of goods which may emanate from

³ Additionally, applicant's novel argument based on the alleged total numbers and percentages of registrations in the respective classes is completely unpersuasive and unsupported by any authority. Thus, even if the third-party registrations had been properly made of record, we find that they would have had little or no probative value. Moreover, if in fact there are 104 third-party registrations covering pertinent goods in both Class 16 and Class 26, such evidence would weigh heavily in favor of a finding of likelihood of confusion under *Trostel* and *Mucky Duck*.

or be associated with a single source. The website www.cartoonfans.club.com shows that hair accessories and stationery items both are types of collateral goods which are sold in connection with Disney and Nickelodeon cartoon characters like Winnie the Pooh and Dora the Explorer. The website www.hairboutique.com offers for sale a "Diva Club" product consisting of a "Mini Journal Notebook with Lip Gloss, Glitter and Hair Clip." The website www.hairutopia.com informs purchasers that "We are a leading manufacturer and have the world's largest selections of fashion accessories, hair accessories, personal care, bath and body, cosmetics, novelties, jewelry and stationery."

Based on this evidence, we find that applicant's hair accessory products and registrant's stationery and party supply products are related, for purposes of the second *du Pont* factor. As noted above, because applicant's mark is identical to the cited registered mark, there need be only a viable relationship between the respective goods in order to find that a likelihood of confusion exists. See *In re Shell Oil Co.*, *supra*; *In re Opus One Inc.*, *supra*. We find that the evidence of record suffices to establish the requisite viable relationship between the respective goods

in this case. The second *du Pont* factor weighs in favor of a finding of likelihood of confusion.

The third *du Pont* factor requires us to consider the similarity or dissimilarity of the trade channels in which applicant's and registrant's respective goods are marketed. The Trademark Examining Attorney has submitted printouts from nine third-party websites from which a purchaser may purchase both hair accessories and stationery and party products. These are: www.claire.com; www.limitedtoo.com; www.sanrio.com; www.hairboutique.com; www.hairutopia.com; www.thefrogstore.com; www.partyamerica.com; www.cartoonfans.club.com; and www.discountpartysupply.makesparties.com. Applicant argues that its type of goods and the registrant's type of goods are offered for sale on different pages of the websites and that the websites therefore are like large department stores in which many different types of goods are sold in different departments without causing a likelihood of confusion. We find, however, that the fact that the respective goods might appear on different pages of the website is not dispositive; the respective goods are only a mouse click away from each other. Moreover, as the Trademark Examining Attorney persuasively argues, these websites are not like large department stores, but rather

are largely the websites of smaller, boutique retailers marketing specifically to young girls and teenagers.

Based on this evidence, we find that applicant's type of goods and registrant's type of goods are or would be marketed in similar and overlapping trade channels. The third *du Pont* factor accordingly weighs in favor of a finding of likelihood of confusion.

Under the fourth *du Pont* factor, we consider evidence pertaining to the conditions under which applicant's and registrant's respective goods are purchased. The record shows that these goods are inexpensive products purchased by ordinary purchasers, including children. They would not necessarily be purchased with a significant degree of care or sophistication. We find that the fourth *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Considering all of the evidence of record as it pertains to the relevant *du Pont* factors, we conclude that applicant's use of the mark FAB FRIENDS on hair accessories and registrant's use of the identical mark on stationery and party items is likely to result in confusion as to source, sponsorship or affiliation. To the extent that any doubts might exist as to the correctness of this conclusion, we resolve such doubts against applicant. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed.

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Cir. 1993); *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.*, *supra*.

Decision: The refusal to register is affirmed.