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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Juan Pedro Quesada Samper and Gloria Pina Morales

Serial No. 78387617

Charles P. LaPolla of Ostrolenk, Faber, Gerb & Soffen, LLP
for Juan Pedro Quesada Samper and Gloria Pina Morales.

Dominick J. Salemi, Trademark Examining Attorney, Law
Office 106 (Mary Sparrow, Managing Attorney).

Before Hairston, Walsh and Cataldo, Administrative
Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On March 19, 2004, Juan Pedro Quesada Samper and
Gloria Pina Morales (Applicants)¹ filed an application to
register the mark EXCITE CAT in standard-character form on
the Principal Register for goods identified as "boats" in
International Class 12. Applicants filed both based on
their bona fide intention to use the mark in commerce under

¹ The individuals named appear to be joint applicants although
the application does not specify so and the Examining Attorney
did not request clarification.

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Trademark Act Section 1(b), 15 U.S.C. § 1051(b), and based on their ownership of a foreign registration for the mark under Trademark Act Section 44(e), 15 U.S.C. § 1126(e). Applicants have disclaimed "CAT."

The Examining Attorney has refused registration under the Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with the mark in Reg. No. 2844275, shown below, for goods identified as "boats" in International Class 12.



The registration issued on May 25, 2004; it claims both first use anywhere and first use of the mark in commerce on May 25, 2002.

Applicants responded to the refusal; the Examining Attorney made the refusal final; and Applicants filed this appeal. Applicants and the Examining Attorney have filed briefs; Applicants did not request an oral hearing. We affirm.

THE LIKELIHOOD OF CONFUSION REFUSAL

Section 2(d) of the Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion . . ." Id. The opinion in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977) sets forth the factors we may consider in determining likelihood of confusion. Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the goods of the Applicants and registrant. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."). Below we will discuss all factors as to which Applicants or the Examining Attorney argued or presented evidence.

Comparison of the Goods

Applicants have not said a word regarding the goods. In point of fact, the goods of Applicants and the goods in the cited registration are absolutely identical. Both the

application and the registration identify the goods simply as "boats." Of course, in comparing the goods, we must consider the goods as identified in the application and registration. CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991). In addition, if the goods are identical, as is the case here, we must also assume that the channels of goods of Applicants and registrant are likewise identical.

Accordingly, we conclude that the goods and the channels of trade for the goods of Applicants and registrant are identical. Furthermore, we note that, "the degree of similarity [between the marks] necessary to support the conclusion of likely confusion declines" when the goods are identical. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), cert. denied, 506 U.S. 1034 (1992).

Comparison of the Marks

To determine whether the marks are confusingly similar, we must consider the appearance, sound, connotation and commercial impression of each mark. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Applicants first argue that the Examining Attorney failed to give sufficient consideration to the disclaimed term "CAT" in determining whether the marks are similar. Applicants argue more broadly that the Examining Attorney improperly dissected the marks rather than considering them in their entirety. Applicants state:

Taken in its entirety, Applicant's mark EXCITE CAT has a completely different pronunciation, commercial impression and appearance than the cited registration for XCITE and Design. Applicant's mark is a combination of two full words, separately pronounced. The cited registration, however, consists of a single word fragment expressed in a highly distinctive design style in which the "X" is capitalized as the term "cite" remains in lower case while being underlined. As such the cited mark could also have different connotations. For example, the emphasis on the letter "X" may lead some purchasers, particularly men, to believe that the boat they are purchasing will create some form of sexual prowess for the owner. Others could perceive the term "CITE" in the cited mark as having the connotation of "SIGHT" thereby making the mark into the equivalent of "X Sight."

The Examining Attorney, on the other hand, argues that "CAT" is a generic term, and as such, nondistinctive and less important in evaluating the commercial impression of Applicants' mark.

In evaluating the similarity of the marks, we first take note of the significance of "cat" in this context. With his brief, the Examining Attorney had provided a definition from an on-line dictionary indicating that in the "nautical" context "cat" means "catamaran." We decline

to rely on that definition but instead take judicial notice of the definition of "cat" from Merriam-Webster's Collegiate Dictionary (11th ed. 2003) which defines "cat" as "4a : CATBOAT b : CATAMARAN." For completeness, the same dictionary defines "catamaran" as "a vessel (as a sailboat) with twin hulls and usu. a deck or superstructure connecting the hulls."² Accordingly, we conclude that "cat" is, in fact, a generic name for a type of boat. We reject Applicants' assertion that the public would not recognize "cat" as a generic term. The relevant public here are potential purchasers of boats. We believe they would recognize this generic term when applied to a boat.

In viewing the marks in their entirety, we conclude that the marks are similar in appearance, sound, and most conspicuously in connotation and commercial impression.

In concluding so, we view the marks in the entirety, but we recognize that the generic term "cat" is less significant than the dominant literal element "EXCITE" in Applicants' mark. Similarly we conclude that the literal

² We take judicial notice of this dictionary definition. University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). The Board will not take judicial notice of materials from dictionaries which are only available on-line. In re Total Quality Group Inc., 51 USPQ2d 1474, 1476 (TTAB 1999).

element "XCITE" is dominant and of greater importance than the design elements in the registered mark. We also conclude that the dominant literal element in the marks, "EXCITE" and "XCITE" are phonetic equivalents.

Applicants have argued at length that we should accord greater importance to "cat" in their own mark and to the design elements in the registered mark. However, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks than to the less distinctive elements in determining whether the marks are similar. As the Court of Appeals for the Federal Circuit observed, ". . . in articulating reasons for reaching a conclusion on the issue 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 the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Generic terms and design elements, such as those at issue here, are generally of less importance in determining whether marks are similar. See In re Dixie Restaurants, Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997)

Also, while Applicants contrast their mark with the display of the registered mark, we note that Applicants' mark is displayed in standard-character form. When a mark is displayed in standard-character form we must consider all reasonable manners in which the mark could be depicted. See Jockey Intl., Inc. v. Mallory & Church Corp., 25 USPQ2d 1233, 1236 (TTAB 1992) and cases cited therein. In this case, among the potential displays Applicants might adopt is one which includes a stylized "X" similar to the display in the registered mark.

Furthermore, Applicants emphasize the distinction between the marks based on the registered mark beginning with "X" and its own mark consisting of the single word "excite." Applicants refer to "EXCITE" in their mark as a "word" and "XCITE" in the registered mark as a "fragment." This characterization obscures the inescapable fact (1) that XCITE is the phonetic equivalent of, and otherwise equivalent to, EXCITE and (2) that both are the dominant elements in the respective marks. In emphasizing the distinctions between these elements, Applicants effectively ask that we employ a side-by-side comparison. Such a comparison is not consistent with the way marks are encountered in the marketplace. Rather, ". . . the emphasis must be on the average purchaser, who normally

retains a general rather than a specific impression of trademarks." Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975) and cases cited therein.

Also, Applicants' arguments that the cited mark will convey a connotation or commercial impression suggesting "sexual prowess" or "sight" are imaginative, but not supported by evidence. We have no reason to believe that the connotations of "EXCITE" and "XCITE," as applied to boats in both instances, will vary significantly.

Accordingly, we have considered the appearance, sound, connotation and commercial impressions of the marks in their entireties and conclude that the marks are similar. In re Sunmarks Inc., 32 USPQ2d 1470, 1472 (TTAB 1994).

Strength of the Registered Mark

Applicant also argues that the registered mark is "weak" and, as such, should be accorded a narrow scope of protection. This argument apparently addresses du Pont factor (8) - "The number and nature of similar marks in use on similar goods." In re E. I. du Pont de Nemours & Co., 177 USPQ at 567. To support this argument Applicants refer to third-party applications and registrations for marks which include EXCITE in some form. The Examining Attorney argues that, "third-party registrations, by themselves, are

entitled to little weight on the question of likelihood of confusion." (Citations omitted.)

As applicant indicates, in appropriate cases, the Board has considered whether third-party registrations ". . . indicate that the word, feature or design is more suggestive than arbitrary in a particular field, and, therefore, such a registration for goods or services in the same or related field should be given a more restricted scope of protection." (Citations omitted.) On the other hand, the Court of Appeals for the Federal Circuit recently has urged caution in relying on third-party registrations for this purpose noting that registration alone does not establish that a term is weak and that the probative value of third-party trademarks depends entirely upon their usage. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 73 USPQ2d at 1693.

We first note that Applicants have referred to certain information related to numerous registrations and applications, but Applicants have not provided copies of the full records in most cases. Applicants provided listings of approximately 300 applications and registrations from Trademark.com, a commercial service, for marks which include either "EXCITE" or "XCITE." Applicants

have provided copies of only six full records from Trademark.com and USPTO electronic files.

Generally, mere listings of registrations are not sufficient to make registrations of record. In re Dos Padres Inc., 49 USPQ2d 1860, 1861 n.2 (TTAB 1998). Furthermore, the Board does not take judicial notice of registrations.³ In re JT Tobacconists, 59 USPQ2d 1080, 1081 n.2 (TTAB 2001). However, in this case the Examining Attorney did not advise Applicants that the records were not in proper form, and consequently, the Board will consider the listings of record. In re Broyhill Furniture Industries Inc., 60 USPQ2d 1511, 1513 n.3 (TTAB 2001). Ultimately, the listings have little or no probative value because they indicate only the mark, the class of goods and, what appears to be the status of the record.

Furthermore, many of the records, in the listing and among the full records, relate to pending applications. Third-party applications, even when copies have been furnished, have no probative value other than as evidence that the applications were filed. In re Phillips-Van Heusen Corp., 63 USPQ2d 1047, 1049 n.4 (TTAB 2002). Also,

³ To make registrations properly of record, the Board requires the submission of copies of the USPTO paper records or copies directly from the electronic records of the USPTO. In re Volvo Cars of North America Inc., 46 USPQ2d 1455, 1456 n.2 (TTAB 1999); In re Duofold Inc., 184 USPQ 638, 640 (TTAB 1974).

many of the records, in listings and full records, relate to registrations which have expired or been cancelled. Here too, such records have no probative value as to the strength of EXCITE, even when in proper form. Cf. Action Temporary Services Inc. v. Labor Force Inc., 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (cancelled registration held not to constitute notice of anything).

Applicants have submitted only one full record for an active registration for a mark which includes EXCITE in some form, specifically, Reg. No. 1873759 for the mark WE ARE DRIVING EXCITEMENT for "motor vehicles, namely, automobiles, engines therefor and parts therefor."⁴

On the basis of all evidence of record relating to this factor, we conclude that Applicants have failed to demonstrate that "EXCITE" or "XCITE" is weak when used as a mark or component of a mark for boats.

Purchaser Sophistication

Applicants also argue that the purchasers for the goods are sophisticated and that therefore confusion is

⁴ Applicants also provided information regarding another registration which appears to be active, but no full record, with its brief, namely, Reg. No. 2371231 for the mark EXCITE for "transportation aids for handicapped persons namely electrically powered wheeled chairs and structural parts therefor." This information adds to the information provided in the listing furnished during prosecution. We have also considered this information because the Examining Attorney discussed the records generally and did not object to any evidence.

less likely. Applicants state, "Applicant's goods and the goods in the cited registration are described as 'boats', which are generally considered to be expensive, luxury goods for which purchasers are likely to exercise careful scrutiny before purchasing." The Examining Attorney disagrees and states that such purchasers are not immune from trademark confusion.

We agree with the Examining Attorney. We assume, as Applicants argue, that the goods of both Applicants and registrant are relatively expensive, and that the goods would be purchased with a significant degree of care. However, the purchasers themselves may not be sophisticated. That is, we assume that a boat, like an automobile, may be purchased by members of the general public who possess varying degrees of sophistication. Furthermore, as the Examining Attorney noted, even sophisticated purchasers are not immune from trademark confusion. In re Pellerin Milnor Corp., 221 USPQ 558, 560 (TTAB 1983). Accordingly, we conclude that the evidence in this application bearing on the sophistication of the potential purchasers fails to indicate a diminished likelihood of confusion.

Resolving Doubt

In their brief Applicants argue erroneously that, in a likelihood-of-confusion case such as this, any doubt must be resolved in favor of Applicants citing cases, such as, In re Merrill Lynch Pierce Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987). Merrill Lynch and the other cases cited by Applicants address distinctiveness, not likelihood of confusion. In fact, in likelihood-of-confusion cases the opposite rule applies. That is, any doubt must be resolved in favor of the prior registrant. See, e.g., In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988). Accordingly, if we had any doubt in this case, and we do not, we would resolve it in favor of the prior registrant.

CONCLUSION

After considering all of Applicants' arguments and evidence bearing on the du Pont factors, we conclude that there is a likelihood of confusion between Applicants' mark and the cited registered mark principally because the goods of Applicants and registrant and the channels of trade for those goods are identical, and because the marks are similar.

Decision: The refusal to register Applicants' mark under Section 2(d) of the Act is affirmed.