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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Binney & Smith Inc.

Serial No. 78472642

Albert P. Mauro, Jr., of Hallmark Cards, Incorporated for Binney & Smith Inc.

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(Ronald R. Sussman, Managing Attorney).

Before Hohein, Walters and Holtzman, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Binney & Smith Inc. to register the mark COLOR WAVE (COLOR disclaimed) in standard character form for "markers" in Class 16.¹

The trademark examining attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles

¹ Application Serial No. 78472642, filed August 24, 2004 based on an allegation of a bona fide intention to use the mark in commerce.

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the registered mark COLORWAVE (in typed form) for "art paper," as to be likely to cause confusion.²

When the refusal was made final, applicant appealed. Briefs have been filed.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to the marks. In determining the similarity or dissimilarity of marks, we must consider the marks in their entirety in terms of sound, appearance, meaning and commercial impression. See du Pont, supra. See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The marks in this case, COLOR WAVE and COLORWAVE, are identical in sound, meaning and commercial impression, both consisting of the same words, COLOR and WAVE, in the same order.

² Registration No. 2028919, issued January 7, 2001; affidavits under Sections 8 and 15 accepted and acknowledged, respectively.

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The marks are virtually identical in appearance. The presence or absence of a space between the two words is insignificant and is not sufficient to distinguish one mark from the other. Moreover, applicant's mark, as the typed words COLOR WAVE, could reasonably be displayed in the same compressed format as registrant uses thereby rendering the marks visually identical. See Phillips Petroleum v. C.J. Webb, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971); and INB National Bank v. Metrohost, 22 USPQ2d 1585 (TTAB 1992).

Applicant argues that registrant's COLORWAVE mark is "inherently weak" due to the descriptive meaning of the word COLOR. In support of this argument, applicant points to the disclaimer of the COLOR portion of its COLOR WAVE mark; and a list of third-party registrations of marks which incorporate the word COLOR, contending that this evidence demonstrates "wide use" of the word COLOR in the arts and crafts field.

Applicant's evidence and arguments are not persuasive. As to the disclaimer, it is well settled that disclaimed matter still forms a part of the mark and cannot be ignored in determining likelihood of confusion. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("The technicality of a disclaimer in National's application to register its mark has no legal effect on the issue of likelihood of confusion. The public is unaware of what words have been disclaimed...").

With regard to the third-party registrations, the examining attorney correctly pointed out in his final Office action that a mere listing of registrations, without copies thereof, is insufficient to make the registrations of record. See *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998). Applicant did not submit copies of the registrations. We will therefore not further consider this evidence.

We add, however, that even if these registrations were of record, they would not be persuasive on the question of whether the marks in this case are confusingly similar. The relevant consideration is whether similar marks are in use for similar goods and, contrary to applicant's contention, third-party registrations are not evidence of use of the marks therein. See *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973) and *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040 (TTAB 1989). It is true that third-party registrations may be used to indicate that a commonly registered element has a suggestive or recognized meaning for particular goods such that differences in other portions of the marks may be sufficient to render the marks as a whole distinguishable. See, e.g., *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588, 592 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976). Here, however, the marks are essentially identical. There are no other portions to distinguish them. Further, the

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fact that the word COLOR may be common to other marks is not significant. Marks must be evaluated in their entireties, and the cited registration is COLORWAVE, not the word COLOR alone.³ See, e.g., Chicago Pharmacal Co. v. American Home Products Corp., 280 F.2d 148, 126 USPQ 388 (CCPA 1960); and Eastman Kodak Co. v. Supreme Photo Supply Co. Inc., 138 USPQ 90, 91 (TTAB 1963) ("The fact that others have adopted one or the other of the terms "PAN" and "VARI" as components of their marks is immaterial to the question whether or not the unitary marks of the parties herein are confusingly similar.")

In any event, while the word COLOR may be descriptive, registrant's mark COLORWAVE as a whole, which is how the mark must be viewed, is at most only suggestive, perhaps of the variety of product colors. To the extent registrant's mark has a suggestive meaning, however, that meaning would be the same for both marks. Further, there is no evidence that the mark COLORWAVE is weak or entitled to anything less than a normal scope of protection, and the mark would certainly be entitled to

³ Applicant also refers for the first time in its brief to the alleged existence of "over 50 active registrations in Class 16" that include the word WAVE. We have given no consideration to this unsupported statement, and even if copies of the registrations had been submitted, the evidence would be untimely. See Trademark Rule 2.142(d). We also point out that without any information as to the full marks and the goods on which the marks are used, the evidence is not meaningful.

protection against the virtually identical mark for related goods.⁴

Thus, we turn to a consideration of the respective goods. Applicant argues that although registrant's art paper and applicant's markers are both classified in Class 16 and are both used in coloring activities, the goods are of a different character and nature and are "appreciably different" products.

It is well settled that goods need not be similar or competitive in nature to support a finding of likelihood of confusion. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that

⁴ For the first time in its brief, applicant points to a third-party registration (again, unsupported by any copy) which applicant claims is for the mark COLORWAVE for "picture frame moulding" in Class 20. Applicant argues that in view of the coexistence of this mark and the cited mark on the register, applicant's mark should be entitled to register as well. This evidence is untimely and, in any event, unpersuasive. The question of whether the two cited marks are confusingly similar to each other is not before us. Each case must be decided on its own merits. See *In re Nett Designs Inc.*, 236 F3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court."). Further, even assuming that the marks in the two registrations are confusingly similar, it would not justify permitting yet another confusingly similar mark to register. See *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) ("...nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive.").

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could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Markers and art paper are inherently related goods. They are complementary and moreover companion art supplies that would be purchased together and used together for an arts and crafts activity. In addition, the examining attorney has submitted a number of use-based, third-party registrations showing that, in each instance, a single entity has adopted the same mark for markers, such as color markers and marker pens, on the one hand, and art paper, on the other. Several of the registrations also show that the two products are identified as comprising part of a kit or set. Although third-party registrations which are based on use are not evidence that the marks shown therein are in use or that the public is familiar with them, they nevertheless have some probative value to the extent that they serve to suggest that the goods listed therein may emanate from a single source. See *In re Albert Trostel & Sons Co.*, *supra*, and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). Purchasers encountering these goods offered under virtually identical marks would naturally assume the goods come from the same source.

Moreover, these closely related and complementary goods would be sold in the same channels of trade, such as craft stores

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or hobby stores, to the same purchasers, including ordinary consumer purchasers. Ordinary purchasers of arts and crafts supplies, especially considering the relatively inexpensive nature of these products, would not be expected to exercise a high degree of care and thus would be more prone to confusion.

We note applicant's reliance on cases wherein no likelihood of confusion was found notwithstanding the identity of the marks, and applicant's contention that these prior cases "have found no confusing similarity in analogous circumstances." While it may be true, as a general proposition, that even identical marks, if used on unrelated goods or in distinct marketing environments, may be found not to be confusingly similar, contrary to applicant's contention, the facts in the cited cases are not analogous to the facts herein. Those cases involve entirely different marks and goods, and thus in no way compel a finding that the marks in the present case are not confusingly similar. See *Medicated Products Co. v. Alice Jewelry Co.*, 255 F.2d 408, 118 USPQ 90, 91 (CCPA 1958) ("We have repeatedly held that past decisions on confusing similarity are of little assistance in new fact situations wherein entirely different marks and products are involved").

For the reasons stated above, and because the virtually identical marks COLORWAVE and COLOR WAVE are used in connection

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with closely related goods, we find that there is a likelihood of confusion.⁵

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

⁵ Applicant also contends that the absence of evidence of fame of the registrant's mark should be treated as a factor in applicant's favor. Because this is an ex parte proceeding, we would not expect the examining attorney to submit evidence of fame of the cited mark. Thus, this du Pont factor is not applicable. See, e.g., *In re Thomas*, 79 USPQ2d 1021 (TTAB 2006). Similarly, the asserted absence of evidence of actual confusion does not weigh in favor of applicant. The application is based on an intent to use the mark in commerce, and even if use has begun, we have no information as to whether a meaningful opportunity for actual confusion has occurred. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992).