

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
May 27, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lauren Ashley Howell

Serial No. 78505128

Lauren Ashley Howell pro se.

Curtis W. French, Trademark Examining Attorney, Law Office
115 (Tomas V. Vlcek, Managing Attorney).

Before Rogers, Zervas and Kuhlke, Administrative Trademark
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Lauren Ashley Howell, a Canadian citizen, seeks
registration on the Principal Register of the mark THREE
BEARS PUBLISHING (in standard character form, "PUBLISHING"
disclaimed) for goods ultimately identified as "Decals,
Appliqués in the form of a decal, Art Pictures in
watercolor, acrylic paint, marker, pencil crayon, and
pencil, Art Prints, Printed Art Reproductions, Graphic Art
Reproductions, Printed Computer-generated Art, Printed

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Characters, Paper Window Shades, Paper Automobile
Windshield Sun Shades, Paper Placemats, Gift Wrapping
Paper, Stickers, Photo Albums, temporary Tattoos, Dry-
Transfer Characters" in International Class 16.¹

Registration has been refused under Section 2(d) of
the Trademark Act, 15 U.S.C. §1052(d), on the ground that
applicant's mark, when used with her identified goods, so
resembles the registered mark THREE BEARS BOOKS (in typed
form, "BOOKS" disclaimed) for "publication of
developmentally appropriate products, namely educational
teaching textbooks, workbooks, and worksheets for children
and their caregivers" in International Class 41² and
"educational and teaching materials, namely workbooks,
worksheets, and textbooks on a variety of subjects for
grades pre-kindergarten through 12"³ in International Class
16 as to be likely to cause confusion, mistake or
deception. The registrations are owned by the same entity,
Three Bears Books, Inc.

¹ Application Serial No. 78505128, filed October 25, 2004,
alleging first use of the mark on May 1, 2003 and first use in
commerce on October 22, 2004 under Trademark Act Section 1(a), 15
U.S.C. §1051(a). The application is also based upon a foreign
registration under Trademark Act Section 44, 15 U.S.C. §1126.

² Registration No. 1997628, issued on August 27, 1996, renewed.

³ Registration No. 2003662, issued on September 24, 1996,
renewed.

The appeal is fully briefed.⁴ We affirm the refusal to register.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., 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 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).

We first consider whether applicant's mark, THREE BEARS PUBLISHING and the mark in the cited registrations, THREE BEARS BOOKS, are similar or dissimilar when compared

⁴ Applicant attached several exhibits to her reply brief. The record in the application should be complete prior to the filing of an appeal. Trademark Rule 2.142(d). Therefore, these exhibits are untimely and have not been considered. We have only considered matter that was properly entered into the record during the prosecution of the application, i.e., no later than the denial of the final request for reconsideration. TBMP §1204 (2d ed. rev. 2004).

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in their entireties in terms of appearance, sound, connotation and commercial impression.

Examining the marks in terms of their appearance, sound, meaning, and commercial impression, we find the marks to be similar. The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). We must determine whether the marks are sufficiently similar that there is a likelihood of confusion as to source and, in making this determination, we must consider the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Clearly, the phrase THREE BEARS is the dominant element in applicant's and registrant's marks given the highly descriptive nature of the other two disclaimed words, PUBLISHING and BOOKS. In *re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (more or less weight may be given to a particular feature of a mark provided the ultimate conclusion on likelihood of confusion rests on consideration of the marks in their entireties.)

There is no question that THREE BEARS is the source-identifying element in applicant's and registrant's marks. Moreover, the dominant part of registrant's mark - THREE BEARS - is arbitrary and there is no evidence in the record to support a finding that it is weak in this field of use.⁵ While the term BEAR per se may be widely registered and/or used in the bookseller/publishing field, as shown by the third-party registrations and listings of booksellers and publishers in the record (e.g., Honey Bear Books, Brown Bear Books, Purple Bear Books, Mama Bear Books, see May 21, 2006 Request for Reconsideration) the only examples of use or registration of marks that include the phrase THREE BEARS are the marks in the involved application and cited registrations. Therefore, because of the dominance of the identical arbitrary phrase THREE BEARS in the marks, we find that the marks in their entireties are similar in

⁵ Applicant argues in its reply brief that the phrase THREE BEARS in its mark is not arbitrary but rather has "great descriptive significance" in that it is used to convey the image "that the 3 bears from the goldilocks story, or any 3 live bears, have come to life and begun publishing books." Reply Br. pp. 5-6. Further, she states that it was an oversight "that the wording 'Three Bears' was not disclaimed as being descriptive by the Applicant in this Application." Id. However, applicant's use of the mark to evoke a particular image does not make it descriptive of a significant feature of the identified goods. Moreover, it is not possible to disclaim an entire mark; in the event the entire the mark was descriptive, it would be refused in its entirety as merely descriptive.

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sound, appearance and connotation, and have the same overall commercial impression.

In making our determination we have considered applicant's argument that the additional elements PUBLISHING and BOOKS distinguish the marks. Specifically, applicant argues that:

Because the registrations cited against this application contain the word 'Books' rather than the word 'Publishing', (and ours conversely contains only the word 'Publishing', not the word 'Books') the cited registrations have the sound, appearance, meaning and connotation of being a BOOK STORE rather than a Book Publisher. Our Application, on the other hand, is for a trademark that has the sound, appearance, meaning, and connotation of being a PUBLISHER rather than a book store.

Br. p. 2.

As noted by the examining attorney, we must consider the connotation in the context of the goods and services and "it is more likely that the use of the term BOOKS with Registrant's services connotes book publishing because the Registrant provides publication services." Br. p. 5. More importantly, as discussed above, in considering the marks in their entireties, these differences consisting of descriptive or generic terms are not sufficient to overcome the identical nature of the dominant elements in the marks.

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In view of the above, the du Pont factor of the similarity of the marks favors a finding of likelihood of confusion.

We now consider the factor of the relatedness of the goods and services. In making this determination we recognize that where the marks are virtually identical, "the relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the marks are not identical or strikingly similar." *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981). See also *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source").

As noted above, registrant's goods in Reg. No. 2003662 comprise "educational and teaching materials, namely workbooks, worksheets, and textbooks on a variety of subjects for grades pre-kindergarten through 12" and the services in Reg. No. 1997628 comprise "publication of developmentally appropriate products, namely educational teaching textbooks, workbooks, and worksheets for children and their caregivers." Applicant's goods comprise "Decals, Appliqués in the form of a decal, Art Pictures in

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watercolor, acrylic paint, marker, pencil crayon, and pencil, Art Prints, Printed Art Reproductions, Graphic Art Reproductions, Printed Computer-generated Art, Printed Characters, Paper Window Shades, Paper Automobile Windshield Sun Shades, Paper Placemats, Gift Wrapping Paper, Stickers, Photo Albums, temporary Tattoos, Dry-Transfer Characters."

In support of his contention that applicant's goods are related to registrant's goods and services, the examining attorney submitted several third-party use-based registrations to show that numerous entities have adopted a single mark for both applicant's and registrant's types of goods and/or services. See, e.g., Reg. No. 1909982 (SHAMU for, inter alia, educational books on marine subjects, coloring books, decals and crayons); Reg. No. 2369755 (ACTION PUBLISHING for, inter alia, children's books and magazines featuring the natural sciences, and pencils); Reg. No. 2594814 (DESERT SKY PUBLISHING COMPANY for, inter alia, personal and family self-help books, and art prints); Reg. No. 2707520 (TEXTS AND TECHNOLOGY for, inter alia, nonfiction books and newsletters all in the field of integration of written words and oral, audio and visual images, decals, appliquéés in the form of decals, art prints, pencils, and publication services, namely,

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electronic publication of text and graphic works of others); Reg. No. 2738021 (THE YACHTS OF SEABOURN INTIMATE SHIPS. UNCOMPROMISING LUXURY for, inter alia, books, and photo albums); Reg. No. 2661126 (JEI for, inter alia, coloring books, children's picture books, pencils, stickers and publication of textbooks and workbooks); Reg. No. 2874321 (NINE STORIES HIGH for, inter alia, books in the field of children's stories, pencils, gift wrapping paper, decals, transferable temporary tattoos, stickers and posters, and publication of books brochures, bookmarks, and coloring books); and Reg. No. 3056171 (THE PICTURES DO THE TALKING for, inter alia, booklets, posters, illustrations, paper illustration boards, and publication of cards, pamphlets, booklets, posters, handbooks and printed instructional, educational, and teaching materials). See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

In addition, the examining attorney submitted excerpts from a publisher's website showing that the publisher sells a variety of goods under its name. See, e.g., Scholastic webpage offering books and photo albums. We further note that applicant's original identification included books.

Further, inasmuch as there are no limitations in the identification of goods and services, we must presume that

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the goods and services will be offered in some of the same channels of trade, and will be used by some of the same purchasers. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). While registrant's identifications are restricted to the educational field, the application contains no field of use restriction and, as such, includes the educational field. Moreover, as shown below, excerpts from applicant's website attached to the December 12, 2006 Denial of Request for Reconsideration show that applicant markets a wide variety of products, including books in the educational field.



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About Us

Three Bears Publishing is a Canadian publisher of quality story books for ages 5 and up.

Our **Learn & Laugh Books** imprint seeks to entertain and delight children, as well as educate.

Our **Magic Beanstalk Books** imprint was designed to provide quality books that focus on fun, and inspires us all to dream.

Open a Three Bears Publishing book today, and open the window to fun and learning !

In view of the above, the du Pont factors of the similarity of the goods and services and the channels of

trade favor a finding of likelihood of confusion as to the cited registrations.

Finally, to the extent applicant is arguing that despite a period of concurrent use there have been no known instances of actual confusion, there is nothing in the record to show that there has been a meaningful opportunity for such confusion to have occurred.⁶ More importantly, in the context of an ex parte proceeding, "the lack of evidence of actual confusion carries little weight." *Majestic Distilling*, supra, 65 USPQ2d at 1205.

In conclusion, we find that because of the highly similar marks, the relatedness of the goods and services, and the overlap in the trade channels, confusion is likely between applicant's mark and the mark in the cited registrations. To the extent there are any doubts, we resolve them, as we must, in registrant's favor. In re *Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

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

⁶ Applicant's argument in its reply brief that no likelihood of confusion exists because registrant is not using its mark, is unavailing. As applicant itself stated, "the examiner is bound to support marks on the register whether in use or not." Reply Br. p. 8. We must make our determination of likelihood of confusion based on the registration itself and accord it the presumptions provided by Section 7(b) of the Trademark Act.