

THIS OPINION IS NOT
PRECEDENT OF THE TTAB

Mailed:
July 18, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jackie Allen, Christopher Kemp, Melissa Kemp, Lori
Taylor

Serial No. 78572292

Scott J. Fields, of National IP Rights Center LLC, for
Jackie Allen et al.

Fred Carl III, Trademark Examining Attorney, Law Office 108
(Andrew Lawrence, Managing Attorney).

Before Quinn, Kuhlke and Bergsman, Administrative Trademark
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Jackie Allen, Christopher Kemp, Melissa Kemp and Lori
Taylor (hereinafter applicants) seek registration on the
Principal Register of the mark shown below for goods
identified as "candles" in International Class 4.¹



¹ Application Serial No. 78572292, filed February 22, 2005,
alleging May 1, 2004 as the date of first use and use in commerce
under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a).

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In response to a request from the examining attorney, applicants disclaimed the phrase CANDLE CO.

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 on its identified goods, so resembles the registered mark EARLY AMERICANA (typed form) for "candles; scented candles; wicks for oil lamps" in International Class 4 as to be likely to cause confusion, mistake or deception.²

When the refusal was made final, applicant appealed and briefs have been filed. We affirm the refusal.

As a preliminary matter, the examining attorney's objections to the list of trademarks from the trademark.com and the USPTO TESS websites submitted by applicant in its response to the first Office action, and the updated USPTO TESS listings submitted with applicant's brief are sustained. See *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974) (submission of list of registrations does not make them of record); Trademark Rule 2.142(d) (evidentiary record should be complete prior to the filing of an ex parte appeal); *In re Wada*, 48 USPQ2d 1689, 1689 n.2 (TTAB

² Registration No. 2753874, issued August 19, 2003.

1998), aff'd, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (evidence submitted with reply brief not considered).

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/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).

The "candles" identified in the application are identical to the "candles" in the cited registration. Moreover, given that the goods are identical and there is no limitation in the identification thereof in the application or registration, we must presume that the goods will be sold in the same channels of trade and will be bought by the same classes of 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

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USPQ2d 1531 (TTAB 1994). We further note that applicants only address the factor of the similarity of the marks and do not present argument with regard to the goods, channels of trade or class of purchasers. In view of the above, the du Pont factors of the similarity of the goods, the channels of trade, and class of purchasers favor a finding of likelihood of confusion as to the cited registration.

We turn now to the first du Pont factor, i.e., whether applicants' mark AMERICANA CANDLE CO. (stylized with design) and registrant's mark EARLY AMERICANA are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. It is well settled that marks must be considered in their entireties, not dissected or split into component parts and each part compared with other parts. It is the impression created by the involved marks, each considered as a whole, that is important. See Kangol Ltd. v. KangaROOS U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). Finally, "[w]hen marks would appear on virtually identical goods or services, the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), cert denied, 506 U.S. 1034 (1992).

Applicant's argument essentially is that the only common element in the marks is the word AMERICANA, which is weak, and when the marks are properly considered in their entirety the differences are sufficient to distinguish the marks. In particular, the addition of the word EARLY to registrant's mark creates a connotation distinct from applicants' AMERICANA mark in that it evokes "something created at or near the initial period" (br. p. 5) whereas applicants' mark "refers to an American company that makes candles." With regard to applicant's argument that the term AMERICANA is a weak mark, as noted above, we have not considered the listings of registrations provided by applicant.³ Applicants have also submitted search results retrieved from the Google search engine for the phrase EARLY AMERICANA. The search results include excerpts from the following entries: "Eastern Shore Early Americana Museum, Maryland"; "Celebrity Gems - Early Americana"; and "Video presents EARLY AMERICANA on FILM VAUDEVILLE, CIRCUS, AMUSEMENT PARKS, and more." While these entries are consistent with the dictionary definition of AMERICANA submitted by the applicants, they do little to advance our understanding of the strength or weakness of the term

³ We note that consideration of these listings would not change our decision inasmuch as they are of little probative value as to

AMERICANA in connection with candles. Moreover, web page excerpts set forth in search results have little probative value because they do not show the full context of the use of the term. In re Remacle, 66 USPQ2d 1222 (TTAB 2002).

The examining attorney argues that the shared term AMERICANA establishes the similarity in sound and appearance and "the applicants' presentation of its mark in special form will not avoid likelihood of confusion with the registered mark in typed form because the registered mark could be used in the same manner of display as applicants' mark." Br. p. 8. In addition, the examining attorney argues that the marks are similar in meaning and commercial impression because they both "convey a meaning of colonial, or pre-colonial America." Id.

In making his determination, the examining attorney has noted that the disclaimed matter in applicants' mark is less significant inasmuch as "the wording CANDLE CO. is descriptive and therefore [consumers] would not attribute trademark significance to it." Br. p. 9. With regard to applicants' design element he argues that "the star designs and the wording make it clear that applicants' mark is not referring to modern Americana, or mid 20th century

the question of weakness of the term AMERICANA in the field of candles.

Americana, but to a distant past." Br. p. 10. The examining attorney argues that the use of stars in applicants' mark evokes "early Americana" as distinguished from contemporary U.S. culture and thus adds to the similar connotation and commercial impression with registrant's mark EARLY AMERICANA. In support of this argument, the examining attorney submitted excerpts from various websites offering a variety of goods that have an early American historical theme. The examining attorney concludes that "applicants' contention that its mark conveys a meaning that is either contemporary Americana or more significantly geographic is not supported by facts or by the evidence of record." Br. p. 10.

We agree with the examining attorney that AMERICANA is the dominant portion of applicants' mark inasmuch as the wording CANDLE CO. is descriptive of the goods or otherwise without source identifying significance and is disclaimed. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("That a particular feature is descriptive [or otherwise lacking in distinctiveness] ... with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark..."). We also find that the wording in applicants' mark dominates over the design, inasmuch as it is the

wording by which the consumer will call for the goods and the design element is not particularly prominent in relation the wording. In re Appetito Provisions Co. Inc., 3 USPQ2d 1553, 1554 (TTAB 1987).

Thus, inasmuch as the dominant element in registrant's mark is identical to the literal portion of applicants' mark, the marks have a similar overall commercial impression and share strong similarities in sound and appearance.

As to connotation, AMERICANA is defined as: "Materials relating to American history, folklore, or geography or considered to be typical of American culture." The American Heritage Dictionary of the English Language (4th ed. 2000). The primary meaning of each mark would be the same, i.e., goods relating to American history, folklore and culture, inasmuch as the goods with which the marks are used are identical. To the extent the connotation of registrant's mark is temporally limited by inclusion of the word EARLY, applicants' mark, by not being so limited, includes this connotation. Moreover, as the examining attorney points out, both the goods themselves and the use of the star design in applicants' mark evoke early America rather than contemporary America.

Overall, we find that the additions of the descriptive wording CANDLE CO. and the design element of stars dividing the wording to applicants' mark and the word EARLY to registrant's mark are not sufficient to distinguish the marks. In re Rexel Inc., 223 USPQ 830 (TTAB 1984). Viewing the marks in their entireties, they are similar in appearance, sound and connotation, and they convey a similar commercial impression.

Finally, neither applicants, nor registrant, disclaimed the exclusive right to use "Americana." Accordingly, registrant and applicants must believe that "Americana" is at least a suggestive term when used in connection with candles, and therefore the proper subject of registration. Even if we find the term AMERICANA to be suggestive of the goods and somewhat weak as a mark, even weak marks deserve protection. Hollister Inc. v. Ident A Pet, Inc., 193 USPQ 439 (TTAB 1976). Here the goods are identical and the other elements in the respective marks are not sufficient, even given limited protection, to distinguish the marks. Applicant relies on Keebler Co. v. Murray Bakery Products, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989); however, in that case the common term PECAN was an ingredient in the respective parties' cookies and as such had no trademark significance, as distinguished from

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AMERICANA which is not wholly without source identifying significance.

In view of the above, the factor of the similarity of the marks also favors a finding of likelihood of confusion with respect the cited registration.

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

We note that Scott J. Fields, attorney for applicant, passed away on April 23, 2007. We therefore are mailing copies of this decision directly to applicant; to the Conservator for Mr. Fields; to the attorney for the administration of Mr. Fields' estate; and to Mr. Fields' former law firm, National IP Rights Center, LLP.

Applicant is advised that any request for reconsideration under Trademark Rule 2.144 must be filed within one month from the date of this decision, and any appeal under Trademark Rule 2.145 must be filed within two months from the date of this decision.

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If applicant wishes to file a request for reconsideration or an appeal, and is unable to obtain the services of an attorney in a timely manner, applicant may, within the appropriate time limits, request an extension of time.

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

cc:

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