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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Marilyn S. Ruben

Serial No. 78589771

Marilyn S. Ruben, *pro se*.

Roselle M. Herrera, Trademark Examining Attorney, Law
Office 102 (Karen M. Strzyz, Managing Attorney).

Before Quinn, Drost and Cataldo, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Marilyn S. Ruben filed an application to register the
mark SONRISA HANDMADE DESIGNS (HANDMADE DESIGNS
disclaimed) (in standard characters) for goods identified in
International Classes 24 and 28.¹ When the trademark
examining attorney issued a final refusal with respect to
Class 28 only, applicant filed a request to divide.

¹ Application Serial No. 78589771, filed March 17, 2005, alleging
first use anywhere and first use in commerce on March 31, 2003.
The English translation of the Spanish word "sonrisa" is "smile."

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Pursuant to this request, the goods listed in Class 24 were placed in "child" application serial no. 78977305. That application matured into Registration No. 3181047 on December 5, 2006.

The goods listed in Class 28 remain in the present "parent" application. These goods are identified as "stuffed toy animals."

The examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to applicant's Class 28 goods, so resembles the previously registered mark SONRISA TOYS (TOYS disclaimed) (in typed form) for "online retail store services featuring toys and collectibles"² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.

Before turning to the substantive merits of the appeal, we are compelled to note that applicant has raised a number of arguments that fall outside of the Board's limited jurisdiction. Further, the application file is replete with statements and evidentiary materials submitted

² Registration No. 2881641, issued September 7, 2004. The registration indicates that "sonrisa" translates in English to "smile."

by applicant that are irrelevant to the likelihood of confusion analysis in an ex parte appeal before the Board. Suffice it to say, we have considered all of the probative evidence pertaining to likelihood of confusion, as well as all of applicant's relevant arguments with respect thereto (including any evidence and arguments not specifically discussed in this opinion).

The examining attorney maintains that the marks are similar, both being dominated by the identical term SONRISA. The examining attorney further contends that the goods and services are related in that registrant's services encompass the sale of goods of the type sold by applicant, namely stuffed toy animals. In support of the refusal, the examining attorney submitted dictionary definitions of the words "handmade" and "design"; excerpts of websites of third-party on-line retailers; and third-party registrations.

Applicant essentially contends that the marks are different and that her handmade products are different from the toys sold by registrant.

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

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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, however, 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).

With respect to the involved marks, we examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. The focus is on the recollection of 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 (TTAB 1975).

With respect to the involved marks, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this

dominant feature in determining the commercial impression created by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ["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."] For example, in the past merely descriptive matter that is disclaimed has been accorded subordinate status relative to the more distinctive portions of a mark. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997). In the present case, applicant has disclaimed the terms HANDMADE DESIGNS, while registrant has disclaimed the word TOYS. Given the highly descriptive, if not generic nature of these words in the respective marks, each mark is clearly dominated by the identical term, SONRISA. Moreover, the term SONRISA is the first term in each mark; this term is the part of each mark that is most likely to be impressed upon the mind of a purchaser and will be remembered and used when calling for the goods and/or services. *See Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). Thus, the dominant feature, SONRISA, of each mark is identical in

sound and appearance. Further, as noted earlier, the application and registration indicate that this Spanish term means "smile" in English and, thus, the meaning of this term would be identical in each mark. This meaning is the same (that is, the product or service will bring a smile to your face), whether used in connection with toys or retail services featuring the sale of toys, thus engendering the same overall commercial impression.

Although the dominant portion, SONRISA, of applicant's mark is identical to the dominant portion, SONRISA, of registrant's mark, we must do more than just compare the individual components of the marks; it is necessary that we compare the marks as a whole. *M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1948-49 (Fed. Cir. 2006) ["When comparing the similarity of marks, a disclaimed term...may be given little weight, but it may not be ignored"]. While we have considered the HANDMADE DESIGNS portion of applicant's mark, and the TOYS portion of registrant's mark, purchasers are likely to view these commonly understood and recognized terms as having no distinguishing or source-indicating role in the respective marks.

In view of the above, we find that the marks are similar. The similarity between the marks is a factor that weighs in favor of a finding of likelihood of confusion.

We next turn to compare applicant's "stuffed toy animals" to registrant's "online retail store services featuring toys and collectibles." As often stated, it is not necessary that the respective goods and/or services be competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods and/or services are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originated from the same producer. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

The examining attorney submitted nine use-based third-party registrations showing that each registrant adopted a single mark for toys, including stuffed toy animals, and retail store services (online and/or brick and mortar) featuring toys. Third-party registrations that individually cover different items and that are based on use in commerce serve to suggest that the listed goods

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and/or services are of a type that may emanate from a single source. 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). Also of record are excerpts of various third-party websites showing that on-line retailers sell toys, including stuffed toy animals, with the same mark used in connection with both the services and toys.

It is well settled that confusion is likely to occur from the use of similar marks for goods, on the one hand, and for services involving those goods, on the other. See, e.g., *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) [BIGG'S (stylized) for retail grocery and general merchandise store services held likely to be confused with BIGGS and design for furniture]; *In re Seiler Co.*, 289 F.2d 674, 129 USPQ 347 (CCPA 1961) [SEILER for catering services held likely to be confused with SEILER'S for smoked and cured meats]; *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) [CAREER IMAGE (stylized) for retail women's clothing store services and clothing held likely to be confused with CREST CAREER IMAGES (stylized) for uniforms]; and *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) [21 CLUB for various items of clothing held likely to be confused with THE "21" CLUB

(stylized) for restaurant services and towels]. See TMEP §1207.01(a)(ii) (5th ed. 2007)

In view of the above, we find that applicant's goods are related to registrant's services. The goods and services are offered to the same classes of purchasers, including ordinary consumers, who are likely to use nothing more than ordinary care when making their purchasing decision.

Applicant's claim that there has been no actual confusion is entitled to little value. The record is devoid of probative evidence relating to the existence of opportunities for instances of actual confusion to have occurred in the marketplace. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000); and *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Accordingly, the *du Pont* factor of the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion must be considered neutral instead of being in applicant's favor.

One last point requires comment. During prosecution, applicant suggested that she has priority over registrant. To the extent that applicant's allegations constitute a collateral attack on registrant's registration, they are

impermissible. Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in connection with the goods or services identified in the certificate. During ex parte prosecution, including an ex parte appeal, an applicant will not be heard on matters that constitute a collateral attack on the cited registration (e.g., applicant's claim of priority over the cited mark). *In re Dixie Restaurants*, 41 USPQ2d at 1534; and *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992). See TMEP §1207.01(d)(iv) (5th ed. 2007). Accordingly, no consideration has been given to applicant's arguments in this regard.

We conclude that consumers familiar with registrant's online retail store services featuring toys and collectibles rendered under the mark SONRISA TOYS would be likely to mistakenly believe, upon encountering applicant's mark SONRISA HANDMADE DESIGNS for stuffed toy animals, that the goods and services originated with or are somehow associated with or sponsored by the same entity.

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Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *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.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.