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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Coralie Downing and Keri Caffrey

Serial No. 78603930

Lori T. Milvain of Latham, Shuker, Barker, Eden & Beaudine, LLP for joint applicants Coralie Downing and Keri Caffrey.

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Before Holtzman, Zervas, and Wellington, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

On April 4, 2005, Coralie Downing and Keri Caffrey (joint applicants) applied to register the mark appearing to the right on the Principal Register for the following goods:

Jewelry, namely, pendants, necklaces, bracelets, earrings, and pins in International Class 14;

Pens, pencils, calendars, and posters, all related to women's cycling in International Class 16; and

Women cyclists' clothing, namely, jerseys, shorts, t-shirts, jackets, socks, caps, bandanas, scarves, sweatshirts, sweaters, arm warmers, and leg warmers in International Class 25.

The application contains a statement indicating the stylized design portion of the mark depicts a "woman cycling." The application is based on an allegation that the applicants have a bona fide intent to use the mark in commerce.

The examining attorney refused to register the mark under Section 2(d) of the Trademark Act because of two prior registrations. 15 U.S.C. § 1052(d). The first cited registration is for the mark BOBBY'S (in standard character form) for "retail store services namely a department store" in International Class 42.[1] The second cited registration was for the mark BOBBI (in stylized characters) for "fine jewelry" in International Class 14.[2]

After the examining attorney made the refusal final, this appeal followed.

In their appeal brief, applicants correctly note that the registration for the mark BOBBI, Registration No. 2306069, was cancelled (see footnote 2) subsequent to

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[1] Registration No. 1555313, issued September 5, 1989. Section 8 affidavit accepted and Section 15 acknowledged.

[2] Registration No. 2306069 issued on January 1, 2000, but was cancelled on October 7, 2006 for failure to file a Section 8 affidavit.

issuance of the examining attorney's final Office Action. Accordingly, this appeal and our decision herein are limited to the Office's refusal based on Registration No. 1555313 for the mark BOBBY'S.

Before we begin our likelihood of confusion analysis, we note that, as an evidentiary matter, applicants rely on a list of third-party registrations (for marks containing the term BOBBY or BOBBIE) in their appeal brief. Although copies of the registrations were not attached to their brief or otherwise previously submitted, the examining attorney did not object to the list and, indeed, discussed the list of registrations. Accordingly, the list of registrations may be treated as stipulated into the record. See TBMP §§ 1207.03 and 1208.02 (2d ed. rev. 2004), and authorities cited therein [regarding evidence considered due to actions of non-offering party and treatment of third-party registrations]. While the Board gives consideration to this list of third-party registrations, we find it to have little, if any, probative value for purposes of our likelihood of confusion analysis. *Miss Universe Inc. v. Drost*, 189 USPQ 212 (TTAB 1976) [third-party registrations are of little material significance in determining likelihood of confusion since their existence

is not evidence of what happens in the marketplace or of the fact that consumers are familiar with them].

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods/services at issue and the similarity or dissimilarity of the respective marks in their entireties.

We first consider the marks at issue. In doing so, 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 examining attorney argues that, in spite of the spelling differences, the literal portions of applicants' mark and the registered mark are phonetic equivalents. The examining attorney argues that the design portion of applicants' mark does not distinguish their mark from the

registered mark because the word portions of the marks are more likely to "be impressed upon a purchaser's memory" and, as such, should be accorded greater weight in determining likelihood of confusion, citing *In re Dakin's Miniatures Inc.,* 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976); and TMEP §1207.01(c)(ii).

The applicants contend that their mark and the registered mark have several distinguishing characteristics. First, applicants note that the registered mark is the possessive form of the name, Bobby, whereas the literal portion of applicants' mark is stylized and mixes upper and lower case lettering to form a plural of the name, "BOBbies." Applicants also argue that the design portion of their mark creates significant differences in the respective marks' appearance, meaning and commercial impression. Specifically, applicants argue the design portion of their mark is "suggestive of something having to do with cycling, and its highly stylized depiction creates a distinct commercial impression that is very different from the cited registration which contains only BOBBY'S in block letters."

Although we are in agreement with the examining attorney that the literal portions of both marks are phonetically the same and aside from the obvious fact they begin with the letters "BOBB…," we find that the marks have significant differences so that when they are considered as a whole, they are indeed dissimilar in appearance, commercial impression and meaning. Perhaps the most important difference is the presence and prominence of the design portion in applicants' mark. The design is quite large relative to the literal portion. Indeed, the term "BOBbies" is partially incorporated and placed under the wheels of the bicycle design. Applicants' argument that the design portion of their mark creates a distinct overall commercial impression is also persuasive. The fanciful, stylized depiction of a person with long hair flowing backwards while leaning forward on a bicycle injects a separate cycling or sportive theme into the mark that is not present in the registered mark. Because of the importance of the design portion to applicants' mark, we find that it visually dominates the mark and adds significantly to its commercial impression.

Regarding the meanings of the marks, we also find there is a difference. The registered mark is simply the possessive of the nickname, Bobby, and in connection with

registrant's department store services creates the impression that said services are rendered by or in some way connected with someone with the name "Bobby." On the other hand, the literal portion of applicants' mark, BOBbies, is the plural of the nickname.

In view of the above, we conclude that the literal portions of the marks are phonetically equivalent but the marks, as a whole, are otherwise dissimilar in their commercial impressions and appearance. There is also a slight difference in the meaning of the literal portions of the marks.

We turn now to the similarity or dissimilarity of registrant's department store services and applicants' goods. The evidence of record submitted by the examining attorney is scant at best. The examining attorney attached seven excerpted articles from the Nexis database and a dictionary definition of the term "department store."[3] However, the examining attorney only cited these excerpted articles in support of her refusal of applicants' mark based on the second (now cancelled) registration. Indeed,

[3] The examining attorney referenced *The Encarta World English Dictionary, North American Edition* (http://encarta.msn.com/) for a definition of a department store.

the examining attorney makes no mention of these excerpted articles in her brief.

The examining attorney argues that registrant's services and applicants' goods "need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source," citing a string of cases for this proposition. She then contends that a department store is, by definition, "a large store that sells a wide range of goods in separate departments" and "[a]s such, a department store would be likely to sell everything from the applicant's jewelry, to pens and pencils, to its cyclists' clothing. It is highly possible then, that consumers would mistakenly believe that the goods and services emanate from a common source."

Contrary to the examining attorney's position, there is no per se rule with respect to this du Pont factor where we find that one party's department store services are related to the other party's goods simply because the goods may be sold in a department store. Moreover, accepting the dictionary definition offered by the examining attorney, we acknowledge that department stores offer for sale a variety

of goods; however, the record is such that we cannot conclude that registrant's department store services are closely related to applicant's jewelry and women's cycling-related goods. Specifically, as to applicants' women's cycling-related goods, including clothing, there is no evidence that department stores normally carry such goods or that purchasers could expect to find such goods in a department store. Evidence is also lacking to establish that retail department stores normally sell jewelry (or any other of the applicants' goods) under their own house marks or brand names, or that purchasers normally would expect such goods to be sold under a department store's house mark or brand name.

Although not mentioned by the examining attorney in her brief, one of the excerpted articles actually supports her position that some of applicant's goods, the jewelry, may be found in a department store. Specifically, the article excerpt is as follows:

> Check out the collection, which also includes necklaces, earrings and rings, at Bloomingdale's Fine Jewelry department on the first floor.
>
> [excerpted from Chicago Sun Times, June 8, 2006]

This article excerpt is probative, but it does not, by itself or in conjunction with the dictionary definition of "department store," rise to the level of evidence needed to

demonstrate a similarity between registrant’s services and applicants’ jewelry. Again, even if the article excerpt indicates that a department store offers fine jewelry for sale, it does not establish that the department store applies its house mark or uses it own brand name for the jewelry.

In summary, when we balance the relevant du Pont factors in this case and in view of the record before us, we hold that confusion is not likely here.

Decision: The examining attorney's refusal to register under Section 2(d) is reversed.