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*Decision Mailed:
November 7, 2007
GDH/gdh*

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pearce & Pearce

Serial No. 78769245

Derek P. Martin of Martin & Associates, LLC for Robert W. Pearce and Erma Starlene Pearce.

Rebecca J. Povarchuk, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

Before Hohein, Bucher and Grendel, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Applicants, Robert W. Pearce and Erma Starlene Pearce, have filed an application to register on the Principal Register in standard character form the mark "CENTSIBLE SAM" for "retail department store services; [and] on-line retail department store services" in International Class 35.¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicants' mark, when applied to their services, so resembles

¹ Ser. No. 78769245, filed on December 8, 2005, which is based on an allegation of a bona fide intention to use such mark in commerce.

the collective membership marks "CENTSIBLE DRUG"² and "CENTSIBLE DRUG" and design,³ which are owned by the same registrant and are respectively registered on the Principal Register in standard character form and as reproduced below



for, in each instance, "indicating membership in an organization which is an alliance of independently owned drug and retail stores" in International Class 200, as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicants have appealed and briefs have been filed. We affirm the refusal to register.

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). See also In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). 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 factors of the similarity or dissimilarity in the services

² Reg. No. 1,865,085, issued on November 29, 1994, which sets forth a date of first use anywhere and in commerce of May 4, 1982; renewed. The word "DRUG" is disclaimed.

³ Reg. No. 1,864,105, issued on September 16, 1993, which sets forth a date of first use anywhere and in commerce of May 4, 1982; renewed. The word "DRUG" is disclaimed.

and collective membership at issue and the similarity or dissimilarity of the respective marks in their entireties.⁴ See also In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997).

Moreover, contrary to applicants' argument that, in light of the definitions of "service mark" and "collective mark" set forth in Section 45 of the Trademark Act, 15 U.S.C. §1127, "[t]he nature of the services in registrant's CENTSIBLE DRUG mark are ... dissimilar to the nature of the services in applicants' CENTSIBLE SAM mark due to the very difference in the types of marks," it is pointed out that a finding of likelihood of confusion between a collective membership mark and a service mark is not based on confusion as to the source of any services which may happen to be provided by the members of the collective organization. Instead, as correctly noted by the Examining Attorney, it is settled that the issue is whether relevant persons (that is, those persons or groups of persons for whose benefit the collective membership mark is displayed) are likely to believe that an applicant's services emanate from, are endorsed by, or are in some way associated with the collective organization. See, e.g., In re Code Consultants Inc., 60 USPQ2d 1699, 1700-01 (TTAB 2001); In re National Novice Hockey League, Inc., 222 USPQ 638, 640-41 (TTAB 1984); Allstate Life Insurance Co. v. Cuna International, Inc., 169 USPQ 313, 316 (TTAB 1971);

⁴ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the ... [services and collective membership,] and differences in the marks." 192 USPQ at 29.

and Boise Cascade Corp. v. Mississippi Pine Manufacturers Association, 164 USPQ 364, 367 (TTAB 1969).

The issue of likelihood of confusion in this case is therefore whether ordinary consumers, who as members of the general public plainly constitute the relevant persons herein as customers of applicants' "CENTSIBLE SAM" retail department store services and on-line retail department store services, would be likely to believe that applicants, in view of such services, are a member of, are endorsed by, or are in some other way associated with registrant's organization as the owner of the "CENTSIBLE DRUG" collective membership marks for indicating membership in an alliance of independently owned drug and retail stores. Clearly, inasmuch as registrant, which is an organization that consists of an alliance of independently owned drug and retail stores, could include among its members both retail department stores and on-line retail department stores, the second *du Pont* factor of the similarity or dissimilarity in the services and collective membership at issue favors a finding of a likelihood of confusion. The primary focus of our inquiry is accordingly on the first *du Pont* factor of the similarities and dissimilarities in the marks at issue and thus, as indicated above, whether ordinary consumers, upon encountering applicants' "CENTSIBLE SAM" mark in connection with retail department store services and on-line retail department store services, would be likely to be confused into thinking that applicants are a member of, are endorsed by or are otherwise affiliated with registrant's

"CENTSIBLE DRUG" alliance of independently owned drug and retail stores" due to the similarities of the respective marks.

With respect thereto, applicants contend that their "CENTSIBLE SAM" mark has a different appearance, sound, connotation and commercial impression than registrant's "CENTSIBLE DRUG" marks. Although conceding in their brief that, in particular, "[i]t is true that CENTSIBLE is the dominant term in registrant's CENTSIBLE DRUG mark[s]" due to the disclaimer of the generic term "DRUG," applicants maintain that because the term "CENTSIBLE" in their "CENTSIBLE SAM" mark is suggestive of the word "sensible" while the term "SAM" therein is arbitrary or fanciful, it is the latter term which constitutes the dominant portion of their mark and which precludes a likelihood of confusion. In this regard, applicants insist that:

The appearance of CENTSIBLE DRUG and CENTSIBLE SAM is different. While the first words are identical, the second words are entirely different, not related, not even close. The appearance of these two marks is therefore different. The sound of CENTSIBLE DRUG and CENTSIBLE SAM is different. Again, the first word has an identical sound, but the words "drug" and "sam" are very dissimilar in sound. As a result, the sound of these two marks is different. The connotation of CENTSIBLE DRUG and CENTSIBLE SAM is very different. The mark CENTSIBLE DRUG brings to mind a drug store. The mark CENTSIBLE SAM brings to mind a person named Sam who is sensible. The connotation of the two marks is therefore very different.

Considering, furthermore, that as to overall commercial impression, the marks at issue must of course be considered in their entireties, including any disclaimed matter, applicants stress that:

The word SAM in the mark CENTSIBLE SAM is arbitrary or fanciful. Indeed, the word SAM should be given greater weight in applicants' mark than CENTSIBLE because CENTSIBLE is pronounced the same as SENSIBLE, which can describe a person or thing, and therefore may be given less weight than the completely arbitrary word SAM. The entire mark CENTSIBLE SAM creates a unique commercial impression that is significantly different than CENTSIBLE alone and is drastically different than [registrant's] CENTSIBLE DRUG [marks].

We agree with the Examining Attorney, however, that the marks at issue "are highly similar" due to the shared presence on this record of the apparently coined or unique term "CENTSIBLE" in each. The Examining Attorney, in this regard, argues in her brief that "[t]he dominant term in each of the relevant marks is the term 'CENTSIBLE.'" Such is certainly true--as conceded by applicants--as to registrant's "CENTSIBLE DRUG" marks in view of the genericness of the word "drug" with respect to indicating membership in an organization which is an alliance of independently owned drug and retail stores. However, we need not determine whether the term "CENTSIBLE" constitutes the dominant portion of applicants' mark. Rather, it is plain that, at the very least, the term "CENTSIBLE" forms a significant source-indicative element of applicants' "CENTSIBLE SAM" mark when such mark is considered in its entirety, particularly given that, as pointed out by the Examining Attorney:

As a general rule, consumers are more inclined to focus on the first word, prefix or syllable in any ... mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); see also *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is

often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions).

In addition, as noted by the Examining Attorney, on this record the term "CENTSIBLE," while virtually the phonetic equivalent of the word "sensible," is at most suggestive of low cost retailers or retailing "and as such ... engenders a wider scope of protection than descriptive or weak terms."⁵

Specifically, she observes that:

It is worth noting that while applicants have referred to third[-]party registrations, they have not made of record, nor professed, the existence of a single mark for retail store services using either "centsible" or the phonetically similar "sensible." Applicants' and registrant's marks impart very unique commercial impressions stemming from the use of the identical term "CENTSIBLE," replacing "sens-" in "sensible" with the similar sounding "cent-." Using "cent" to refer to the smallest denomination of U.S. currency, "CENTSIBLE" suggests the "sensible" quality of being wise or careful with money. In connection with retail services, "CENTSIBLE" invokes the commercial impression of value or bargains for the money-wise consumer.

Accordingly, just as the term "CENTSIBLE DRUG" in registrant's marks would bring to mind a group of drug and other retail stores which are "sensible" to patronize due to the low cost merchandise or bargains available to money-wise consumers,

⁵ Although no copies thereof were attached, of the list of 14 third-party registrations included by applicants with their request for reconsideration of the final refusal, only one is indicated to be for the mark "CENTSIBLE," which is assertedly registered for "lint removing brushes, lint removing rollers and refills therefor, line [sic] roller handles, and adhesive lint remover." The 13 others are listed as being for marks which consist of or include the word "sensible" and, while applicants contend that such registrations "show that the term SENSIBLE is a very common term for products sold in retail department and drug stores," none lists any retail services.

applicants' mark "CENTSIBLE SAM" would bring to mind a department store retailer, or perhaps even a mascot or character for such a retailer, which is likewise "sensible" in that it offers frugal buyers inexpensive items or special values. Given that both applicants and registrant employ the unique term "CENTSIBLE" in their respective marks as a play on this notion of "sensible" retailing which offers consumers savings of money or cents on merchandise which they purchase, and in view of the fact that such term constitutes the first and thus a prominent portion of the marks at issue, it is plain that when considered in their entirety, applicants' "CENTSIBLE SAM" mark and registrant's "CENTSIBLE DRUG" marks are substantially similar in appearance, sound, connotation and commercial impression. Even among those consumers who notice the differences respectively provided by the elements "SAM" and "DRUG," such consumers would still be likely to believe, due to the substantial overall similarities in the "CENTSIBLE SAM" mark and "CENTSIBLE DRUG" marks, that applicants are a member of, are endorsed by or are otherwise affiliated with registrant's alliance of independently owned drug and retail stores. This would especially be the case if applicants, since they are seeking registration for their "CENTSIBLE SAM" mark in standard character form, were to elect to display their mark in a manner similar to registrant's "CENTSIBLE DRUG" and design mark, in which the term "CENTS" stands out due to the use of the cents sign (¢) for the letter "C" which is connected to an elongated letter "S." See, e.g., Phillips Petroleum Co. v. C. J. Webb,

Inc. 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) [a mark ... in typed or standard character form is not limited to the depiction thereof in any special form]; and INB National Bank v. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992) ["[a]s the *Phillips Petroleum* case makes clear, when [an] applicant seeks a typed or block letter registration of its word mark, then the Board must consider all reasonable manners in which ... [the word mark] could be depicted"]. The first *du Pont* factor of the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression thus favors a finding of a likelihood of confusion.

As noted earlier, the second *du Pont* factor favors a finding of a likelihood of confusion. Moreover, as to the related third and fourth *du Pont* factors of, respectively, the similarity or dissimilarity of established, likely to continue trade channels and the conditions under which and buyers to whom sales are made, that is, "impulse" versus careful, sophisticated purchasing, applicants admit in their brief--and we agree--that these factors favor a finding of a likelihood of confusion. In particular, applicants concede as to the third *du Pont* factor that:

Because the CENTSIBLE DRUG mark is used to indicate membership in an organization which is an alliance of independently owned drug and retail stores, the trade channel for the CENTSIBLE DRUG mark is to shoppers in the independently owned drug and retail stores that use its mark. The trade channels for applicants' CENTSIBLE SAM mark are to shoppers in retail department stores that use the mark and online retail department stores that use the mark. Due to the similarity of the trade channels of the two marks, the

third factor in the DuPont analysis favors refusing registration of applicants' mark.

In the same vein, applicants admit as to the fourth *du Pont* factor that:

The buyers for the CENTSIBLE DRUG mark are shoppers in independently owned drug and retail stores. The buyers for applicants' CENTSIBLE SAM mark are shoppers in retail department stores and online retail department stores. The conditions under which the sales are made are therefore similar. As a result, the fourth factor in the DuPont analysis favors refusing registration of applicants' mark.

With respect to the fifth *du Pont* factor of the fame of the prior mark, applicants argue that registrant's "CENTSIBLE DRUG mark has not achieved widespread fame"⁶ and that such factor therefore "favors registration of applicants' mark." However, even if registrant's mark were considered as not being famous, it is settled that, especially in an *ex parte* context, a lack of

⁶ Applicants premise such argument on the basis that the record allegedly shows that any use of registrant's marks "has been confined to the Chicago, Illinois area." Specifically, referencing both an article retrieved on March 17, 2007 from Drug Store News which is dated June 17, 1996 and states in pertinent part that "[t]here are approximately 40 Centsible pharmacies (independents participating in the voluntary program of wholesaler Dik Drug) in the Chicagoland market" and a list of the results from a June 12, 2007 search of the term "centsible drug" using the "GOOGLE" search engine which located various excerpts that refer to a single "Centsible Drug" at 208 South Hale St., Wheaton, Illinois 60187, applicants contend that:

Only one CENTSIBLE DRUG store can be found on this simple Google search. If ... the referenced article and Google search are accurate, this means the fame of the CENTSIBLE DRUG mark has diminished over the past 10+ years from 40 stores in the Chicago area to only one store. While applicants do not have any information regarding the sales and advertising for CENTSIBLE DRUG, the length of use, the limited use in only the Chicago area, and the diminishing use over the past 10 years shows the fame of the CENTSIBLE DRUG mark is small.

fame for such mark must be treated as neutral rather than as a factor which weighs in favor of applicants. See, e.g., In re Thomas, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006) ["It appears that applicant 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. This *du Pont* factor, as is normally the case in ex parte proceedings, must be treated as neutral"]. The fifth *du Pont* factor is thus neutral in this case rather than indicative of a lack of a likelihood of confusion.

Similarly, as to the remaining *du Pont* factors, such factors are neutral inasmuch as there is simply no evidence which is of record which is probative with respect thereto. While, in particular, applicants maintain that the 14 third-party registrations referred to previously (consisting of a single registration of the mark "CENTSIBLE" and the rest involving registrations for marks which consist of or include the term "SENSIBLE") demonstrate that the sixth *du Pont* factor of the number and nature of similar marks in use on similar goods favor registration of applicants' mark, it is well settled that third-party registrations are not evidence of use of the marks shown therein or that the public is aware of them. See, e.g., *Olde Tyme Foods, Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992); *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973); and *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269

(CCPA 1973). Thus, in the absence of probative evidence of third-party use, the sixth *du Pont* factor is neutral. Moreover, as to applicants' apparent conflation of the ninth *du Pont* factor with the sixth such factor by their reliance on the same third-party registrations as support for the contention that the ninth *du Pont* factor of the variety of goods on which a cited registrant's mark is or is not used (e.g., house mark, "family" mark or product mark) favors applicants, suffice it to say that the ninth *du Pont* factor focuses solely on the manner of the use of the cited registrant's mark. Consequently, even if the record contained proof of third-party use of the marks which are the subjects of the third-party registrations, such evidence would plainly be irrelevant to the manner of how the cited registrant's mark is used. The ninth *du Pont* factor is therefore neutral.

Applicants, furthermore, admit in their briefs--and we concur--that "[b]ecause applicants' CENTSIBLE SAM mark is based on applicants' intent to use the mark in commerce" rather than actual use, the following *du Pont* factors are neutral because there is no evidence with respect thereto: the seventh *du Pont* factor as to the nature and extent of any actual confusion; the eight *du Pont* factor concerning the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion; the tenth *du Pont* factor with respect to the market interface between applicants and the owner of the CENTSIBLE DRUG marks; and the thirteenth *du Pont* factor pertaining to any other established facts probative of the effect of applicants' use of [the mark] CENTSIBLE SAM. Although

applicants curiously concede that there is "no right [by applicants as yet] to exclude others from use of ... [their] CENTSIBLE SAM mark for the recited services, so the eleventh DuPont factor favors refusal of applicants' mark," we find that in the absence of evidence with respect thereto that such factor is instead neutral. Finally, while applicants assert that the twelfth *du Pont* factor is in their favor in that the extent of potential confusion is de minimis rather than substantial due to the claimed decline in use of registrant's mark in the Chicago area during the past ten years, suffice it to say that in view of the nationwide scope of registrant's cited registrations, any evidence, even if such were probative, of the extent of actual use of registrant's marks is irrelevant and, hence, the twelfth *du Pont* factor is at best neutral instead of indicative of an absence of a likelihood of confusion.

In balancing the *du Pont* factors discussed above, we note that several favor a finding of a likelihood of confusion and the remainder are neutral; none favors a determination of no likelihood of confusion. We accordingly conclude that because of the substantial similarities between the respective marks and the fact that applicant's "CENTSIBLE SAM" retail department store services and on-line retail department store services are encompassed by the drug and retail store services rendered by members of registrant's "CENTSIBLE DRUG" alliance of independently owned drug and retail stores," we conclude that the relevant purchasing public, namely, ordinary consumers would be likely to believe that applicants are a member of, endorsed by or

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otherwise affiliated with registrant's organization of independently owned drug and retail stores when in fact such is not the case. This likelihood of confusion as to affiliation bars registration of applicants' mark.

Decision: The refusal under Section 2(d) is affirmed.