

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Oddesse, Inc.

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Serial No. 78856580

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Rudy R. Singleton, Trademark Examining Attorney, Law Office 102 (Karen Strzyz, Managing Attorney).

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Before Seeherman, Hohein and Hairston, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Oddesse, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register SUGARVOD, in standard characters, for "streaming of adult-themed video material on the Internet; and Adult-themed video-on-demand transmission services" in Class 38.<sup>1</sup> Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15

U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark SUGAR and design, as depicted below, which is registered for, inter alia, "telecommunication services which allow a person to get in oral and visual communication with another, namely, transmission of voice, data and graphics by means of telephone, telegraphic, television, radio, cable, computer network and satellite transmissions," as to be likely, when used in connection with applicant's services, to cause confusion or mistake or to deceive.<sup>2</sup>



The description of the mark that appears in the registration states that "the mark consists of the word

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<sup>1</sup> Application Serial No. 78856580, filed April 7, 2006, based on Section 1(b) of the Trademark Act (intent to use).

<sup>2</sup> Registration No. 2829011, issued April 6, 2004. The registration also includes goods in Classes 9 and 16, but it is clear that the Examining Attorney considers applicant's mark is likely to cause confusion only with respect to the services in Class 38, and therefore we have limited our discussion to such services.

'SUGAR' in blue over a circle design which contains shades of dark and light blue."

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, 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). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Applicant's mark is SUGARVOD; the cited mark is the word SUGAR depicted within a circular design. As applicant has recognized, in comparing marks 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 a consideration of the marks in their entireties. In *re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In the present case, the term VOD is highly

descriptive of applicant's services. The Examining Attorney has submitted evidence showing that VOD is a recognized abbreviation for "video-on-demand." See definition in "Compact Oxford English Dictionary," reported at AskOxford.com. An entry in Webopedia, [www.pcwebopaedia.com](http://www.pcwebopaedia.com), states that "VoD" is

short for *Video-on-Demand*, an umbrella term for a wide set of technologies and companies whose common goal is to enable individuals to select videos from a central server for viewing on a television or computer screen. VoD can be used for entertainment (ordering movies transmitted digitally), education (viewing training videos), and videoconferencing (enhancing presentations with video clips). Although VoD is being used somewhat in all of these areas, it is not yet widely implemented. VoD's biggest obstacle is the lack of a network infrastructure that can handle the large amounts of data required by video.

Thus, VOD in applicant's mark would be viewed as a descriptive or generic term for applicant's "video-on-demand" transmission services, and it is the SUGAR portion of applicant's mark that consumers would regard as having source-indicating significance. As for the cited mark, again applicant has recognized that if a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by

purchasers to request the goods or services. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). That is the situation with the registrant's mark. The circle design is likely to be perceived as a mere background for the word SUGAR--in effect, as a "carrier" for the word mark. It is the word SUGAR, which is visually the most prominent part of the mark, and which is the only part of the mark that can be articulated, that will make the far greater impression on consumers. Thus, although we have compared the marks in their entireties, we give greater weight to the word SUGAR in both marks, and find that both marks are similar in appearance, pronunciation and meaning, and convey substantially the same commercial impression. Again, we recognize that when the marks are compared side-by-side, there are specific differences that can be identified. However, under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980). In the present case, even if consumers were to notice that applicant's mark contains the additional element VOD, they are likely to assume that the owner of the registered mark was using SUGARVOD to inform purchasers of the particular

nature of the video on demand services, rather than to view SUGARVOD as a mark indicating services coming from a separate source.

Accordingly, we find that the du Pont factor of the similarity of the marks favors a finding of likelihood of confusion.

During the course of prosecution, applicant submitted various third-party registrations for marks that contain the word SUGAR. Third-party registrations can be used in the manner of dictionary definitions, to show that a term has a particular significance in an industry. *Mead Johnson & Company v. Peter Eckes*, 195 USPQ 187 (TTAB 1977). We note that the third-party registrations submitted by applicant are primarily for goods in Class 9 and 16, and therefore these registrations do not show that SUGAR has a suggestive or descriptive meaning for services in Class 38, or that registrant's mark is entitled to a limited scope of protection vis-à-vis applicant's mark for Class 38 services.

The only third-party registration for services in Class 38 that applicant can point to is Registration No. 2698785 for the mark SUGARCULT for "providing on-line electronic bulletin boards for transmission of messages among computer users concerning musical groups; providing

on-line chat rooms for transmission of messages among computer users concerning musical groups." This single registration certainly does not prove that SUGAR has a suggestive or descriptive meaning for the registrant's identified telecommunication services. Moreover, there is a greater difference between SUGARCULT and the cited mark than there is between applicant's mark and the cited mark. Thus, the fact that the Office considered the two registered marks different enough to coexist does not show that there would be no confusion between applicant's mark and the cited mark. We also point out that the Board must decide each case on its own merits and that the USPTO's allowance of prior registrations does not bind the Board. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Thus, to the extent that applicant has relied on the third-party registrations to show that the cited registration is a weak mark and is entitled to a limited scope of protection, we are not persuaded by this argument.

We turn now to a consideration of the services. Applicant has, through the course of prosecution of its application, narrowed its identification and it now is limited to services which transmit material with an adult-themed content, namely, streaming of adult-themed video

material on the Internet and adult-themed video-on-demand transmission services. The cited registration is not limited as to the content of the communications it transmits; the services are identified as telecommunication services which allow a person to get in oral and visual communication with another, and it lists a variety of media for such communications, including computer network, satellite and television transmissions. Because the registrant's services are broadly described, they can include adult-themed communications, and the media for the transmissions include the same media as applicant's identified services, e.g., streamed on the Internet or video on demand transmissions through the Internet or television or satellite. Thus, applicant's services and the registrant's services, as they are identified, must be deemed to include the same classes of consumers, such as adults who wish to engage, through the Internet, in communications of a sexual nature with another person or persons, and also wish to view adult entertainment on a video on demand basis or through video streaming.

This similarity in the nature of the services and the consumers for the services would be sufficient for us to find the services related. However, the Examining Attorney has also made of record several third-party registrations

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which show that entities have adopted a single mark for services similar to those identified in applicant's application and the cited registration. See, for example, Registration No. 2934820 for, inter alia, electronic transmission of images, audio, voice and messages via satellite, television and communication networks and video-on-demand transmission services; Registration No. 3074361 for, inter alia, providing transmission of voice, data, facsimile and video via computer, television and telecommunications networks, voice and video conferencing services, and video on demand transmission services; Registration No. 3021927 for, inter alia, interactive communications services, namely, receipt, transmission and broadcasting of video and video-on-demand by means of satellite, the global computer network and other technologies that enable communications; Registration No. 2670316 for, inter alia, streaming of audio and video material on the Internet, electronic, electric and digital transmission of voice, images and messages, local and long distance transmission of voice, data, graphics by means of telephone, telegraphic, cable and satellite transmissions, and video on demand transmission services; and Registration No. 3023147 for, inter alia, video on demand television broadcasting and transmission services and electronic

transmission of voice, images, signals and messages. We acknowledge that only a few of the third-party registrations specifically mention that the transmissions have an adult-themed content, but that does not lessen the probative value of the registrations as showing that the general type of services identified in applicant's application and those identified in the cited registration are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). We also point out that registrants are not required to identify with particularity the specific subject matter of the communications that are transmitted using their services, and therefore one would not expect third-party registrations to contain such information. In this connection, we note that applicant originally identified its services as "Broadcasting services and provision of telecommunication access to films and tv programmes provided via a video-on-demand service; Streaming of video material on the Internet; Transmission of sound, video and information; Video conferencing; Video-on-demand transmission services." It was not until applicant filed its request for reconsideration that it restricted its identification to identify the content of its transmissions as having an adult theme.

We find that the du Pont factor of the similarity of the services favors a finding of likelihood of confusion.

Both applicant and the Examining Attorney have limited their arguments to the du Pont factors discussed above. Because of this, and because no evidence has been submitted on other factors, we, too, have limited our discussion to these factors. To the extent that any other factors are applicable, we must treat them as neutral.

Considering all of the evidence of record as it pertains to the *du Pont* factors, and for the reasons discussed above, we find that applicant's use of the mark SUGARVOD for its identified services is likely to cause confusion with the mark SUGAR and design for the services set forth in Registration No. 2829011.

Decision: The refusal of registration is affirmed.