

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: August 26, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Spice Entertainment, Inc.

Consolidated
Serial Nos. 77031138 and 78912571

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of Davis McGrath, LLC for Spice Entertainment, Inc.

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114 (K. Margaret Le, Managing Attorney).

Before Cataldo, Bergsman and Ritchie de Larena,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applications were filed by Spice Entertainment, Inc.
to register the following marks on the Principal Register:



¹ Application Serial No. 77031138 was filed on October 27, 2006, based upon applicant's assertion of its bona fide intent to use the mark in commerce.

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and

FRESH! (in standard characters)²

both for "broadcasting programs via a global computer network; television broadcasting" in International Class 38; and "entertainment in the nature of on-going television programs in the field of adult entertainment; television programming; television scheduling; television show production" in International Class 41.

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's marks, as intended to be used on or in connection with its services, so resemble the mark FRESH!, previously registered on the Principal Register in typed or standard character form for "entertainment magazine" in International Class 16,³ as to be likely to cause confusion.

When the refusal was made final in both cases, applicant appealed. Applicant and the examining attorney filed briefs on the issue under appeal in both cases. In addition, applicant filed a motion to consolidate the above-referenced appeals. In a paralegal order issued on

² Application Serial No. 78912571 was filed on June 20, 2006, based upon applicant's assertion of its bona fide intent to use the mark in commerce.

³ Registration No. 1502139 issued on August 30, 1998. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

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March 26, 2008, the Board granted applicant's motion to consolidate.

Because the examining attorney has cited Registration No. 1502139 as a bar to registration of both applications under consideration herein, and further because applicant and the examining attorney have presented essentially identical arguments on the issue under appeal on the same records, we will come to our determination with regard to both applications in this decision.

Likelihood of Confusion

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, 567 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key, though not exclusive, 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, 27 (CCPA 1976).

The Marks

We turn to the first *du Pont* factor, i.e., whether applicant's marks and registrant's mark are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). We note initially that the test under the first *du Pont* factor 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 terms of their overall commercial impression that confusion as to the source of the goods 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. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

In this case, however, applicant's mark, FRESH!, in its application Serial No. 78912571 is identical to the mark in the cited registration in every respect. Use of identical marks is a fact which "weighs heavily against applicant." See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984); and *In re*

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Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993).

In addition, applicant's mark in its application Serial No. 77031138, displayed below,



incorporates in its entirety the cited mark, FRESH!, as its most distinctive element. The three petal design in applicant's mark appears after and slightly below the word FRESH! and the design is also smaller in size relative thereto. As a result, the petal design visually contributes less to the mark's overall commercial impression than the wording. Furthermore, there is nothing to suggest that consumers will verbalize the petal design. Thus, the design is less significant than the wording because consumers will refer to or request the identified services by the word FRESH!. *See In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). In addition, the three petal design connotes freshness, lending additional emphasis to the word FRESH!. For these reasons, we consider FRESH! to be the dominant feature of the applied-for mark. When viewed in its entirety, we find that the applied-for mark is nearly identical to registrant's mark in appearance and identical in sound. We further find that

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inasmuch as both marks may connote that the content of the goods or services identified thereby is "fresh" as opposed to dated, stale or passé, applicant's mark is identical to the mark in the cited registration in connotation. We find therefore that the marks convey nearly identical commercial impressions. As a result, consumers are likely to view the marks as variations of each other, but indicating a single source.

Thus, as discussed above, applicant's mark in its application Serial No. 78912571 is identical to the mark in the cited registration. Applicant's mark in its application Serial No. 77031138 is essentially identical thereto in appearance, sound, connotation and overall commercial impression. Accordingly, this *du Pont* factor heavily favors a finding of likelihood of confusion.

Strength of the Cited Mark

Applicant argues that registrant's mark is weak and entitled to a limited scope of protection. In support of this contention, applicant has submitted a dictionary definition of "fresh" with its appeal brief.⁴ According to

⁴ The American Heritage Dictionary of the English Language, 4th Ed. (2000). The Board hereby takes judicial notice of this dictionary definition. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002). See also *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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this definition, fresh may be defined, *inter alia*, as follows: new to one's experience, not encountered before; novel, different; having the glowing, unspoiled appearance of youth; untried, inexperienced; bold and saucy, impudent; excellent, first rate. This dictionary definition supports a finding that FRESH may suggest that the subject matter of registrant's goods or, for that matter, applicant's services, is novel, first rate, or even bold and saucy. However, such definition does not support a finding that FRESH is a highly suggestive or otherwise weak mark as applied to either the goods or services.

In addition, applicant has made of record printed copies of a number of third-party registrations taken from the United States Patent and Trademark Office's (USPTO) Trademark Applications and Registrations Retrieval (TARR) database, containing the word FRESH alone or in context with other words and designs for magazines as well as a variety of other goods and services. The following are illustrative:

1. Registration No. 2985481 for the mark FRESH for supermarket magazines;
2. Registration No. 2799388 for the mark FRESH ATTITUDES for magazines for mass merchandising of retail and grocery store consumer products;

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3. Registration No. 1812891 for the mark FRESH MEN for magazine featuring erotic articles and photographs of young male models;

4. Registration No. 2666331 for the mark FRESH FAITH for greeting cards, note cards, and stationery;

5. Registration No. 2824644 for FRESH for notebooks, binders, zipper pouches for pens and pencils, stationery-type portfolios; and

6. Registration No. 2450997 for FRESH TRENDS for trade publications, namely, a magazine for growers, wholesalers, and retailers of fresh fruits and vegetables.

However, applicant's evidence of third-party registrations is entitled to limited probative value.⁵ The registrations are not evidence of use of the marks shown therein. As a result, they are not proof that consumers are familiar with such marks so as to be accustomed to the existence of the same or similar marks in the marketplace. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982). Thus, applicant's proffered third-party registrations simply

⁵ The third-party applications also submitted by applicant are only evidence that an applicant has filed for registration of a mark, and thus have no probative value. See *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002).

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indicate that the USPTO has registered a number of "FRESH" formative marks in relation to various goods and services, only one of which, FRESH MEN, is arguably related to the goods or services in the involved applications or cited registration. Such evidence fails to establish that the consuming public has been exposed to third-party use of similar marks on similar goods or services, such that consumers would distinguish applicant's mark, FRESH! and petal design, from the cited mark, FRESH!, based on the very minor differences between them, to say nothing of applicant's FRESH! mark that is identical to the mark in the cited registration.

Third-party registrations also may be used in the manner of dictionary definitions to show that a term has a certain significance in a particular field. Similar to dictionary definition submitted by applicant, the registrations made of record suggest that the content of the goods and services recited therein is novel, first rate, or otherwise current. However, even if we were to conclude, based on applicant's evidence, that registrant's mark is entitled to a more narrow scope of protection than a totally arbitrary mark, the scope is still broad enough to prevent the registration of an identical or a highly similar mark for services that are highly similar to the

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services identified in the cited registrations. See *In re Farah Manufacturing Co., Inc.*, 435 F.2d 594, 168 USPQ 277, 278 (CCPA 1971).

The Goods and Services

We turn then to a consideration of the goods and services. In making our determination regarding the relatedness thereof, we must look to the goods and services as identified in the involved applications and cited registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).⁶ See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

We note, at the outset of considering this *du Pont* factor, that the greater the degree of similarity between applicant's marks and the cited registered mark, the lesser the degree of similarity between applicant's services and registrant's goods that is required to support a finding of likelihood of confusion. See *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). If the marks are the same, as in this case, it is only necessary that there be a

⁶ Applicant acknowledges that because the recited goods and services contain no limitations as to their trade channels, registrant's goods and applicant's services are presumed to move in all normal channels of trade therefor and be available to all classes of potential consumers. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

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viable relationship between the goods and services in order to support a finding of likelihood of confusion. *See In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983).

Furthermore, it is not necessary that the goods and services at issue be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient instead that the respective goods and services are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and 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 originate from the same producer. *See In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, applicant's services are "broadcasting programs via a global computer network; television broadcasting" in Class 38 and "entertainment in the nature of on-going television programs in the field of adult entertainment; television programming; television scheduling; television show production" in Class 41. Clearly, these services are not the same as registrant's

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"entertainment magazines." We note, however, that "entertainment," which is the subject matter of registrant's magazines, is very broad and encompasses applicant's more narrowly identified "adult entertainment" which is the subject matter of its television programs. Further, applicant's television programming, scheduling and production may be presumed to involve television programs featuring entertainment. Thus, as identified, applicant's Class 41 services and registrant's goods would appear to be related inasmuch as both pertain to providing entertainment in different media, that is, television versus printed magazines.

In addition, the examining attorney has made of record the following use-based, third-party registrations which show that various entities have adopted a single mark both for magazines as well as television programs, television production services and on-line entertainment involving various subject matter:⁷

⁷ The Examining Attorney further made of record registrations based on Section 44 of the Trademark Act. Because these registrations are not based on use in commerce they have no probative value in showing the relatedness of the goods and services, and they have not been considered. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). Nor do we find probative those third-party registrations which are for goods and/or services that are different from those identified in the applications and the cited registration. Also, as discussed above, the examining attorney's submitted applications are only

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Registration Nos. 3301964 and 3352327 (owned by the same entity) for, *inter alia*, magazines in the field of sexual statistics and trivia, outstanding and unusual sexual achievements, and failures or occurrences related to sex, for entertaining and education, and on-going television and radio programs in the field of sexual statistics and trivia, outstanding and unusual sexual achievements, and failures or occurrences related to sex; and

Registration No. 3045741 for, *inter alia*, publications, namely, periodicals, books, and magazines in the field of dance performances, television show production, production of radio and television programs.

Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993).

Based upon the goods identified in the cited registration and the services recited in Class 41 of the involved applications, as well as the above third-party evidence of record, we find that applicant's adult entertainment television shows, as well as applicant's television programming, scheduling and television show

evidence that an applicant has filed for registration of a mark. See *In re Phillips-Van Heusen Corp.*, *supra*.

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production, are related to registrant's entertainment magazines.

Further, and as discussed above, applicant's Class 38 services, identified as "broadcasting programs via a global computer network; television broadcasting" may be presumed to include the broadcasting of television and internet programs featuring entertainment. As such, the subject matter of applicant's broadcasting services includes the subject matter of registrant's "entertainment magazines." Viewed another way, registrant's magazines, which broadly cover entertainment, may feature articles or otherwise discuss applicant's broadcasts. As a result, we find that a viable relationship exists between registrant's magazines and applicant's broadcasting services such that consumers encountering them under their identical or nearly identical marks are likely to believe that these goods and services may emanate from a common source.

As such, based upon the record before us this *du Pont* factor also favors a finding of likelihood of confusion.

Summary

In light of the foregoing, particularly given that applicant's marks are, respectively, identical and nearly identical to the mark in the cited registration, and resolving any doubt as we must in favor of the prior

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registrant, we find that a likelihood of confusion exists between the applied-for marks in both applications and the mark in the cited registration as to both classes of services. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal of registration of application Serial Nos. 77031138 and 78912571 is affirmed.