

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

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re IceBreaker, Inc.

Serial No. 78971012

James J. Pingor of Amin, Turocy & Calvin, LLP for  
IceBreaker, Inc.

William M. Rossman, Trademark Examining Attorney, Law  
Office 109 (Dan Vavonese, Managing Attorney).

Before Seeherman, Grendel and Taylor, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

IceBreaker, Inc. has appealed from the final refusal  
of the Trademark Examining Attorney to register  
ICEBREAKER\*# and design, as shown below, for services  
identified, as amended, as

social networking services, namely,  
internet and mobile network based  
social networking, introduction and  
dating services via mobile  
communicative devices such as mobile  
phones; online social networking  
services via mobile communicative

devices such as mobile phones;  
providing a database featuring  
information regarding social networking  
services, namely, personal ads, love,  
romance and dating services (Class 45).<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 previously registered mark ICEBREAKERS for "pre-recorded video tapes in the field of interpersonal relationships, matchmaking and helping people meet other people" (Class 9) and "printed instructional materials and books in the field of interpersonal relationships, matchmaking and helping people meet other people" (Class 16).<sup>2</sup>

As a preliminary matter, we must comment on the manner in which the Examining Attorney has attempted to make some evidence of record. It appears that the Examining Attorney inserted hyperlinks in the June 21, 2007 and November 27,

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<sup>1</sup> Application Serial No. 78971012, filed September 11, 2006. The application was originally based on Section 1(a) of the Act, and included goods in Class 9 as well as services in Class 45. During the course of prosecution, applicant deleted the goods in Class 9 and amended the application to an intent-to-use basis in order to attempt to overcome various refusals.

<sup>2</sup> Registration No. 2942408, issued April 19, 2005.

2007 Office actions, which allow the reader to "click" on the link to reach an Internet site. The problem with this evidence is that there is no assurance that the content of the linked material is the same today as it was when the Examining Attorney included it in the Office action or when the applicant read it. As a result, we can give this changeable or changing evidence no probative value. The better practice is to submit as part of the Office action copies of the webpages or screen shots of the webpages that were in existence at the time the Office action was written.

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, 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).

Turning first to the marks, the literal element of applicant's mark, ICEBREAKER, is virtually identical to the registrant's mark, ICEBREAKERS. Although applicant's mark also has a strong visual design element because the letters of ICEBREAKER are laid out on a telephone keypad, that design element is not sufficient to distinguish the marks. Applicant's mark will still be referred to as ICEBREAKER, because it is the only part of applicant's mark that can be articulated, and therefore it will make a stronger impression on consumers. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). This is particularly true because applicant's social networking and dating services are the type of services that may be recommended by word of mouth, where the design element would not have an impact. Moreover, because applicant's services are rendered through mobile communicative devices such as mobile phones, the keypad design is likely to be viewed as referencing the manner in which applicant's services are provided.

It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, 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). For the above-discussed reasons, we have given more weight to the word ICEBREAKER in applicant's mark.

Because the marks are virtually identical in pronunciation, similar in appearance and connotation, and convey the same commercial impression, the du Pont factor of the similarity of the marks favors a finding of likelihood of confusion.<sup>3</sup>

With respect to the goods and services, we begin our analysis with the well-established principle that it is not necessary that the goods or services of applicant and the registrant 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 that the respective goods 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

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<sup>3</sup> In reaching this conclusion, we have given no weight to the Examining Attorney's argument that, because the registrant's mark is registered in typed form, we must consider that it could be depicted with the same line breaks that are used in applicant's mark, i.e., with ICE on the first line, BRE on the second line, AKE on the third line, and R on the fourth line. Although a registration for a typed mark format (now called standard character format) does not limit the protection accorded the mark to a particular typestyle or font, it would not encompass the odd line breaks that the Examining Attorney suggests.

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). Here, both applicant's services and the registrant's goods involve dating, whether it is called, in the identification of applicant's services, social networking, introduction and dating services, and providing a database featuring personal ads, romance and dating services, or, in the identification of registrant's goods, "interpersonal relationships, matchmaking and helping people meet other people." The purpose of both the services and the goods are the same: enabling the customer to meet people for the purpose of social networking or dating. Although, as applicant points out, the media through which these purposes are accomplished are different, with applicant offering its services through the Internet and mobile communicative devices such as mobile phones, and the registrant using video tapes, printed instructional materials and books, the goods and services are clearly related and, at the very least, complementary. That is, even if the registrant's goods do not in fact offer potential dates or matches, but concentrate more on how one can go about meeting other people (as applicant puts it, "relationship advice", reply brief, p. 3), registrant's

goods can be seen as a helpful complement to how one presents oneself when using the dating and social networking services identified in applicant's application. As a result, consumers are likely to believe that applicant's services are an extension of the registrant's goods. This du Pont factor, too, favors a finding of likelihood of confusion.<sup>4</sup>

Applicant has argued that the classes of consumers for applicant's services and the registrant's goods are different because "consumers utilizing the specialized

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<sup>4</sup> In reaching this conclusion, we have given little weight to the evidence submitted by the Examining Attorney of third-party registrations. Third-party registrations which individually include some of the goods and services that are included in both the applicant's and the registrant's identification of goods and services, and which are based on use in commerce, are evidence that the listed goods 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). However, in this case none of the third-party registrations made of record by the Examining Attorney appears to include both the services identified in applicant's application and the goods identified in the registrant's registration. For example, in his brief the Examining Attorney points to Registration No. 3112102 as showing that applicant's services and the registrant's goods are included in one registration. However, that registration is only for services in Class 45; it does not include pre-recorded video tapes or books. Registration No. 2810640, while it includes videotapes and printed publications featuring relationship information, does not include the services identified in applicant's application. Rather, the services are "counseling services pertaining to interpersonal relationships." Registration No. 32435452 is for services only; video dating services are not the same as the registrant's identified pre-recorded video tapes. We have discussed these specific registrations because the Examining Attorney listed them in his brief, and therefore we presume he believed that they were the most probative of the third-party registrations he made of record.

technology associated with Applicant's networking services are not likely to purchase a pre-recorded instruction video tape on dating." Reply brief, p. 3. It is applicant's position that "Applicant's consumers are more likely to download information from the Internet rather than purchase pre-recorded video tapes." Brief, p. 6. We are not persuaded by these statements. As noted above, one using a mobile telephone (although applicant characterizes it as specialized technology, mobile telephones and the like are ordinary consumer products) to access a dating service may also read books or view video tapes to obtain dating advice. Consumers that use the Internet or mobile communications devices also watch video tapes and buy books, and there is no evidence to support applicant's position that they would not purchase video tapes and books on relationship advice from retail stores, but only download them from the Internet. On the contrary, the Examining Attorney submitted evidence that an Internet dating website, [www.datingondemand.com](http://www.datingondemand.com), has a link to "singles life store," which offers print materials and books with relationship advice, including "Bar Code: Your Personal Pocket Decoder to the Modern Dating Scene." Request for reconsideration, pages 110-114. This material is evidence that printed materials and dating services can

be offered through the same websites. However, even if we accept that the specific channels of trade for social networking and dating services rendered through mobile communications devices will be different from those for pre-recorded videotapes and printed publications, the classes of consumers must be considered the same. Further, because the consumers are likely to encounter both the goods and the services, and because the goods and the services have complementary purposes, the differences in the channels of trade in which the goods and services are offered does not obviate the likelihood of confusion.

With regard to the conditions of purchase, applicant contends that "consumers of the goods and services at issue are interested in purchasing a very specific service in a highly specialized and technological field related to computer, software and mobile communicative devices." Brief, p. 7. Again, the fact that applicant's services are rendered by mobile communicative devices or the Internet does not make the consumers for its social networking and dating services sophisticated. It does not require any particular sophistication to use the Internet or mobile communication devices such as mobile telephones or mobile telephones that have Internet access/capabilities. The purchasers of applicant's services and the registrant's

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goods must be deemed to be the public at large, and we cannot assume that they have any particular sophistication about the goods or services at issue. This du Pont factor is neutral.

In view of the foregoing, and particularly in view of the similarity of the marks and the relatedness of the goods and services, we find that applicant's mark for its identified services is likely to cause confusion with ICEBREAKERS for the goods identified in Registration No. 2942408.

Decision: The refusal of registration is affirmed.