

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF  
THE TTAB

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U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Thomas Nelson, Inc.

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Serial No. 74/648,091

Edward D. Lanquist, Jr. of Wadley & Patterson for Thomas  
Nelson, Inc.

Jeffrey D. Martin, Trademark Examining Attorney, Law Office  
107 (Thomas Lamone, Managing Attorney).

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Before Sams, Rice and Hanak, Administrative Trademark  
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Thomas Nelson, Inc. (applicant) seeks registration of  
INSPIRATIONS THOMAS NELSON GIFTS in the stylized form shown  
below for note pads in Class 16 and mugs in Class 21. The  
application was filed on March 17, 1995 with a claimed first

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use date of June 10, 1994 as to both types of goods. At the request of the Examining Attorney, applicant disclaimed the exclusive right to use the term GIFTS apart from the mark in its entirety.



*Inspirations*  
**THOMAS NELSON GIFTS**

As clarified in his brief, the Examining Attorney has no objection to the registration of the above mark for mugs. However, the Examining Attorney refused registration pursuant to Section 2(d) of the Lanham Trademark Act on the basis that applicant's mark, as applied to note pads, is likely to cause confusion with the mark INSPIRATION previously registered by Westvaco Corporation for writing paper, index bristol and book papers (Registration No. 553,363) and for printing papers (Registration No. 1,301,645).

When the refusal was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

In arguing that there is no likelihood of confusion, applicant makes two primary arguments. First, applicant contends that the term INSPIRATION(S) is so widely used in connection with stationery products such that it has become

a very "weak" source identifier. Second, applicant contends that the use of its trade name THOMAS NELSON in its mark INSPIRATIONS THOMAS NELSON GIFTS is sufficient to distinguish its mark from the cited mark INSPIRATION.

In support of its first argument, applicant submitted the declaration of its counsel who stated that he performed searches on private data bases for federal and state registrations and applications containing the word INSPIRATION(S) for stationery products, and for the names of companies (trade names) which contain the word INSPIRATION(S) and which sold or manufactured stationery. In addition to the two cited registrations, the federal trademark search revealed applicant's own prior registration of MARKINGS INSPIRATIONS for stationery and note pads, as well as three applications marked "pending -- published for opposition" for marks consisting of or containing the word INSPIRATION(S) for various stationery items. The state trademark search revealed that there are nine marks containing the word INSPIRATION(S) for paper products or for the services of selling paper products. Finally, the company name search revealed that there are 24 companies whose names consist of or contain the word INSPIRATION(S) and which are engaged in the business of manufacturing or selling stationery. With regard to this company name search, applicant's counsel made the following statements in paragraph three of his declaration:

Exhibit 3 attached hereto shows a list of companies using "INSPIRATION" in connection with stationery. Each of these were called on August 21, 1995, by me. Each answered the phone using the company name which included the term "INSPIRATION." Each was asked if they sold or manufactured stationery. Each stated that they sold or manufactured stationery.

In response, the Examining Attorney did not object to the fact that the applicant did not make of record copies of the federal and state registrations and applications. However, with regard to the state registrations and applicant's "confirmed" company name search, the Examining Attorney contended that this evidence is "of no probative value inasmuch as the Office examines the weakness of the mark in the context of common law use among federal registrations." (Office Action No. 2 page 2, emphasis added).

In his brief, the Examining Attorney correctly argues that third-party registrations and applications do not demonstrate that the marks registered or applied for have been used, or have had any impact upon purchasers. (Examining Attorney's brief page 6). The Examining Attorney then goes on to note that "a list of trade names of businesses which sell books and stationery or print stationery containing the term INSPIRATION is not sufficient evidence to demonstrate use of the term INSPIRATION as a trademark used on paper products. Such evidence merely

shows use as a trade name in connection with retail sales."  
(Examining Attorney's brief pages 6-7).

With regard to the Examining Attorney's latter contention, two comments are in order.

First, a mere list of trade names (like a mere list of trademarks and services marks) does not prove that the trade names have been used. However, what does prove that the trade names have been used is the declaration of applicant's counsel wherein he states that he personally called each of the 24 companies and confirmed that their company names (trade names) included or consisted of the word INSPIRATION(S) and that under these trade names, they "sold or manufactured stationery."

Second, extensive use of a term as a trade name can "weaken" the source identifying function of that term. For this weakening to occur, the term need not have been used as a trademark or a service mark, and it certainly need not have been used as a trademark or service mark registered with the PTO, as the Examining Attorney states in Office Action No. 2. See In re Broadway Chicken Inc., 38 USPQ2d 1559, 1565-66 (TTAB 1996) wherein the Board made the following determinations (emphasis added):

The evidence offered by applicant is sufficient to establish prima facie that a significant number of third parties are using trade names/services marks containing the term BROADWAY for restaurant/"eating place" services. ... Evidence of widespread third-party use, in a particular field, of marks [or names] containing a certain

shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the mark as a means of distinguishing the source of the goods or services in the field.

Viewing the record in its entirety, we find that applicant has established that the term INSPIRATION(S) has been used so extensively by third parties in connection with the manufacture or sale of stationery such that it has become a "weak" source identifier for such types of products and services, and that the public has now become accustomed to looking for other words or designs to distinguish one mark or name from another.

Given the fact that the term INSPIRATION(S) is weak, we find that the presence of the words THOMAS NELSON GIFTS in applicant's mark (albeit in decidedly subordinate fashion) is sufficient to distinguish applicant's mark from the cited INSPIRATION per se. In so doing, we note that applicant's goods (note pads) and certain of registrant's goods (writing paper) are very closely related. However, this was also the case in Broadway Chicken where all the trade names and services marks involved various types of restaurants.

In short, despite the fact that the goods are very closely related and the fact that the most prominent (in terms of size) portion of applicant's mark (INSPIRATIONS) is virtually identical to the cited mark INSPIRATION, nevertheless, we find there exists no likelihood of confusion given the fact that the term INSPIRATION(S) is a weak source identifier, and the additional fact that

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applicant's mark contains (albeit in subordinate fashion)  
the name THOMAS NELSON.

Decision: The refusal to register is reversed.

J. D. Sams

J. E. Rice

E. W. Hanak  
Administrative Trademark Judges  
Trademark Trial and Appeal Board

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