

THIS DISPOSITION IS
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **WoodenBoat Publications, Inc.**

Serial No. 74/**677,107**

Timothy A. French and Donna M. Weinstein of **Fish & Richardson P.C.** for applicant.

LaVerne T. Thompson, Trademark Examining Attorney, Law Office 109 (**Deborah Cohn**, Managing Attorney).

Before **Seeherman, Hohein** and **Hairston**, Administrative Trademark Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

An application has been filed by WoodenBoat Publications, Inc. to register the mark "HOPE MAGAZINE," in the stylized format reproduced below,



for "magazines of inspirational stories and information".¹

¹ Ser. No. 74/677,107, filed on May 19, 1995, which alleges a bona fide intention to use the mark in commerce. The stippling "is a feature of

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "HOPE MAGAZINE," which is registered for "magazines dealing with homelessness,"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Turning first to consideration of the respective marks, we agree with the Examining Attorney that, when considered in their entirety, the marks are identical in sound and meaning and are virtually identical in appearance. Although applicant stresses that its mark "includes a significant design element comprised of the lettering and placement of the words in the mark and ... the distinctive shaded 'O' design in the word 'Hope,'" the Examining Attorney correctly points out that registrant's mark, being in typed form, is not limited in its depiction to any particular stylization. See Phillips Petroleum Co. v. C. J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). Instead, the typed format of registrant's mark means that registrant's rights therein extend to all reasonable manners in which the words "HOPE MAGAZINE" could be depicted, including the same manner of lettering and placement of such words as in applicant's

the mark for shading purposes only and is not intended to indicate color." The word "MAGAZINE" is disclaimed.

² Reg. No. 1,781,395, issued on July 13, 1993, which sets forth dates of first use of March 1, 1992. The word "MAGAZINE" is disclaimed.

mark. See INB National Bank v. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992). Consequently, we concur with the Examining Attorney that "the shading of the letter 'O' in [the word] 'HOPE' is a marginal design element at best" in applicant's "HOPE MAGAZINE" and design mark. Such stippling, the Examining Attorney properly notes, "neither changes the meaning nor the commercial impression of the [applicant's] mark" from the connotation and commercial impression projected by registrant's mark. Contemporaneous use of the respective marks in connection with the same or closely related goods is likely, therefore, to cause confusion as to source or sponsorship.

Turning, then, to consideration of the respective goods, it is clear that such goods are magazines which would be sold through the same channels of trade to the same class of ordinary purchasers. Applicant contends, however, that "[t]he focus of each magazine is quite distinct, [with] applicant's publication dealing with stories having a general inspirational theme, and registrant's [magazine] dealing with a specific social welfare issue--namely, homelessness." Applicant maintains, in view thereof, that this case is analogous to the situation in Lang v. Retirement Living Publishing Co. Inc., 949 F.2d 576, 21 USPQ2d 1041, 1045 (2d Cir. 1991), in which the court, finding no likelihood of confusion between the mark "NEW CHOICES FOR THE BEST YEARS" for a magazine directed to older adults and the trade name "NEW CHOICES PRESS" as utilized in connection with a book and tapes about charisma, reasoned that:

Because Retirement Living's magazine caters to the interests of older adults generally, whereas Lang's publishing house markets her book and tapes to all people who seek specifically to enhance their charisma, the products neither compete nor serve the same purpose. Lang's book and tapes are best classified as image-building products; Retirement Living's magazine addresses diverse topics of interest to mature consumers, including travel, finance, health and nutrition. The two companies' products are not used together. Although both Lang's publishing house and Retirement Living's magazine are in the field of publishing, this does not render them proximate. . . .

Likewise, in light of the diversity in subject matter of the respective magazines herein, and given the high degree of suggestiveness inherent in the respective marks, applicant insists that:

No likelihood of confusion would result from use and registration of these titles for such different publications. "Hope" is a highly suggestive concept, no doubt for that reason forming part of two other registered marks for publications: HOPELINES for, inter alia, children's magazines (Reg. No. 1,719,452); and HOPE HEALTH LETTER for information letters dealing with health and fitness.

The Examining Attorney, although objecting to applicant's reference in its brief to the two-third party registrations referenced above,³ argues that inspirational

³ Besides noting that the mere submission of a list of registrations is generally insufficient to make the registrations of record, the Examining Attorney contends that such evidence is untimely under Trademark Rule 2.142(d). However, rather than being mentioned for the first time in applicant's brief, the third-party registrations were previously referred to by applicant in response to the initial Office action. Nevertheless, the Examining Attorney, in her final refusal, neither apprised applicant of the deficiency and concomitant need to submit actual copies of the third-party registration if such were to be properly considered, nor otherwise responded to applicant's reference thereto. Consequently, the Examining Attorney has waived

stories and articles about homelessness are closely related subject matter since, as shown by the excerpts made of record by the Examining Attorney from her searches of the "NEXIS" database,⁴ "[s]tories of the homeless have been the source of inspiration for individuals, publications, songs, television shows, and motion pictures." The most pertinent of such excerpts are set forth below (**emphasis added**):

Two Madison County women are hoping profits from their aluminum recycling business will help end a cycle of poverty and homelessness.

Tammi Herschell's contract with a Downtown **homeless** man wheeling a cart full of cans was her **inspiration** for Cans R Us, a vending machine-type can recycling operation. -- Columbus Dispatch, March 8, 1996, News Local & National, at 10B (article headlined: "PAIR STARTS BUSINESS TO BENEFIT **HOMELESS**");

After talking with people at inner-city churches, shelters and on the streets, IBS created "Jesus Was **Homeless**," an **inspirational** pamphlet The booklet explores how Jesus spent time on the streets and interacted with people and gives Scriptural references and quotes. -- Charleston Gazette Mail, February 18, 1996, News, at 02C;

"Wall of Hope" ... is displayed in the Philadelphia Committee to End **Homelessness'** resource center. This art collage, which spans across four walls, ... consists of ceramic, mirror pieces and photos. It is intended to provide **inspiration** to the **homeless** who utilize the center. -- Philadelphia Tribune, August 25, 1995, at 2-B; and

any objections to the third-party registrations referred to by applicant and we have considered them for whatever probative value they may have.

⁴ Specifically, the Examining Attorney on June 10, 1996 searched the "ALLNWS" file of the "NEWS" library using the search requests "HOMELESS! W/8 INSPIRATION!" and "INSPIRATION! W/5 HOMELESS!".

"The Saint of Fort Washington" --
Inspirational drama about two **homeless** men
(Danny Glover and Matt Dillon) in New York
who turn their lives around when they become
friends. -- Atlanta Journal & Constitution,
August 29, 1993, Arts, §K, at 19.

While the respective marks, as contended by applicant, are indeed highly suggestive, they nevertheless suggest essentially the same theme of fulfillment or desire for betterment when applied to magazines dealing with the shared or common subject matter of inspirational stories about homelessness. The condition of homelessness, as the evidence furnished by the Examining Attorney clearly shows, has repeatedly served as the basis for inspiring others. Far from being diverse subject matter, the excerpts of stories made of record by the Examining Attorney are sufficient to demonstrate an overlap of coverage such that "[c]onsumers would expect inspirational stories from a magazine dealing with homelessness and would expect magazines featuring inspirational stories in general to also feature articles about homelessness." Contemporaneous use of such essentially identical marks as applicant's "HOPE MAGAZINE" and design mark for magazines of inspirational stores and information and registrant's "HOPE MAGAZINE" mark for magazines dealing with the closely related subject matter of homelessness is thus likely to cause confusion as to source or sponsorship.

Finally, to the extent that we may nevertheless entertain any doubt as to the above conclusion, we resolve such doubt, as we must, in favor of the registrant. See In re

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Pneumatiques Caoutchouc Manufacture et Plastiques Kelber-
Columbes, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

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

E. J. Seeherman

G. D. Hohein

P. T. Hairston
Administrative Trademark Judges,
Trademark Trial and Appeal Board