

THIS OPINION IS CITABLE AS  
PRECEDENT OF THE TTAB

APRIL 27, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Mosby-Year Book, Inc.

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Serial No. 75/050,481

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Ava K. Doppelt of Allen, Dyer, Doppelt, Milbrath & Gilchrist; and Katherine L. McDaniel, Esq. and Avis Frazier-Thomas, Esq. for applicant.

Jodi Lauterbach, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

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Before Hanak, Quinn and Walters, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Mosby-Year Book, Inc. has filed a trademark application to register the mark ACE THE BOARDS for a "series of books on the subject of medicine."<sup>1</sup> The

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<sup>1</sup> Serial No. 75/050,481, in International Class 16, filed January 30, 1996, based on an allegation of a bona fide intention to use the mark in commerce. On April 9, 1996, applicant filed an amendment to allege use and specimens of use, alleging a date of first use and first use in commerce as of March 20, 1996.

application includes a disclaimer of BOARDS apart from the mark as a whole.

The Trademark Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark shown below, previously registered for "printed teaching materials," in International Class 16, and "educational services; namely, offering courses for teaching students to become test sophisticated," in International Class 41,<sup>2</sup> that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

In the analysis of likelihood of confusion in this case, key considerations are the similarities between the

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<sup>2</sup> Registration No. 1,766,471, issued April 20, 1993, to Carol Decker, doing business as Scholastic Advantage. [Sections 8 and 15 affidavits accepted and acknowledged, respectively.]

marks, the goods and services, and the channels of trade, and the sophistication of the purchasers. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Considering the similarities between applicant's goods and registrant's goods and services, we find, first, that applicant's goods and registrant's goods are essentially the same. Applicant's goods, identified in its application as a "series of books on the subject of medicine," are encompassed within the identification of registrant's goods, "printed teaching materials."<sup>3</sup> Applicant's statement in its brief (p. 7) that its goods are limited to "publications designed to assist medical students in the successful completion of their USMLE's (United States Medical and Laboratory Exams)" does not require a different result. Not only is applicant's identification of goods not so limited, but registrant's goods, as identified, includes these types of publications.

We also find that applicant's goods are related to registrant's services, "educational services, namely, offering courses for teaching students to become test

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<sup>3</sup> We construe "teaching materials" to encompass books and other materials, and to include books directed to teachers as an aid to teaching, as well as books directed to students to teach them a particular subject or subjects.

sophisticated." Registrant's identification of services is broadly worded so that it includes such services offered in the medical field. It is reasonable for consumers to believe that books and courses on the subject of medicine emanate from the same or a related source, particularly if both the books and the courses are aimed at assisting the consumer to pass certain tests. It is very possible that the books would be used in conjunction with these courses.

We turn, next, to the channels of trade and class of purchasers. Applicant states that its goods are directed to medical students and suggests that registrant's goods and services are directed to a different class of consumers, namely, persons interested in becoming more "test-sophisticated." We do not believe this is a valid distinction. In the absence of any limitation in registrant's identifications of goods and services, we presume that registrant's goods and services are offered to all levels of students, including medical students, not merely those students with little or no experience, or in any test-taking environment. Certainly, it is reasonable to assume that publications and educational courses for medical students who are studying to pass certifying boards will include information and practice to improve their competence at taking this type of test.

Further, the record contains no evidence regarding channels of trade or class of purchasers. Because we have found applicant's and registrant's goods, as identified, to be the essentially same, we presume that the goods of applicant and registrant are sold in all of the normal channels of trade to all of the normal purchasers for such goods. See *Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). That is, we presume that the goods of applicant and registrant are sold through the same channels of trade to the same classes of purchasers. In the absence of evidence to the contrary, we presume the same is true with respect to registrant's closely related services.

Applicant contends that the purchasers of applicant's goods and registrant's goods and services will exercise a high degree of care in purchasing the respective goods and services. While we agree that applicant's goods and registrant's goods and services, as identified, are unlikely to be "impulse purchases," applicant has submitted absolutely no evidence in this regard, and we decline to find that such purchasers are discriminating or sophisticated. However, even if we were to conclude that applicant's goods and registrant's goods and services are marketed only to sophisticated and discriminating

purchasers, such individuals are not immune from confusion if confusingly similar marks are used in connection with the same or substantially similar goods. See, *In re General Electric Company*, 180 USPQ 542 (TTAB 1973).

Therefore, we turn, next, to consideration of the marks. The Examining Attorney contends that the word ACE is the dominant portion of both marks; that the words BOARD and TEST are synonymous and that, therefore, the phrases ACE THAT TEST and ACE THE BOARDS are synonymous; and that the design element in registrant's mark is insufficient to distinguish the marks.

On the other hand, applicant contends that the marks considered in their entirety are not similar, as the only common element is the word ACE; and that the design portion of registrant's mark sufficiently distinguishes it from applicant's mark.

It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, while the marks are compared in their entirety, "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 consideration of the marks in

their entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

We find that the overall commercial impressions of applicant's and registrant's marks are substantially similar. Looking at the word portions of the two marks, we begin by taking judicial notice of the definition of ACE as "Slang. A grade of A; the highest grade or score." In explaining the specific nature of applicant's goods, applicant essentially acknowledges that BOARDS are a type of test. Thus, both phrases, ACE THAT TEST and ACE THE BOARDS, suggest that purchasers using the respective goods and services will succeed on a test by obtaining a grade of "A." To the extent that there is any difference in connotation between the words TEST and BOARDS, consumers are certainly likely to believe that the goods and services offered in connection with the respective marks originate from the same or related source. It is very likely that consumers would believe that applicant's ACE THE BOARDS publications are a specialized subset of the publications and courses offered by registrant that are directed to excelling on a specific test. This is particularly likely in view of the fact that under actual marketing conditions, consumers do not always have the luxury of making side-by-side comparisons between marks. *Dassler KG v. Roller Derby*

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*Skate Corp.*, 206 USPQ 255 (TTAB 1980). Because of the fallibility of memory and the consequent lack of perfect recall, consumers will retain a general rather than a specific impression of trademarks or services marks.

*Spoons Restaurants, Inc. v. Morrison, Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd*. No. 92-1086 (Fed. Cir. June 5, 1992); and *In re Steury Corporation*, 189 USPQ 353 (TTAB 1975).

If, as with registrant's mark, a mark comprises both words and a design, then the words are normally accorded greater weight because the words are likely to make an impression upon purchasers that would be remembered by them and would be used by purchasers to request the goods and/or services. *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); and *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985). See also: *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). We find this to be the case herein. Although registrant's mark has a distinctive design element, we believe that the word portion of registrant's mark predominates. We find that the design element in registrant's mark is not sufficient to overcome the substantial similarity between the word portions of the two marks.

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Therefore, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, ACE THE BOARDS, and registrant's mark, which includes a design and the phrase ACE THAT TEST, their contemporaneous use on the same goods and the closely related goods and services involved in this case is likely to cause confusion as to the source or sponsorship of such goods and services.

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

E. W. Hanak

T. J. Quinn

C. E. Walters  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board