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Paper No. 23
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pentel of America, Ltd.

Serial No. 75/469,129

Bruce L. Adams of Adams & Wilks for Pentel of America, Ltd.

Amy Lohr, Trademark Examining Attorney, Law Office 107
(Thomas Lamone, Managing Attorney).

Before Cissel, Walters and Holtzman, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On April 16, 1998, applicant filed the above-referenced application to register the mark "ICY" on the Principal Register for "automatic pencils," in Class 16. The application was based on applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these goods.

The Examining Attorney refused registration under Section 2(d) the Lanham Act on the ground that if applicant were to use the mark "ICY" in connection with automatic

pencils, it would so resemble the mark "ICEE," which is registered¹ for, among other things, "pens and pencils," in Class 16, that confusion would be likely.

Responsive to the refusal to register, applicant presented arguments that confusion would not be likely and amended the identification-of-goods clause in the application to read as follows: "automatic pencils having colored translucent plastic barrels sold in a variety of colors resembling flavored ice." Submitted with the response to the refusal to register were the results of a search of a private trademark database. Applicant argued that "... there are several thousand federal reference marks in the United States containing the word 'ICE' in all International Classes," and attached "a partial list" of these marks. The list has dozens of pages listing what are argued to be trademarks which incorporate the word "ice."

Applicant argued that "ICY" is a weak trademark, and that it is used in connection with applicant products

"to create a commercial impression which is reminiscent of flavored-ice. It is thus rather weak in a trademark sense because it is used in a highly suggestive manner. Such marks are entitled to a very limited scope of protection, and the commercial impression created by applicant's goods, as identified in the amended statement, results in a consumer perception of applicant's ICY trademark that is

¹ Reg. No.1,942,417 issued on the Principal Register to Icee of America, Inc. on December 19, 1995.

consistent with the ordinary meaning of the term ICY and not to a fanciful use." (response, p.4).

The Examining Attorney accepted the amended identification-of-goods clause, but was not persuaded to withdraw the refusal to register, which was made final in the second Office Action.

Applicant timely filed a Notice of Appeal, followed by an appeal brief. The newly assigned Examining Attorney also filed an appeal brief. Applicant did not request an oral hearing before the Board.

As a preliminary matter, we need to discuss the objection of the new Examining Attorney to the copies of third-party registrations applicant submitted with its brief. Trademark Rule 2.142(d) provides that the record closes with submission of a Notice of Appeal unless applicant requests, and the Board grants, permission to submit additional materials. In the case at hand, applicant did not make such a request, but the third-party registrations submitted with the appeal brief appear to be some of the registrations for the marks listed in the search report submitted with applicant's response to the first refusal to register.

Ordinarily, as the Examining Attorney points out, simply listing registrations is insufficient to make them

of record. Official copies of such registrations should have been submitted during the prosecution of the application. See *In re Duofold, Inc.*, 184 USPQ 638 (TTAB 1974).

In the case at hand, however, although the Examining Attorney's second Office Action did not discuss the list of third-party registrations in great detail, the Examining Attorney's response did discuss the registrations in general terms and explained why they are not persuasive evidence that confusion would not be likely.

In that the probative effect of this evidence was discussed by the Examining Attorney, the Board overrules the Examining Attorney's objection to the submission of copies of the listed registrations with applicant's appeal brief. The copies submitted with the brief are in the nature of an effort by applicant to overcome the possible objection to the error applicant made earlier in the prosecution of the application by submitting the list instead of copies of the actual registrations. Because the Examining Attorney responded to the list as if the listed registrations were properly of record, we have taken them into account in reaching our decision on the merits of this appeal.

We hasten to add, however, that the newly assigned Examining Attorney is correct in her assessment of the probative value of this evidence. The third-party registrations, by themselves, are entitled to little weight on the issue of likelihood of confusion. In re Hub Disturbing, Inc., 218 USPQ 284 (TTAB 1983). They are not evidence of use of the marks therein, nor are they evidence of what happens in the marketplace, so they cannot be the basis upon which we could conclude that the public is so familiar with the use of such marks that it looks to other elements besides the term common to all of them in order to distinguish among them. Moreover, none of the third-party registrations submitted by applicant involves identical marks and goods, as is the case with this application vis-a-vis the registration cited as a bar to it under Section 2(d) of the Act.

We therefore turn to the primary issue presented by this appeal, i.e., whether the mark applicant seeks to register, "ICY," if used in connection with automatic pencils having colored translucent plastic barrels sold in a variety of colors resembling flavored ice, would so resemble the registered mark "ICEE" for pens and pencils that confusion would be likely. Based on careful

consideration of the record and arguments before us, we hold that the refusal to register is well taken.

In the case of *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the predecessor to our primary reviewing court set out the factors to be considered in determining whether confusion is likely. Chief among these factors are the similarity of the marks as to appearance, pronunciation, meaning and commercial impression, and the similarity of the goods as set forth in the application and registration, respectively.

In the case at hand, the marks are nearly identical. Although the spelling of the registered mark differs slightly from that of applicant's mark, these marks are identical in pronunciation and connotation, and the commercial impressions they engender are the same. As noted above, applicant has not established any support for its argument that the registered mark is weak, or that it is a common term which is suggestive of the goods in question in this appeal. As the Examining Attorney points out, the cases cited by applicant in support of its argument with respect to these marks involve situations where both marks contain wording which is highly suggestive of the goods or services in question and is commonly used in the relevant fields of commerce. Applicant in the case

at hand has not established that the marks at issue here contain or consist of a term which is highly suggestive of the goods. To the contrary, the registered mark "ICEE" appears to be arbitrary and fanciful with respect to pens and pencils, just as it appears to be arbitrary and fanciful with respect to the pencils identified in the application.

The goods applicant has identified in its amended application are encompassed within the broad identification-of-goods clause in the registration because they are specific kinds of pencils. The registration does not contain language restricting or limiting the pencils identified therein, so it must be considered to cover all types of pencils, including automatic pencils having colored translucent plastic barrels sold in a variety of colors resembling flavored ice.

In summary, confusion would be likely if applicant were to use the mark it seeks to register because it creates the same commercial impression that the registered mark does and the goods specified in the registration encompass those set forth in the application.

We have no doubt that confusion would be likely, but if we did have any doubt, it would have to be resolved in favor of the registrant and against the applicant, which

Ser No. 75/469,129

had a duty to adopt a mark that is not likely to cause confusion with the registered mark already in use. Lone Star Manufacturing Co. v. Bill Beasley, Inc., 498 F.2d 906,182 USPQ 368 (CCPA 1974).

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

Ser No. 75/469,129