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**THIS DISPOSITION  
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Paper No. 11  
HRW

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Toymax Inc.

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Serial No. 75/596,667

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Frank J. DeRosa and Monica B. Richman of Brown Raysman  
Millstein Felder & Steiner LLP for Toymax Inc.

Zhaleh Delaney, Trademark Examining Attorney, Law Office  
101 (Jerry Price, Managing Attorney).

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Before Seeherman, Hanak and Wendel, Administrative  
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Toymax Inc. has filed an application to register the  
mark CANDY PLANET for a "house mark for a full line of  
candy, ice cream and frozen confections sold separately and  
as a unit with toys."<sup>1</sup>

Registration has been finally refused under Section  
2(d) of the Trademark Act on the ground of likelihood of

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<sup>1</sup> Serial No. 75/596,667, filed November 24, 1998, based on an  
allegation of a bona fide intention to use the mark in commerce.  
A disclaimer has been made of the word CANDY.

confusion with the mark COOKIE PLANET which is registered for "bakery products, namely, cakes, cookies, pastries, breads, brownies, blondies and muffins; confectioneries, namely, fudge."<sup>2</sup>

The refusal has been appealed and applicant and the Examining Attorney have filed briefs.<sup>3</sup> An oral hearing was not requested.

We make our determination of likelihood of confusion on the basis of those of the *du Pont*<sup>4</sup> factors that are relevant in view of the evidence of record. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services with which the marks are being used, or are intended to be used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Looking first to the respective marks, we are guided by the well-established principle that although the marks must be considered in their entirety, there is nothing

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<sup>2</sup> Registration No. 2,171,615, issued July 7, 1998. A disclaimer has been made of the word COOKIE.

<sup>3</sup> The Examining Attorney's request for a continuance and the acceptance of her brief, which was filed late because of a mix-up in Office procedure, is granted.

<sup>4</sup> *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

improper, under appropriate circumstances, in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Moreover, although descriptive or disclaimed matter cannot be ignored in comparing the marks, it is also a fact that consumers are more likely to rely on the non-descriptive portion of a mark as an indication of source. See *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993).

We are in agreement with the Examining Attorney that the dominant feature of both applicant's and registrant's marks is the term PLANET. The additional term in each is no more than the generic term for the goods with which the mark is being used, or is intended to be used, and as such has little source-indicating significance. While the presence of the additional term, COOKIE or CANDY, in the marks leads to obvious differences in the appearance and sound of the marks as a whole, the overall commercial impressions created by the marks are very similar. Both consist of the generic term for the goods followed by the term PLANET. Moreover, and as discussed further below, there is even a similarity in the generic terms, in that both are for sweet items which bear a relationship to each other.

Applicant's contention is that the term PLANET has been used frequently in marks in connection with food products, making registrant's mark COOKIE PLANET a weak mark which is entitled to only a narrow scope of protection. On this basis, applicant argues that the overall differences in the respective marks are sufficient to render confusion unlikely. To support its argument that the PLANET portion of the mark is weak, applicant has made of record seven third-party registrations for marks including the term PLANET for baked goods, confectionary items or closely related food products.

The third-party registrations may well show that in the past PLANET has appealed to others in the foodstuffs field as a desirable term for adoption as part of a mark. These third-party registrations, however, are not evidence of the use of the marks shown therein or of the extent to which consumers are familiar with the marks so as to be accustomed to the existence of PLANET-containing marks in the marketplace. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); *Hilson Research Inc. v. Society for Human Resource Management*, *supra*. Thus, the third-party registrations in themselves are of little weight in determining likelihood of confusion.

Furthermore, upon reviewing the third-party registrations, we find that there is no other mark which follows the format of applicant's and registrant's marks, namely, the generic term for the food product followed by the term PLANET. In only two of these marks is PLANET preceded by another term (COOL PLANET and CRAZY PLANET) and neither of these is the generic term (or a recognized name) for the goods. The remaining five (PLANET LUNCH, PLANET ONE, PLANET C, PLANET SWEETS AND PLANET BAGEL) all follow a different word order and even those containing a generic term for the goods create different commercial impressions from applicant's mark because of this word order. Applicant's arguments with respect to the co-allowance by the Office of these various third-party marks on the register is irrelevant to the issue at hand. The question is whether confusion is likely between applicant's mark CANDY PLANET and registrant's mark COOKIE PLANET. We find no evidence of record to support applicant's conclusion that the public has been exposed to so many PLANET-containing marks for various food products that it is capable of distinguishing these marks, even if as similar in commercial impression as applicant's and registrant's marks.

Turning to the goods involved, we note that as a general principle, the issue of likelihood of confusion must be determined on the basis of the goods as identified in the application and the cited registration. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). It is not necessary that the goods of registrant and applicant be similar or even competitive to support a holding of likelihood of confusion. It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate, or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993) and the cases cited therein. If there are no restrictions in the application or registration as to channels of trade, the parties' goods must be assumed to travel in all the normal channels of trade for goods of this nature. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992).

As pointed out by the Examining Attorney, the respective goods are in part identical, in that

registrant's goods include the confection fudge, which, as shown by evidence made of record by the Examining Attorney and as commonly recognized, is a type of candy. As identified, applicant's candies may be sold separately or as a unit with toys; there is no prerequisite that a toy be part of the goods. Furthermore, applicant's arguments that its candies are sculpted and/or are used to fill toys in the form of animated characters or human action stars are to no avail, inasmuch as the identification of goods simply lists the goods as "candy."

Insofar as other goods of registrant are concerned, registrant's "cookies" cannot be limited, as applicant attempts, to premium gift cookies with gourmet ingredients. The identification of goods in the registration includes "cookies," without limitation as to type or content. The question is whether a sufficient relationship exists between the goods of applicant, which include candy, and those of registrant, which include cookies, that customers would be likely to believe that both originate from a single source if similar marks are used thereon. We find the copies of numerous third-party registrations made of record by the Examining Attorney showing registration of the same mark by a single entity for both candy and cookies, and in many instances other bakery products as

well, fully adequate to establish such a relationship. While these registrations are admittedly not evidence of use of the marks in commerce, they are sufficient to suggest that these goods are ones which may be produced by a single entity and marketed under the same mark. See *In re Albert Trostel & Sons Co.*, *supra*, *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988). Accordingly, if marks as similar in commercial impression as CANDY PLANET and COOKIE PLANET are used on candy and cookies, respectively, it may reasonably be presumed that customers will mistakenly believe that the goods emanate from the same source.

Applicant's arguments with respect to differences in the channels of trade can be given no weight. Regardless of whether registrant presently offers its goods over an Internet website for order by telephone or mail, there are no restrictions in the identification of goods in the registration limiting the channels of trade to this manner of sale. Instead we must assume that registrant's products travel in all the normal channels of trade for goods of this nature. This would include the same supermarkets or retail outlets at which customers would find the candy and frozen goods of applicant. No distinction can be drawn on the basis of channels of trade.

Moreover, the Examining Attorney has established that a greater relationship exists between the goods of applicant and registrant than that they are simply food items which might be sold in the same markets. We are not following any "per se" rule for food products in general. Instead, it has been shown that these are the type of food products which have been marketed by a single entity under the same mark and thus may readily be assumed by customers to emanate from a single source, a much closer relationship than merely being food products found in the same stores.

Finally, we note that these are inexpensive food items which would be purchased without any great degree of care in their selection, making confusion more likely by the use of similar marks thereon.

Accordingly, we find that confusion is likely.

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

**Ser No.** 75/596,667