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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jane Kittle

Serial No. 76/052,746

Eric A. Lerner of Ostrager Chong & Flaherty LLP for Jane Kittle.

Kathrine Stoides, Trademark Examining Attorney, Law Office 109 (Ronald Sussman, Managing Attorney).

Before Simms, Cissel and Drost, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On May 22, 2000, applicant filed the above-referenced application to register the mark shown below



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on the Principal Register for "carriers (animal), pet collars, pet leashes and pet clothing," in Class 18. The application was based on applicant's claim of use of the mark on these goods since March 1, 1998 and use on the goods in interstate commerce since May 3, 1999.

The Examining Attorney refused registration under Section 2(d) the Lanham Act, 15 U.S.C. 1052(d), on the ground that applicant's mark, as used on the goods specified in the application, so resembles the mark "PET WORLD," which is registered<sup>1</sup> for "wholesale and retail pet and tropical fish store services," that confusion is likely. In addition to refusing registration, the Examining Attorney also required applicant to state her citizenship, clarify the identification-of-goods clause and disclaim the descriptive word "PET'S" apart from the mark as shown.

Applicant responded to the first Office Action by providing the requested disclaimer, amending the application to state that she is a citizen of the United States, and amending the identification-of-goods clause to read as follows: "animal carriers, pet collars, pet leashes

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<sup>1</sup> Reg. No. 1,603,018, issued to Pet World, Ltd., a Virginia corporation, on June 19, 1990; renewed. The descriptive word "pet" is disclaimed apart from the mark as shown.

and pet clothing." Applicant also provided argument against the refusal to register based on likelihood of confusion. Applicant submitted a number of third-party registrations and applications for trademark registrations for marks which include the words "pet" and "world," contending that this evidence shows that marks which include both terms are "common on the register," so that none of them should be the basis for finding that confusion is likely between applicant's mark and the mark in the cited registration.

The Examining Attorney accepted the amendments to the application, but was not persuaded by applicant's evidence or arguments on the issue of likelihood confusion. She made the refusal to register final in the second Office Action.

Applicant timely filed a Notice of Appeal, followed by her appeal brief. The Examining Attorney filed her appeal brief, but applicant neither filed a reply brief nor requested an oral hearing before the Board. Accordingly, we have resolved this appeal based on the written record and the arguments presented in the briefs.

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 and/or services as they are set forth in the application and the registration, respectively. Any doubt on this issue must be resolved in favor of the registrant, who, as the second comer, had a duty to select a mark which is not likely to cause confusion with another mark already in use in the marketplace for related goods or services. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

When the facts presented by this appeal are evaluated in light of these considerations, we conclude that confusion is likely because applicant's goods are closely related to the services rendered under the registered mark, and the marks are similar because they create similar commercial impressions.

It is well settled that confusion may be found likely when one mark is used on particular goods and a similar mark is used in connection with services which include providing those goods to others. See, for example, In re Golden Griddle Pancake House Ltd., 17 USPQ2d 1074 (TTAB 1990) [restaurant services held related to table syrup];

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In re United Service Distributors, Inc., 229 USPQ 237 (TTAB 1986) [distributorship services in the field of health and beauty aids held related to skin cream]; In re United Shoe Corp., 229 USPQ 707 (TTAB 1985) [retail clothing store services held related to items of apparel]; and In re Phillips-Van Heusen Corp., 228 USPQ 949 (TTAB 1986) [items of clothing held related to restaurant services and towels].

The pet equipment and accessories specified in this application are the types of products purchasers would expect to be offered in a wholesale or retail pet store. If pet store services are rendered under a mark which is similar to the mark used on these kinds of pet products, confusion as to source is clearly likely.

We find applicant's mark to create a commercial impression which is similar to that created by the mark in the cited registration. As noted by the Examining Attorney, if the goods and services of the applicant and the owner of the cited registration are closely related, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as it would be if the goods and services were diverse. ECI Division of E Systems, Inc. v. Environmental Communications, Inc., 207 USPQ 443 (TTAB 1980). We agree

with the Examining Attorney that by combining the descriptive references to pets with the word "WORLD," both marks communicate the idea of a world for pets. Applicant argues that its mark connotes the notion of "a specific pet's world," whereas the cited registered mark refers to "a pet world, in general," but we do not believe that this distinction would necessarily be drawn by the ordinary consumers who purchase pet products at retail pet stores. The word portions of these two marks are essentially the same. In each, the term "WORLD" is modified by either the term "PET" or the possessive form of that word. When these two marks are considered in their entireties, as they must be, the commercial impressions they engender are quite similar. While the design element in applicant's mark has not been ignored, the word portion of this mark is clearly dominant. In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). The word portion is the part that customers are likely to use in ordering or recommending these goods. Because the literal portions of both marks are so similar in appearance, sound, meaning and connotation, the addition of the design element in applicant's mark does not remove the likelihood of confusion. Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc., 526 F.2d 556, 188 USPQ 105 (CCPA 1975).

Applicant's argument that the third-party registrations of record demonstrate that confusion is not likely is not persuasive for several reasons. To begin with, in these registrations the marks and the goods and services for which they are registered are distinctly different from the goods and services and the marks involved in the instant appeal. For example, the first three marks applicant cites are as follows: "WORLD FAMOUS PETS" for "providing and online computer database featuring and displaying graphical images of pet[s] and pet owners";<sup>2</sup> "WORLD PET FOODS" for "distribution services in the field of pet food, cooperative advertising and marketing of pet food";<sup>3</sup> and "WORLD WIDE PET SUPPLY ASSOCIATION" for "arranging in conducting trade show exhibitions directed to the pet industry and pet owners."<sup>4</sup> In these third-party marks and the others argued by applicant, the words "PET" and "WORLD" are used in contexts in which their ordinary meanings are understood, just as they are in applicant's mark and the cited registered mark, but in the third-party registered marks, the connotations of the marks in their

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<sup>2</sup> Reg. No. 2,414,802, issued on the Supplemental Register on December 19, 2000 to Amber Patricia Sorenson.

<sup>3</sup> Reg. No. 2,148,777 issued on the Principal Register with a disclaimer of "pet foods" on April 7, 1998 to Sunshine Mills, Inc..

<sup>4</sup> Reg. No. 1,914,361 issued on the Supplemental Register on May 17, 1995 to Western World Pet Supply Association, Inc.

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entireties are quite different because of the other words with which "PET" and "WORLD" are combined and the goods or services in connection with which they are registered.

In contrast, as noted above, the connotation and hence the commercial impression generated by applicant's mark in connection with the pet equipment and accessories specified in the application are quite similar to the connotation and commercial impression generated by the cited registered mark in connection with pet store services. Simply put, even if we were to accord a relatively narrow scope of protection to the cited registered mark because of its suggestive nature, the suggestion made by applicant's mark is very similar, so that the use of these two marks in connection with both the pet products listed in the application and pet store services recited in the cited registration is likely to cause confusion.

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