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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Scholastic Inc.

Serial No. 76/269,058

Edward H. Rosenthal of Frankfurt Kurnit Klein & Selz, P.C.  
for Scholastic Inc.

Ann K. Linnehan, Trademark Examining Attorney, Law Office  
114 (K. Margaret Le, Managing Attorney).

Before Quinn, Hairston and Rogers, Administrative Trademark  
Judges.

Opinion by Hairston, Administrative Trademark Judge:

Scholastic Inc. has filed an application to register  
the mark SWEETBERRY BOOKS for a "series of books for  
children."<sup>1</sup>

The Trademark Examining Attorney has finally refused  
registration under Section 2(d) of the Trademark Act, 15

<sup>1</sup> Serial No. 76/269,058, filed June 7, 2001, and asserting a bona  
fide intention to use the mark in commerce. The word "BOOKS" has  
been disclaimed apart from the mark as shown.

U.S.C. §1052(d), in view of the prior registration of the mark SWEET BERRY for "toy animal figures."<sup>2</sup>

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs.<sup>3</sup> We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the goods and the similarities between the marks. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1096, 192 USPQ 24 (CCPA 1976).

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<sup>2</sup> Registration No. 2,220,956 issued January 26, 1999.

<sup>3</sup> Applicant, for the first time with its appeal brief, submitted printouts downloaded from registrant's website and a list of third-party registrations. The Examining Attorney has objected to these materials as being untimely submitted. Under Trademark Rule 2.142(d), material submitted for the first time with a brief on appeal is normally considered by the Board to be untimely and therefore given no consideration. Moreover, the Board does not take judicial notice of registrations which reside in the U.S. Patent and Trademark Office and the submission of a mere list of third-party registrations is insufficient to make them properly of record. Rather, copies of the actual registrations or the electronic equivalent thereof, i.e., printouts of the registrations which have been taken from the USPTO's own computerized database, must generally be submitted. Under the circumstances, the Examining Attorney's objection is well taken and we will not consider the materials accompanying applicant's brief. We hasten to add that even if we had considered these materials, our decision herein would be the same.

Comparing first the goods, the Examining Attorney contends that applicant's identified goods, namely, a series of books for children, and registrant's toy animal figures, are closely related. In support of her position, the Examining Attorney submitted copies of third-party registrations of marks which cover children's books, on the one hand, and toy animals, on the other hand.

Applicant argues that there are specific differences between children's books and toy animal figures; and that registrant's toy animals figures are part of the well-known "My Little Pony" line of toys and are in the nature of collectibles such that they would be purchased by sophisticated purchasers. Applicant concludes therefore that the goods are not related.

It is well settled that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See *In re Monsanto Co. v.*

Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

Moreover, it is well established that the issue of likelihood of confusion must be determined on the basis on the goods as they are set forth in the involved application and the cited registration, and not in light of what such goods are shown or asserted to actually be. See Octocom Systems Inc. v Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); and Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 911 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987). Thus, where applicant's and registrant's goods are broadly described as to their nature and type, it is presumed in each instance that the application and registration encompass not only all goods of the nature and type described therein, but that the identified goods move in all channels of trade which would be normal for those goods and that they would be purchased by all potential buyers thereof. See In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

The Examining Attorney submitted copies of third-party registrations, which issued on the basis of use of the marks therein in commerce, to demonstrate the relationship between the involved goods, by showing in each instance

that a single entity has adopted one mark for children's books and toy animals. For example, Registration No. 2,203,072 is for the mark CHOP CHOP and covers a children's book and stuffed toy animals; Registration No. 1,262,363 is for the mark SCRIBOODLES and design and covers children's books and toy animals; Registration No. 2,298,272 is for the mark ALPHABET KIDS and covers children's books, story books and stuffed toy animals; Registration No. 2,371,526 is for the mark PAINTBEARS and covers a stuffed toy animal and coloring books; Registration No. 1,262,362 is for the mark GINNI and design and covers children's books and toy animals; and Registration No. 2,328,078 is for the mark THUNDER BUNNY and design and covers children's books and stuffed toy animals.

Third-party registrations are not evidence of commercial use of the marks shown therein, or that the public is familiar with them. Nevertheless, third-party registrations which individually cover a number of different items and which are based on use in commerce have some probative value to the extent they suggest that the listed goods and/or services are of a type that may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and *In re Mucky Duck*

Mustard Co., Inc., 6 USPQ2d 1467, 1470 footnote 6 (TTAB 1988).

Further, in the absence of any limitations or restrictions in the cited registration, we must presume that registrant's goods cover all types of toy animal figures, not just "My Little Pony" collectibles, and that the goods are sold in all the normal channels of trade to all the usual purchasers. Thus, in this case, we must assume that both applicant's and registrant's goods are sold in toy stores, department stores, and mass merchandisers to ordinary consumers who would typically exercise nothing more than reasonable care in their selection or purchase. Thus, for purposes of our likelihood of confusion analysis, we must consider the channels of trade and class of purchasers for the involved goods to be the same. Under the circumstances, applicant's series of books for children and registrant's toy animal figures are sufficiently related that, if marketed under identical or substantially similar marks, confusion as to source or sponsorship is likely to occur.

Considering then the marks, we find that applicant's mark SWEETBERRY BOOKS and registrant's mark SWEET BERRY, when viewed in their entireties, are substantially similar in sound, appearance, meaning and overall commercial

impression. Both marks begin with SWEETBERRY or SWEET BERRY (in registrant's case, SWEET BERRY comprises the entire mark), and in applicant's mark SWEETBERRY is followed by the disclaimed term BOOKS, which is clearly descriptive for applicant's goods. Although marks must be considered in their entireties, it is well established that there is nothing improper, in stating that for rational reasons, more or less weight has been given to a particular feature of a mark. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). The term SWEETBERRY is clearly the dominant feature in applicant's mark. In view of the descriptiveness of the term BOOKS, it is the term SWEETBERRY which has source-identifying significance. Thus, the dominant feature of applicant's mark is virtually identical to the cited mark SWEET BERRY. We note that it is a general rule that a subsequent user may not appropriate another's entire mark and avoid a likelihood of confusion simply by adding descriptive or subordinate matter. See Alberto-Culver Company v. Helen Curtis Industries, Inc., 167 USPQ 365 (TTAB 1970).

In addition, the fact that applicant's mark depicts SWEETBERRY as a single word instead of two words as does registrant's mark does not serve to distinguish the marks so as to avoid a likelihood of confusion. Under actual

market conditions, consumers generally do not have the luxury of making side-by-side comparisons. The proper test in determining likelihood of confusion is not a side-by-side comparison of the marks, but rather assessment of the similarity of the general overall commercial impressions engendered by the involved marks. See Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255 (TTAB 1980). Purchasers are unlikely to remember the slight differences in SWEETBERRY BOOKS and SWEET BERRY due to the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of the many trademarks encountered. That is, the purchaser's fallibility of memory over a period of time must also be kept in mind. See Grandpa's Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573 (CCPA 1973).

Further, we are not persuaded by applicant's argument that confusion is not likely because consumers will associate SWEETBERRY BOOKS with applicant's house mark "Scholastic" and SWEET BERRY with registrant's house mark "Hasbro." The problem with this argument is that the Board must compare the marks as they are depicted in the drawings. The house marks "Scholastic" and "Hasbro" do not appear in the respective drawings of the marks.

Finally, applicant contends that registrant has discontinued its "My Little Pony" line of toys which includes SWEET BERRY animal toy figures. If applicant believes registrant is no longer using the SWEET BERRY mark, it was incumbent upon applicant to file a petition to cancel the registration on the ground of abandonment, if appropriate. Otherwise, applicant's contention is essentially an attack on the validity of the cited registration and will not be entertained in this ex parte appeal.

In sum, based on the substantial similarity in the marks, the relatedness of the goods, and the identical trade channels and purchasers, we find that there is a likelihood that the relevant purchasing public would be confused if applicant were to use the mark SWEETBERRY BOOKS for a series of books for children in view of the previously registered mark SWEET BERRY for toy animal figures. In particular, purchasers familiar with registrant's toy animal figures offered under the mark SWEET BERRY, upon encountering a series of books for children offered under the mark SWEETBERRY BOOKS, are likely to believe applicant's books are companion products emanating from the same source as the SWEET BERRY toy animal figures.

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