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Mailed: 9/10/04

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Blue Grotto Media, Inc.**

Serial No. 75667475

Robert S. Stoll of Stoll, Miskin, Previto, Hoffman & Badie
for Blue Grotto Media, Inc.

Matthew C. Kline, Trademark Examining Attorney, Law Office
114 (K. Margaret Le, Managing Attorney).

Before Simms, Seeherman and Quinn, Administrative Trademark
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Blue Grotto Media, Inc. has appealed from the final
refusal of the Trademark Examining Attorney to register
BLISS! as a mark for "on-line website in the field of
weddings, wedding preparation, engagement and wedding
parties and engagement and wedding gifts."¹ The services
were originally identified as an on-line magazine rather

¹ Application Serial No. 75667475, filed March 24, 1999,
claiming first use and first use in commerce on March 10, 1997.

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than an on-line website, but applicant amended the identification in order to avoid a potential likelihood of confusion with a prior pending application. That application subsequently was abandoned. Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark BLISS GIFT & BRIDAL REGISTRY, previously registered for "gift and bridal register service, and distributorship in the field of bridal gifts,"² that, as used in connection with applicant's identified services, it is likely to cause confusion or mistake or to deceive.

The appeal has been fully briefed.³ Applicant did not request an oral hearing.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d

² Registration No. 2140872, issued March 3, 1998; Section 8 affidavit accepted; Section 15 affidavit acknowledged.

³ In its brief applicant raised a concern about a procedural matter. In the Office action mailed January 13, 2004, the Examining Attorney declared the application to be abandoned because applicant filed an incomplete response to the final action. The Examining Attorney was not aware, at the time he issued the action, that applicant had previously filed a timely notice of appeal. The appeal was subsequently instituted on January 28, 2004, and the appeal has gone forward. We hereby clarify that the statement that the application was abandoned was made in error, and that Office records show that the application is still active.

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1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Turning first to the services, we begin our analysis with the well-established principle that it is not necessary that the goods or services of the parties be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient if the respective goods or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

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The services are obviously complementary, and would be used by the same class of purchasers, e.g., wedding couples and their family and friends. Moreover, the Examining Attorney has made of record a number of third-party registrations which show that entities have registered a single mark for providing retail services and providing on-line information about particular subject matter. See, e.g., Reg. No. 2497932 (online retail services, featuring items in the field of religion, spirituality and morality, and providing on-line information in the field of religion, spirituality and morality, and on-line electronic magazine services in the field of religion, spirituality and morality); Reg. No. 2565081 (providing on-line magazine in the field of sports, movies and music and online retail and mail order services featuring novelty sporting goods); and Reg. No. 2546856 (online retail services featuring goods and services focusing on lifestyles, culture and history of the United Kingdom, providing on line chat rooms and discussion groups for the transmission of messages among computer users dealing with the lifestyles, culture and history of the United Kingdom, and providing information services, an online magazine and an archive of information all in the field of the lifestyles, culture and history of the United Kingdom).

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Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Applicant does not dispute the relatedness of the services. In fact, applicant did not discuss this duPont factor at all in its appeal brief and, although the Examining Attorney pointed this out in his brief, applicant did not raise it in its reply brief, either. We find that this factor favors a finding of likelihood of confusion.

This brings us to a consideration of the marks. Applicant's mark is BLISS!; the cited mark is BLISS GIFT & BRIDAL REGISTRY. As both applicant and the Examining Attorney recognize, although marks must be compared in their entireties, 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). In the cited mark, the disclaimed words GIFT & BRIDAL REGISTRY are descriptive of a gift and bridal register service. These words deserve little weight in the likelihood of confusion analysis, because they have no

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source-indicating significance. Rather, it is to the word BLISS that consumers will turn to identify the source of the services. Consumers will view BLISS!, when used with an on-line website in the field of weddings and the like, and BLISS GIFT & BRIDAL REGISTRY when used for a gift and bridal register service, as indicating services emanating from the same source. They will understand the words GIFT & BRIDAL REGISTRY to be an appropriate descriptive phrase when used for the bridal register service, and will assume that BLISS! is a variation of that mark, but that the descriptive phrase is not used in connection with the on-line website because it is not appropriate for that service. Therefore, although, as applicant points out, the phrase GIFT & BRIDAL REGISTRY creates certain differences in the marks by making the cited mark longer in appearance and pronunciation, the presence of the additional phrase in the cited mark, and the absence of it in applicant's mark, do not serve to distinguish the marks.

In its reply brief applicant raises for the first time the assertion that BLISS is a weak mark for wedding-related matters because "'bliss' and such phrases as 'Wedded bliss' are so common and well known as to call for judicial notice." Reply brief, p. 2. Even if we were to accept the assertion that the word "bliss" has some suggestive

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significance in connection with weddings,⁴ the same connotation applies to both applicant's and the registrant's mark. Thus, the marks are similar in connotation. Further, to the extent that applicant asserts that the scope of protection to be accorded the registered mark should be limited, it is still broad enough to prevent the registration of a very similar mark for related services. Accordingly, this factor favors a finding of likelihood of confusion.

The only other factor on which there is evidence relates to actual confusion. Applicant asserts that the marks have coexisted since 1997 without any evidence of actual confusion, and has submitted a declaration from its president to this effect. The lack of such evidence does not outweigh the factors of the similarity of the marks and the relatedness of the services. First, it is notoriously difficult to obtain evidence of actual confusion. Second, we have not had an opportunity to hear from the registrant as to its experience with any instances of confusion. Third, because applicant's services are the furnishing of an on-line website, it is not clear how instances of actual

⁴ The dictionary we have consulted, The American Heritage Dictionary of the English Language, © 1970, lists, as definitions for "bliss," "serene happiness; the ecstasy of salvation; spiritual joy; a cause of great delight or happiness."

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confusion might come to its attention. It would not receive misdirected mail, since presumably communications with it would come through the Internet, from people who had already accessed its website. And there would be no casual conversation, as might happen if a customer entered a "brick and mortar" retail store and mentioned to the proprietor/salesperson a presumed connection with the registrant.

Decision: The refusal of registration is affirmed.