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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Worldwide, Inc.

Serial No. 76604027

Michael E. Dergosits of Dergosits & Noah LLP for Worldwide,
Inc.

Maureen L. Dall, Trademark Examining Attorney, Law Office
110 (Chris A.F. Pedersen, Managing Attorney).

Before Seeherman, Drost and Zervas, Administrative
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

An application was filed by Worldwide, Inc. to register the mark CATNIPLOUNGER (in standard character form) for "pet bed" in International Class 20.¹ The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a), and June 30, 2002 is

¹ Application Serial No. 76604027, filed July 19, 2004.

alleged in the application as the date of first use of the mark anywhere and in commerce.

The examining attorney has finally refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that applicant's mark, as applied to applicant's goods, is merely descriptive of such goods. Additionally, the examining attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark so resembles the previously registered mark LOUNGER (in standard character form) for "beds for pets,"² also in International Class 20, that, as used on applicant's identified goods, applicant's mark is likely to cause confusion or mistake or to deceive.

Applicant has appealed the final refusals of its application. Applicant and the examining attorney filed opening briefs, but applicant did not request an oral hearing.

In the paragraphs that follow, we first consider the Section 2(e)(1) refusal and then consider the Section 2(d) refusal. Both refusals to register are affirmed.

² Registration No. 2388975, issued September 26, 2000.

Section 2(e)(1) - Mere Descriptiveness

"A mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of' the goods or services related to the mark." *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004), quoting, *Estate of P.D. Beckwith, Inc. v. Commissioner*, 252 U.S. 538 (1920). See also *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778 (Fed. Cir. 2003). The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for

which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

As is immediately apparent upon perceiving applicant's mark, the mark is a combination of the words CATNIP and LOUNGER. This impression is reinforced by applicant's specimen; CATNIP appears in light lettering on a dark background and LOUNGER appears in dark lettering on a light background. Also, the initial letter in each word is in upper case, and the remaining letters are in lower case. In view of this combination of words, the examining attorney argues as follows:

The evidence attached to the Office Action dated May 16, 2005 and the Final Office Action dated July 25, 2005, which includes at least 20 articles obtained via the Google® internet search engine and five articles from the Lexis/Nexis® computerized database, demonstrates that 'lounger' is a term commonly used to describe a type of pet bed. Meanwhile, 'catnip' is a feature of the applicant's pet beds. In this regard, the applicant's specimen specifically says that the goods contain refillable catnip pouches. When combined to form the term 'CATNIPLOUNGER,' each of the individual terms retains its descriptive nature. Therefore, the composite mark is descriptive. Brief at p. 8.

Applicant's specimen of use makes clear that applicant's goods include catnip. Specifically, the specimen of use states, "Adding Catnip Invites Cats To

Lounge Or Play" and "Keep Interest Fresh With Refillable Catnip Pouch." (Capitalization in the original specimen.) Thus, catnip is a significant feature of applicant's pet beds. Further, the examining attorney's evidence of record, consisting of printouts from third-party websites, results from an Internet search using the Google search engine, and excerpts from the Nexis database,³ establishes prima facie that a "lounger" is a type of pet bed. The following are representative samples of excerpts obtained from third-party websites and excerpts from four of the five articles obtained from the Nexis database:

From third-party websites

Kitty Cat Lounger with Puma Pattern
Every kitten would love this model kitty cat
lounger.
(from www.cozycatfurniture.com)

Orthopedic Pet Lounger
At last, a lounger designed for maximum comfort
and security of the pet.
(from www.petsmart.com)

Personalized Faux Sheepskin Lounger for Cats
(from www.petsmart.com)

Reversible Lounger Dog Bed
(from www.radiofence.com)

³ The examining attorney states that "[f]ive representative articles [from the Nexis database were] attached" to the final Office action. We accord limited weight to the fifth excerpt because it is an excerpt from a wire service story - Nexis excerpts from wire services are generally accorded limited probative value because it cannot be assumed that they have been seen in a newspaper or periodical. *In re Patent and Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998).

TrendyPets Plain Dyed Chenille Dog Lounger
(from *www.gpsdirect.biz*)

Medium Dog Lounger/Cuddler Bed
(from *www.terisstore.com*)⁴

From Nexis database

Products include collars, leads, leashes,
bandannas, pet loungers and T-shirts
(from *Orlando Sentinel (Florida)*, July 18, 2004)

Indy also likes "the cat lounger attached to the
window in the living room. I had to buy a second
one so the cats would have a place to nap."
(from *The Dallas Morning News*, June 7, 2003)

... includes a visit to a dog day spa, a photo
session with a professional photographer, a
doggie lounger and a dog leash with attached
light.
(from *The Post-Standard*, Syracuse, NY)

... has just the thing for tired dogs - a pet couch
that folds out to become a lounger ...
(from *The Miami Herald*, December 14, 1997)

Applicant has argued that the mark is not merely
descriptive because LOUNGER has been registered for "beds
for pets" in Registration No. 2388975 (the registration
which forms the basis of the Section 2(d) refusal) and
hence has been found by the Office not merely descriptive
of those goods. Applicant asserts that, in view of that
registration, CATNIPLOUNGER cannot be merely descriptive of
the goods of the present application. Applicant's argument

⁴ This excerpt identifies the same item as both a "lounger" and
a "bed."

is not persuasive because while a term at its inception or adoption, and registration, may be arbitrary or even suggestive in character, it may subsequently come to be regarded by the purchasing public as nothing more than a descriptive designation for the goods on which it is used. See *DeWalt, Inc. v. Magna Power Tool Corp.*, 129 USPQ 275 (CCPA 1961). In this case, the record shows ample descriptive use of "lounger" with respect to "pet bed[s]." Also, it is well settled that the Office and the Board are not bound by the decisions or actions of previous examining attorneys, but instead must decide each case on its own record and merits. *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

Applicant also cites to *In re Colonial Stores, Inc.* 157 USPQ 381 (CCPA 1968) involving the mark SUGAR & SPICE and argues that its mark has "another associative connotation" besides the descriptive meaning of each individual term in the mark; and that "CATNIPLOUNGER could mean a number of goods such as beds, pillows, futons, rugs or blankets which either contain catnip, or which provide a catnip odor, or which are colored or designed as catnip leaves, or any of these combinations. CATNIPLOUNGER could not be considered descriptive only of pet beds." Brief at unnumbered p. 3. (Emphasis in the original brief.)

Applicant appears to be arguing that because there may be other meanings of "lounger" as applied to other goods, the mark is not merely descriptive of applicant's goods. However, that a term may have other meanings in different contexts is not controlling. *In re Polo International Inc.*, 51 USPQ2d 1061 (TTAB 1999); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). Merely because there are other descriptive meanings of "lounger" does not render the term registrable for applicant's goods and services. See *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). When the mark CATNIPLOUNGER is viewed in connection with applicant's goods, namely a pet bed that has a pouch for catnip, consumers will immediately understand CATNIPLOUNGER as describing such products.

Further, although not entirely clear, it appears that applicant, in citing *In re Colonial Stores, supra*, may be arguing that even if the terms "catnip" and "lounger" are descriptive, the combination of the two terms is not descriptive. It is true that a term which is created by combining two or more unregistrable words may achieve registration if, in combination, a new and different commercial impression is achieved and/or the term so created imparts a bizarre or incongruous meaning as used in connection with the goods or services. See *In re Oppedahl*

& Larson LLP, supra; In re National Shooting Sports Foundation, 219 USPQ 1018 (TTAB 1983). However, this is not the case here. We find that the mark in its entirety is merely the sum of two merely descriptive components and is equally merely descriptive in connection with applicant's identified goods. The exercise of imagination or thought is not required for prospective users of applicant's goods to perceive readily the merely descriptive significance of the term CATNIPLOUNGER as it pertains to applicant's goods. The term CATNIPLOUNGER immediately describes, without conjecture or speculation, a feature or characteristic of applicant's goods, namely, that applicant's goods are pet loungers which contain catnip.⁵

Section 2(d) - likelihood of confusion

Our determination of the examining attorney's refusal to register the mark under Section 2(d) of the Trademark Act is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood

⁵ Applicant has observed that "despite apparent extensive online searching by the Examining Attorney, no instance could be found where anyone has combined 'catnip' and 'lounger' for any purpose whatsoever let alone as a trademark to identify the source or origin of pet beds." Brief at unmarked p. 2. Applicant's observation appears to be more appropriate to an argument that its mark is not generic. However, evidence of use of the combined term "catnip lounger" or "catniplounger" is not required to prove that a term is merely descriptive.

of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 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).

The cited registration is for the mark LOUNGER. As we stated in our discussion regarding the Section 2(e)(1) refusal, the evidence of record - including the uses by third parties of "lounger" to identify a type of pet bed - shows that LOUNGER has a descriptive connotation for pet beds. However, because we must accord the cited registration the presumptions of Section 7(b) of the Trademark Act, for purposes of our likelihood of confusion analysis, we consider the cited mark to be a highly suggestive, rather than a merely descriptive term. While the registration is entitled to a very limited scope of protection due to the highly suggestive nature of the mark, it is still entitled to some protection. Here, applicant's and registrant's goods are legally identical, with

applicant's goods identified as "pet bed[s]" and registrant's goods identified as "beds for pets." Applicant's mark incorporates the entirety of registrant's mark and is distinguished only by the addition of the descriptive word CATNIP to registrant's mark. Applicant thus has added a descriptive term to the highly suggestive term LOUNGER, and uses the combination on legally identical goods. Even according the cited registration the limited protection to which it is entitled, such protection still extends to prevent the registration of CATNIPLOUNGER. Simply put, the additional descriptive term CATNIP does not suffice to distinguish the marks.

We add too that applicant's and registrant's goods are both inexpensive goods which may be purchased on impulse. See, e.g., printout from www.petsmart.com showing loungers for cats priced at \$21.99. When products are inexpensive and subject to impulse buying, the risk of consumer confusion increases because purchasers are held to a lesser standard of purchasing care. See *Recot, Inc. v. M.C. Becton*, 214 F.3d 1332, 54 USPQ2d 1894 (Fed. Cir. 2000). Under such circumstances, the addition of the term CATNIP to the highly suggestive term LOUNGER certainly does not serve to mitigate any likelihood of confusion.

Applicant has argued that the record includes "a plethora of users of" LOUNGER "for products related to bedding and relaxation which strongly cut against registrant's ability to stop others from identifying the source of such goods by 'lounger.'" Brief at unmarked p. 2. Applicant adds that "[i]t is inconceivable to applicant that the Examining Attorney would cite page after page of recitations of those using 'lounger' to describe products for sleeping, lounging or relaxing unrelated to registrant on the one hand and yet assert that CATNIPLOUNGER and LOUNGER are confusingly similar on the other." *Id.* Further, in the context of discussing the Section 2(e)(1) refusal, applicant concludes that "the marks, as a whole, are weak being somewhat suggestive, at a minimum, of the goods." *Id.* However, as the examining attorney has pointed out, weak marks too are entitled to protection against registration by a subsequent applicant of the same or similar mark for the same or closely related goods or services. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974); *In re Colonial Stores*, 216 USPQ 793, 795 (TTAB 1982).

In view of the foregoing, and mindful that in cases such as the present one, where applicant's and registrant's goods are identical, the degree of similarity between the

marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical, *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992), we conclude that consumers familiar with registrant's "beds for pets" offered under the mark LOUNGER would be likely to believe, upon encountering applicant's mark CATNIPLOUNGER for "pet bed[s]," and particularly pet beds that, as applicant's specimens show, contain a pouch for catnip, that they both originate with the same entity.

Decision: The refusal of registration under Section 2(d) of the Act is affirmed. The refusal of registration under Section 2(e)(1) of the Act also is affirmed.