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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Viacom International Inc.

Serial No. 78216470

Kiersten M. Skog of MTV Networks, a division of Viacom International Inc., for Viacom International Inc.

Catherine Pace Cain, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Quinn, Hohein and Holtzman, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Viacom International Inc. filed an application to register the mark IT'S WHAT'S INSIDE THAT COUNTS for the following goods.¹

Video game machines for use with television, audio output game machines for use with television, video game cartridges, video games recorded on CD-ROM for use in freestanding video game machines; and computer products, namely, game cartridges for computer video games and video output game machines for use with television and instructional materials sold as a unit, computer game cassettes, computer game tapes and

¹ Application Serial No. 78216470, filed February 19, 2003, based on applicant's assertion of a bona fide intention to use the mark in commerce.

manuals sold as a unit; theatrical and musical sound recordings; theatrical and musical video recordings, laser discs and digital video discs, namely, digital versatile discs and DVD; sunglasses (in International Class 9).

The trademark examining attorney ultimately issued a final refusal to register the mark under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles the registered mark WHAT'S INSIDE COUNTS for the following services as to be likely to cause confusion:²

Multimedia entertainment software production services; audio and video recording and production (in International Class 41); and

Computer services, namely, designing and implementing network web pages for others, design of computer software and multimedia games (in International Class 42).

Applicant, in response, filed a request for reconsideration, seeking to overcome the final refusal by adding the following language (highlighted below) to the identification of goods:

Video game machines for use with television, audio output game machines for use with television, video game cartridges, video games recorded on CD-ROM for use in freestanding video game machines; and computer products, namely, game cartridges for computer video games and video output game machines for use with television and instructional materials sold as a unit, computer game cassettes, computer game tapes and manuals sold as a unit; theatrical and musical sound recordings; theatrical and musical video recordings,

² Registration No. 2490027, issued July 11, 1995; Sections 8 and 15 affidavits accepted and acknowledged, respectively.

laser discs and digital video discs, namely, digital versatile discs and DVD; sunglasses, **all of which are to be marketed in connection with the EVERGIRL line of products which is directed to children, pre[-]teens and teens and emphasizes the concept of self[-] empowerment and a positive self[-]image.**

The examining attorney rejected the amendment, citing TMEP §1402.09 ("Use of Marks Inappropriate in Identifications"), reasoning as follows:

The applicant currently has 12 pending applications for the mark EVERGIRL, 11 of which have been approved for publication. Several of the pending applications may register before the final disposition of this application. Registered marks are not to be used in the application to describe applicant's goods.

The examining attorney required that applicant delete the mark "EVERGIRL" from the amendment, and proceeded to maintain the final refusal on the basis of the original identification of goods.

The amendment submitted by applicant for the first time in its request for reconsideration raised a new issue that should not have been made final by the examining attorney until applicant was given an opportunity to respond to the rejection. See TMEP §715.03(b). That said, however, we find that a remand of the application at this point for further examination concerning the propriety of the amendment would serve no useful purpose. The examining attorney's ground for rejecting the amendment based on TMEP §1402.09 is improper on its face. While

that section of the TMEP provides that the use of a registered mark of *another* entity is not appropriate, it clearly permits an applicant to use *its own* registered mark in an identification of goods in its own application. That is what applicant has done here.

Under the circumstances, the amended identification of goods is acceptable, and because applicant has briefed the issue of likelihood of confusion on the basis of the identification of goods as amended, the appeal will go forward and we will decide the issue based on the goods as so amended.

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, including the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Turning first to the marks, applicant argues that although the marks share some common words, the overall pronunciation, meaning and commercial impression of the marks are dissimilar. Applicant contends that its mark suggests "the philosophy behind the EVERGIRL brand, namely, a message of empowerment, a positive self-image and acceptance" whereas registrant's mark, according

to applicant, "is clearly intended to suggest that the software in a computer is of particular importance."

It is well settled that marks must be compared in their entireties and not dissected into component parts and each part compared with other parts. *Genesco Inc. v. Martz*, 66 USPQ2d 1260 (TTAB 2003). In the normal marketing environment, purchasers would not usually have an opportunity to examine marks in such detail. Furthermore, the average purchaser is not infallible in his recollection of trademarks and often retains only a general overall impression of marks that he may previously have seen in the marketplace. In *re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988). Thus, it is the overall impression of the marks derived from viewing the marks in their entireties that is controlling. See *Dan Robbins & Associates, Inc. v. Questor Corporation*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979). See also *E.I. Du Pont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F.Supp. 502, 185 USPQ 597, 603 (EDNY 1975) (overly analytical approach with close attention to specific differences is less important than the overall impression of general similarity.)

When applicant's mark IT'S WHAT'S INSIDE THAT COUNTS and registrant's mark WHAT'S INSIDE COUNTS are considered in their entireties and as they would be encountered in the marketplace, we find that the marks are substantially similar in sound,

appearance, meaning and commercial impression, and that the overall similarities in the marks far outweigh their differences.

Applicant's slogan, IT'S WHAT'S INSIDE THAT COUNTS, incorporates registrant's slogan, WHAT'S INSIDE COUNTS, in its entirety. The slight differences in sound and appearance between the two slogans, due to the presence of the terms "IT'S" and "THAT" in applicant's mark, are so insignificant that they are not likely to be noted or remembered by purchasers when seeing or hearing these slogans at separate times. Applicant's mark is, in effect, just a slightly longer version of the same slogan used by registrant.

Moreover, in relation to the respective goods and services, the meaning and commercial impression conveyed by the two slogans are substantially the same. Applicant contends that its mark IT'S WHAT INSIDE THAT COUNTS" imparts a message "of empowerment and a positive self-image" when viewed in connection with its products, while registrant's mark WHAT'S INSIDE COUNTS refers to the importance of "what's inside" the computer, meaning the quality of the software used in a computer. However, we believe that purchasers are more likely, or at least just as likely, to view WHAT'S INSIDE COUNTS as suggesting the content of the audio/video recordings registrant produces and the video games it designs, and that purchasers would therefore perceive the meaning of the two slogans as being the same.

Applicant argues that it is not appropriate to assume that registrant "has strong rights in the mark" because registrant's mark is not famous, and further that "it is not even clear that the mark has developed secondary meaning among the consumer[s] of the services." While we have no evidence that registrant's mark is strong in terms of market power, the mark by its nature is relatively strong, being at most only somewhat suggestive of registrant's services. There is nothing in the record to diminish this inherent strength of registrant's mark or, in any event, to indicate that the mark should be entitled to less than a normal scope of protection.

We turn then to the question of whether the respective goods and services are sufficiently related and/or the circumstances surrounding the marketing of the goods and service are such that purchasers encountering them would, in view of the similarity of the marks, mistakenly believe that the goods and services emanate from the same source. See *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590 (TTAB 1978) and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Applicant argues that the respective goods and services are not related and that they will be sold in different channels of trade, to different purchasers. Applicant contends that, unlike registrant's services which are marketed and sold to adults in the business-to-business context, applicant's goods will be sold

to children, pre-teens and teens in retail outlets that carry toys, games and accessories. In addition, applicant maintains that purchasers of registrant's services are more likely to spend time investigating and researching before purchasing the services than the ordinary consumers who will be purchasing applicant's products.³

Applicant's goods include video game cartridges, video games recorded on CD-ROM, theatrical and musical sound and video recordings, and digital laser discs and DVDs. Registrant's services involve the types of goods identified in the application. Registrant designs multimedia games (e.g., video games) and produces audio and video recordings. We find that these are complementary, inherently related goods and services. See, e.g., *In re Hyper Shoppes (Ohio) Inc.*, 837 F. 2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (finding that confusion may result if the same or similar marks are used for goods, on the one hand, and for services involving those goods, on the other).

In addition, the examining attorney has submitted a number of use-based, third-party registrations showing that, in each instance, a single entity has adopted the same mark for goods of the type listed in the application and for services such as those

³ Applicant, for the first time on appeal, submitted a printout from the website for its EVERGIRL products at www.evergirl.com. The examining attorney objected to this evidence as untimely under Trademark Rule 2.142(d) and the objection is well taken. Accordingly,

Ser No. 78216470

identified in the cited registration. For example, Registration No. 2235685 lists prerecorded audio cassettes and discs featuring music, as well as audio and audio-visual production services for television, film, cable television, radio, theme parks, restaurants, and theaters; Registration No. 2374577 lists prerecorded video recordings, as well as production of video recordings and multimedia entertainment software, "all featuring ... cartoon animation for entertainment, education, training and motivation in a wide variety of fields"; Registration No. 2684345 lists computer game cartridges and discs, as well as design of computer games, video games and computer game cartridges; Registration No. 2753196 lists musical sound and video recordings, as well as audio recording and production; Registration No. 2716535 lists musical sound recordings, prerecorded video tapes, compact discs, DVDs, video game discs and cartridges, as well as audio recording and production, digital video disc and video tape production "all on the subject of inspiring and facilitating personal discovery and personal growth"; and Registration No. 2902320 lists compact discs and DVDs featuring music and theatrical productions, as well as theatrical productions, and production of audio, video and audio-video recordings.

this evidence will not be considered. Even if the evidence were considered, however, it would not affect the outcome of this case.

Although third-party registrations are not evidence that the marks shown therein are in commercial use or that the public is familiar with them, they nevertheless have some probative value to the extent that they serve to suggest that the goods listed therein may emanate from a single source.⁴ See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

Applicant's identification specifies that its goods "are to be marketed in connection with the EVERGIRL line of products which is directed to children, pre-teens and teens and emphasizes the concept of self-empowerment and a positive self-image." While this language may limit the content of applicant's games and recordings and perhaps the way those goods are promoted, it does not serve to limit the nature of the goods themselves. Further, absent any limitation in registrant's identification of services, it must be presumed that the music and video recordings produced by registrant and the multimedia games registrant designs could include any type of content, including children's music and video recordings and video games with child-oriented themes and self-empowerment messages; and that such recordings and games could be used for all purposes, including motivational

⁴ Contrary to applicant's contention, the examining attorney did not conclude from this evidence that those entities which offer software design services will also produce software, only that the evidence tends to show that if purchasers encounter both types of goods and

and educational purposes. We also note that a few of the third-party registrations mentioned above specify that goods and services of the type provided by applicant and registrant are used for a variety of purposes and have a variety of content.

We also find that there is at least an overlap in the purchasers for applicant's audio/video products and registrant's design and production services involving those products. We can presume from the description of registrant's services, and it can also be seen from several of the third-party registrations noted above, that the type of services offered by registrant would be directed to commercial purchasers such as television and movie studios, theme parks, restaurants, theaters, and educational institutions. Applicant's goods could likewise be offered to those industries. While the language in applicant's identification may indicate, as we noted earlier, the content of applicant's recordings and video games, or that those goods are promoted emphasizing a self-empowerment message, the language does not serve to restrict the potential purchasers for applicant's goods or to limit the universe of purchasers to the general public.

We recognize that the overlapping purchasers for these goods and services are presumed to have some degree of specialized

services under similar marks, they would believe the same entity is providing both.

knowledge and therefore would be more sophisticated than ordinary consumers. However, even sophisticated purchasers are susceptible to source confusion, particularly under circumstances where, as here, the goods and services are closely related and are sold under very similar marks. See *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers ... are not infallible."). See also *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); and *In re Pellerin Milnor Corp.*, 221 USPQ 588 (TTAB 1983).

Accordingly, we find that purchasers familiar with registrant's audio/video production and video game design services sold under its mark WHAT'S INSIDE COUNTS, are likely to believe, upon subsequently encountering the substantially similar mark IT'S WHAT'S INSIDE THAT COUNTS on audio/video recordings and video games of the kind provided by applicant, that they were products designed by or produced by registrant, or that there is otherwise some connection between the sources of the respective services and goods.

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