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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Medi Plus Tec Medizinisch-Technische
Handelsgessellschaft mbH

Serial No. 78283332

Mary S. Mathew of Collard & Roe, P.C. for Medi Plus Tec Medizinisch-Technische Handelsgessellschaft mbH.

Steven W. Jackson, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop, Managing Attorney).

Before Walters, Rogers, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On August 5, 2003, Medi Plus Tec Medizinisch-Technische Handelsgessellschaft mbH (applicant) applied to register the mark DENVER (in typed or standard character form) on the Principal Register for goods ultimately identified as:

> cigarettes, tobacco, matches, and smoker's articles, namely, cigarette holders not of precious metal, cigarette cases not of precious metal, ashtrays not of precious metal, matchboxes not of precious metal and lighters not of precious metal, not including cigars in Class 34.

The application (Serial No. 78283332) is based on applicant's ownership of a German registration (No. 302 52 030). 15 U.S.C. § 1126(e).[1] The examining attorney[2] refused to register the mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of a registration for the mark DENVER SWEETS, in typed or standard character form, for "cigars" in Class 34. The registration, No. 2,124,720, issued December 30, 1997, and it contains a disclaimer of the term "Sweets." Affidavits under Sections 8 and 15 of the Trademark Act have been accepted or acknowledged.

After the examining attorney made the refusal final, this appeal followed.

When we have a question of likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind

[1] Applicant also based its application on its intention to use the mark in commerce, but it subsequently deleted this basis.
[2] The current examining attorney was not the original examining attorney in the case.

that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin by looking at the similarities and dissimilarities of applicant's and registrant's marks, DENVER and DENVER SWEETS. Neither mark is limited to any particular style or design so the marks are identical except for the fact that registrant adds the disclaimed word "Sweets" in its mark. The term "Sweets" appears, at a minimum to be descriptive of cigars with "a sweet flavor, smell."[3] *The Random House Dictionary of the English Language (unabridged)* (2d ed. 1987).[4] Disclaimed matter is often "less significant in creating the mark's commercial impression." In re Code Consultants Inc., 60 USPQ2d 1699, 1702 (TTAB 2001). The Federal Circuit has held that the addition of the word "Swing" to registrant's mark "Laser"

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[3] See also In re House of Windsor, 221 USPQ 53, 54 (TTAB 1983) (emphasis added) ("Registration was initially refused in this case, under Section 2(e)(1) of the Trademark Act, on the ground that the term 'BAHIA' merely described a type of small, *sweet*, dark leaf tobacco raised in the Bahia province in Brazil, from which leaves applicant's cigars were presumably made").

[4] We take judicial notice of this definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

did not result in the marks being dissimilar. "[B]ecause both marks begin with 'laser,' they have consequent similarities in appearance and pronunciation. Second, the term 'swing' is both common and descriptive… Regarding descriptive terms this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion." Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1845-45 (Fed. Cir. 2000) (citations and quotation marks omitted). See also In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Court held that the addition of "The," "Cafe" and a diamond-shaped design to registrant's DELTA mark still resulted in a likelihood of confusion).

Applicant's mark DENVER is obviously dominated by the term DENVER inasmuch as it is the entire mark. Registrant's mark DENVER SWEETS would also be dominated by the same term because the descriptive term "Sweets" would not significantly distinguish the otherwise identical terms. When we compare the marks in their entireties, the terms DENVER and DENVER SWEETS are similar in sound, appearance, meaning, and commercial impression. If "the dominant portion of both marks is the same, then confusion

may be likely notwithstanding peripheral differences." In re Denisi, 225 USPQ 624, 624 (TTAB 1985).

However, applicant argues that the term "Denver" is "highly diluted" and it "is entitled to a narrow scope of protection as it is a weak word." Brief at 6. Applicant relies on a list of 319 marks that contain the word "Denver." There are numerous problems with applicant's argument. First, the Federal Circuit has made it clear that concerning the "strength of a mark, however, registration evidence may not be given *any* weight." Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (emphasis in original). See also AMF Inc. v. American Leisure Prods., Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) ("The existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them"). Therefore, we cannot consider the registrations as evidence that the cited mark is weak or diluted. Also, while "third-party registrations may be used to demonstrate that a portion of a mark is suggestive or descriptive, they cannot be used to justify the registration of another confusingly similar mark." In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987). Therefore, even if applicant provided complete copies of

these registrations, they would not support applicant's argument that the cited registration is weak and entitled to only a narrow scope of protection.

More importantly, the evidence of record consists of a list of application and registration numbers with the mark and the status of the application and registration. Normally, the "submission of a list of registrations is insufficient to make them of record." In re Duofold, Inc., 184 USPQ 638, 640 (TTAB 1974). However, the examining attorney has not objected and we will consider them for whatever limited probative value such evidence may have. In re Broyhill Furniture Industries Inc., 60 USPQ2d 1511, 1513 n.3 (TTAB 2001). We add that there is little probative value in a list of marks devoid of goods or services, disclaimers, and other information.

Furthermore, when we view the list, there are only approximately 33 active registrations. The rest of the list is composed of applications and expired registrations, which are not evidence that supports applicant's argument. Action Temporary Services Inc. v. Labor Force Inc., 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("[A] canceled registration does not provide constructive notice of anything"); and Glamorene Products Corp. v. Earl Grissmer Co., Inc., 203 USPQ 1090, 1092 n.5 (TTAB 1979)

("The filing of a notice of reliance upon third-party applications is a futile act because copies of those applications or the publication thereof in the Official Gazette is evidence only of the filing of the applications and nothing else"). The fact that the term "Denver" is registered as part of 33 different registrations for a variety of goods and services is hardly surprising. Therefore, we cannot conclude from this very limited evidence that the cited registration is weak.

The next factor we consider is the relatedness of the goods of applicant and registrant. Registrant's goods consist of a single item, cigars. Applicant's goods include cigarettes, tobacco, matches, and various smoker's articles. Obviously, goods do not have to be identical before we can find that they are related. "In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources." McDonald's Corp. v.

McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). See also In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001).

The examining attorney has introduced numerous registrations that show that the same entity has registered its mark for both cigarettes and cigars. See, e.g., Registration Nos. 2,128,089 (cigars and cigarettes); 2,289,175 (cigars and cigarettes); 2,174,627 (cigars and cigarettes); 2,632,926 (cigars and cigarettes); 2,690,682 (cigars and cigarettes); 2,750,200 (cigars and cigarettes); 2,739,152 (cigars and cigarettes); and 2,750,333 (cigars and cigarettes). These registrations suggest that cigars and cigarettes originate from the same source. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"). See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).

Furthermore, we note that the board has held that cigars and smoking tobacco are related products.

> Cigars, chewing tobacco and smoking tobacco are all tobacco products sold in the same retail outlets to the general purchasing public. Although neither of

> the parties presently includes in their line of products the goods of the other, the record indicates that other companies carry such products as part of their line. There is no doubt that if cigars and chewing tobacco or smoking tobacco were sold under the same or similar marks, the purchasing public would readily assume that the products originate with a single producer or seller.

Consolidated Cigar Corp. v. Liggett & Myers Tobacco Co., 137 USPQ 483, 484 (TTAB 1963).

Here, the record supports the examining attorney's conclusion that the goods are related. When we also consider that the marks DENVER and DENVER SWEETS are very similar, we hold that if purchasers were to encounter these very similar marks on the identified products, they are likely to assume that the sources of these goods are related or associated in some way. Therefore, confusion would be likely.

Decision: The refusal to register applicant's mark under Section 2(d) is affirmed.