

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

Mailed:  
February 9, 2006  
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Greenspring Media Group Inc.  
(by change of name from Minnesota Monthly Publications Inc.)<sup>1</sup>

Serial No. 78298486

Linda M. Byrne of Crawford Maunu PLLC for Greenspring Media  
Group Inc.

Florentina Blandu, Trademark Examining Attorney, Law Office  
112 (Janice O'Lear, Managing Attorney).

Before Quinn, Bucher and Drost, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Greenspring Media Group Inc. seeks registration on the  
Principal Register of the mark **GIRLS NIGHT OUT** (*standard  
character drawing*) for services recited in the application, as  
follows:

"arranging and conducting trade show  
exhibitions in the field of food and wine  
[featuring food and wine samples and  
demonstrations by gourmet chefs], in  
International Class 35.<sup>2</sup>

<sup>1</sup> Applicant's name change was recorded with the Assignment  
Division of the United States Patent and Trademark Office at  
Reel 3078, Frame 0133.

<sup>2</sup> Application Serial No. 78298486 was filed by Minnesota Monthly  
Publications Inc. on September 10, 2003 based upon applicant's  
allegation of first use anywhere and first use in commerce at least

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with the recited services, so resembles the mark **GIRLS NIGHT OUT** (*standard character drawing*), which is registered for services recited as "advertising agencies, namely, promoting the services of retailers through the distribution of printed, broadcast and Internet promotional materials, and rendering sales promotion advice as to retail sales events" also in International Class 35,<sup>3</sup> as to be likely to cause confusion, to cause mistake or to deceive.

When the refusal was made final, applicant appealed and requested reconsideration of the final decision. On April 7, 2005, the Trademark Examining Attorney denied the request for reconsideration and the appeal was resumed. The Trademark Examining Attorney and applicant have each filed a brief in

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as early as February 2000. The Trademark Examining Attorney has been silent about whether or not she accepted applicant's proffer of an amended recitation of services put forward by applicant on February 7, 2005 [e.g., the wording shown above in brackets]. Our decision herein is not affected by the Trademark Examining Attorney's acceptance or rejection of this proposed addition of a clause narrowing the recitation of services. However, should applicant ultimately prevail on the issue of likelihood of confusion, the application would be forwarded back to the Trademark Examining Attorney for consideration of the proposed amendment.

<sup>3</sup> Reg. No. 2637948 issued to 2XL Strategic Marketing, Inc. on October 22, 2002, alleging use in commerce since at least as early as March 11, 1999.

the case, but applicant did not request an oral hearing before the Board. We affirm the refusal to register.

In arguing for registrability, applicant contends that there is no likelihood of confusion with the cited registration because the trademark register shows this to be a weak mark for these services, because of the dissimilarity of the respective services, and because the relevant consumers of these services are sophisticated purchasers.

By contrast, the Trademark Examining Attorney contends that the services of applicant and the registrant are related, and that the channels of trade are closely related, if not identical. She argues that applicant has failed to demonstrate why persons attending a wine and food exposition should be considered sophisticated consumers, and of course, that even sophisticated consumers are not immune from source confusion.

### **Likelihood of confusion**

Our determination under Section 2(d) is based upon an analysis of all of the facts in evidence that are relevant to the factors bearing upon the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and

the relationship of the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

### **The marks**

Accordingly, we turn first to the du Pont factor focusing on the similarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). There is no issue with respect to the similarity between the marks as they are identical, and both are presented in standard character form. This factor heavily favors the position of the Trademark Examining Attorney.

### **Third-Party Use**

The sixth du Pont factor requires consideration of any evidence pertaining to "the number and nature of similar marks in use on similar goods." In an attempt to show that registrant's mark is less distinctive and is entitled to a narrow scope of protection, applicant relied upon a number of third-party registrations of the same, or similar, marks.<sup>4</sup>

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<sup>4</sup> We have not listed the third-party marks identified by applicant that were the subject of abandoned applications or cancelled registrations as they have no probative value as to the scope of protection afforded to registrant's cited mark. Although the Office strives for consistency, the fact that years ago an Trademark Examining Attorney allowed another application loses all

**GIRLS NIGHT OUT** for "cosmetic kits composed of a cosmetic bag and one  
(standard character drawing) or more of the following, antiperspirant, blush, body glitter, bubble bath, cologne, cream for the body, cream for the eyes, cream for the face, cream for the hands, deodorant for personal use, eye shadow, hair conditioner, hair shampoo, hair spray, hair styling gel, lip gloss, lipstick, lotion for the body, lotion for the face, lotion for the hands, makeup, makeup remover, mascara, nail polish, nail polish remover, non-medicated face cleanser, perfume, powder for the body, powder for the face, shower gel, soap for the body, soap for the face and soap for the hands," in International Class 3<sup>5</sup>;

**GIRLS NIGHT IN** for "heat and steam facial saunas; footbaths;  
(standard character drawing) whirlpool baths for feet; portable electric water heaters and aerators for washing and refreshing feet, for domestic use; parts and replacement parts therefore" in International Class 11<sup>6</sup>;

**GIRLS NIGHT-OUT PARTIES** for "distributorships and mail order catalog services  
(standard character drawing) in the field of adult novelty items, marital aids, and gift items sold through party plans" in International Class 35.<sup>7</sup>

This evidence is entitled to little probative value in determining likelihood of confusion. Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992); and Carl Karcher Enterprises, Inc. v. Stars Restaurants Corp., 35 USPQ2d 1125 (TTAB 1995). The registrations are not

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relevance if the application is subsequently abandoned due to a failure to file a Statement of Use. See Applicant's appeal brief, pp. 4-5.

<sup>5</sup> Reg. No. 2799879 issued on December 30, 2003 based upon a claim of use anywhere and use in commerce since at least as early as March 4, 2002.

<sup>6</sup> Reg. No. 2789811 issued on December 2, 2003 based upon a claim of use anywhere and use in commerce since at least as early as January 17, 2003.

<sup>7</sup> Reg. No. 2855014 issued on June 15, 2004 based upon a claim of use anywhere and use in commerce since at least as early as July 29, 2002.

evidence that the marks are in use, much less that purchasers are familiar with them. Further, contrary to the gist of applicant's remarks, the probative value of this evidence is greatly diminished by the fact that the goods and services covered in the third-party registrations are distinctly different from advertising services.

Moreover, although third-party registrations are probative to show, in the manner of dictionary definitions, that the term has a significance or meaning in this field (*See Conde Nast Publications Inc. v. Miss Quality, Inc.*, 180 USPQ 149 (TTAB 1973)), given the paucity of third-party, registered marks that are the same as, or *similar* to, the **GIRLS NIGHT OUT** mark, applicant has failed to demonstrate that the term has a significance or meaning in this field.

Hence, applicant has not rebutted the position of the Trademark Examining Attorney that registrant's mark should be regarded as a strong mark entitled to broad protection.<sup>8</sup> Accordingly, this factor weighs in the Office's favor.

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<sup>8</sup> Moreover, although applicant points out that the term "Girls Night Out" is "ubiquitous" in our society [e.g., applicant got 16.8 million hits on a Google search done on February 1, 2005], this result has no relevance to the question before us as to the strength of this term to serve as a source indicator for registrant's services.

**The Services**

With respect to the services, it is well established that the services of registrant and of applicant need not be similar or competitive, or even that they are offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective services of registrant and applicant are related in some manner, and/or that the conditions and activities surrounding the marketing of the 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 source. See Hilson Research, Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993); and In re International Telephone & Telephone Corp., 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the goods or services, but rather whether there is a likelihood of confusion as to the source of the goods (or services). In re Rexel Inc., 223 USPQ 830 (TTAB 1984).

In comparing the services, we initially note that where identical marks are involved, as is the case here, the degree of similarity between the respective services that is required to support a finding of likelihood of confusion declines. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688-1689

(Fed. Cir. 1993); Time Warner Entertainment Co. v. Jones, 65 USPQ2d 1650, 1661 (TTAB 2002); and In re Opus One Inc., 60 USPQ2d 1812 (TTAB 2001).

In support of her position on the relatedness of the services, the Trademark Examining Attorney initially did a Google search of the words TRADE SHOWS AND ADVERTISING AGENCIES. Summary pages for hits 1 - 40 and 71 - 80 were attached to her Office action of March 5, 2004. She attached additional Internet web pages to later Office actions.

Several of the websites are municipal, regional or national directories of advertising agencies, some of which list "trade shows support" as one of the services offered by advertising agencies.<sup>9</sup> At least one site reports that advertising agencies are often reluctant to include trade

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- <http://dir.yahoo.com/>
- [http://www.ad-mkt-review.com/public\\_html/docs/fs040.html](http://www.ad-mkt-review.com/public_html/docs/fs040.html), Advertising and Marketing Review: "you are either already a trade show exhibitor, or you should be"
- [http://directory.google.com/Top/Business/Business\\_Services/Event\\_Planning\\_and\\_Production/Convention\\_and\\_Trade\\_Show\\_Services/Exhibit\\_and\\_Display\\_Vendors/Custom\\_Exhibits/](http://directory.google.com/Top/Business/Business_Services/Event_Planning_and_Production/Convention_and_Trade_Show_Services/Exhibit_and_Display_Vendors/Custom_Exhibits/)
- [http://www.business.com/directory/advertising\\_and\\_marketing/advertising/agencies/full-service/us\\_states/illinois/](http://www.business.com/directory/advertising_and_marketing/advertising/agencies/full-service/us_states/illinois/)
- <http://boston.about.com/>
- <http://www.houstonadagencies.com/>
- <http://www.pureim.com/chicago/chicago-advertising-agency/chicago-advertising-agency.htm>, Pure Imagination, a Chicago advertising agency does trade show booth design
- <http://www.coloradoarts.net/>

shows in their clients' marketing plans.<sup>10</sup> However, many of the listed sites are totally irrelevant to the point for which the Trademark Examining Attorney cites to them.<sup>11</sup> For example, given the way the syntax of the search was set up, there is nothing in some of the sites about "trade shows," but rather, the words "trade" and "shows" appeared in distinctly different portions of the website.<sup>12</sup> Several websites show that national associations of advertising agencies have their own industry trade shows.<sup>13</sup> Some other sites appear to be Internet portals

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<sup>10</sup>     ▪ <http://www.tenonline.org/art/mm/9708.html>, Trade Show Marketing: Ad Agencies ... Help or Hindrance?

<sup>11</sup>     ▪ <http://www.schipul.com/agencies/index.asp>, hypothetical intended to sell an Internet tracking function: "It might also interest you that we have turned around complete projects with full Tendenci™ marketing tracking functionality in less than a week for those sometimes unreasonable clients of yours. Ya, you know the ones with the trade show next week they forgot to mention."

      ▪ <http://www.apparelnews.net/Links/tradeshows.html>, major international apparel and textile trade shows

      ▪ <http://www.advertising.com/Contact/ContactAgency.html>, information request form to have an Advertising.com representative evaluate one's objectives

      ▪ <http://www.jobpilot.cz/content/service/jobjournal/>, a job listing in Switzerland

      ▪ <http://www.buyusa.gov/korea/en/>, U.S. government agency promoting U.S. business interests in South Korea

      ▪ <http://www.gcn.com/adinfo/shows.pdf>, Government Computer News blurbs

      ▪ <http://www.vss.com/>, Veronis Suhler Stevenson, an investment firm serving media clients in North America and Europe.

<sup>12</sup>     ▪ <http://www.museum.tv/archives/etv/A/htmlA/advertisinga/advertisinga.htm>

      ▪ [www.adforum.com](http://www.adforum.com)

      ▪ <http://archive.thisisworcestershireshire.co.uk/2002/5/2/272417.html>

<sup>13</sup>     ▪ [www.aaaa.org/](http://www.aaaa.org/), American Association of Advertising Agencies has an annual conference including a tradeshow

      ▪ [www.adweek.com](http://www.adweek.com) discusses American Association of Advertising Agencies' annual media conference and tradeshow

for foreign or international ventures.<sup>14</sup> Others are primarily devoted to foreign food and wine shows, but do include some trade shows in the United States.<sup>15</sup>

In summarizing these Internet hits, we find that many were not particularly helpful in showing the relationship between advertising agency services and arranging trade show exhibitions in any field. On the other hand, a number of

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▪ [http://www.ana.net/news/2001/01\\_18\\_01.cfm](http://www.ana.net/news/2001/01_18_01.cfm), a national e-business conference and trade show, designed to help advertising agencies and advertising executives steeped in Internet marketing practices

▪ <http://www.mediapost.com/index.cfm>

<sup>14</sup> ▪ <http://www.ctv.ca/servlet/ArticleNews/story/CTVNews/>, in Canada

▪ <http://trade.indiamart.com/offer/media-advertising>, the gateway to markets in India

▪ <http://www.modaitalia.net/common/about.htm>, the Italian Fashion Portal

▪ <http://www.internettradeshowslist.com>, IT and Business Trade Shows Around the World

▪ <http://www.theemrgroup.com/index.html>, in the UK

▪ <http://archive.thisisworcestershire.co.uk/2002/5/2/272417.html>, in the UK

▪ <http://www.tdctrade.com/prodmag/house/hou199811nw.htm>, in Hong Kong

▪ [http://www.world-food.ru/about/index\\_e.asp](http://www.world-food.ru/about/index_e.asp) or <http://www.world-food.ru/eng/about/sections/>, World Food Show and Conference in Moscow.

<sup>15</sup> ▪ [http://www.expocentral.com/food\\_and\\_beverage/industry\\_food\\_and\\_beverage\\_wine.html](http://www.expocentral.com/food_and_beverage/industry_food_and_beverage_wine.html), local, national and global trade shows and companies organized into subject-based categories and sub-categories, including wine trade shows in cities in the United States, including Boston, New Orleans, San Francisco and Sacramento

▪ [http://atn-riac.agr.ca/events/3683\\_e.htm](http://atn-riac.agr.ca/events/3683_e.htm), New Brunswick office of the Agri-Food Trade Service, Canada, website listing food trade shows from seventy countries chosen based on their relevance to the agri-food, fish and seafood sectors, including expositions in Washington DC, New York City, Boston, Chicago, San Francisco, Los Angeles, Long Beach, Portland (OR), and Tacoma

▪ [http://www.divbusiness.com/ts\\_byindustry\\_detail.asp?ShowTypeID=5](http://www.divbusiness.com/ts_byindustry_detail.asp?ShowTypeID=5), of ten shows, all but one is offered within Australia, that one exception being an office in Portland, ME.

these websites do make it clear that it is not unusual that among the services advertising agencies offer to their retail clients, one such service is support for trade shows.

Applicant argues that its services "function in a specialized and niche area of commercial discourse that is separate and distinct from 'advertising agencies'."

Applicant's brief, p. 7. Applicant goes on to argue that "[t]hese services are NOT a sub-set of advertising agency services." Applicant's brief, p. 8, EMPHASIS in original. In support of its position, applicant argues there are also differences in the trade channels and classes of purchasers.

However, other than naming retailers, there are no restrictions as to the retail field of registrant's customers. Hence, we must presume that registrant's advertising services promoting the services of retailers includes those in the field of food and wine, and rendering advice as to retail sales events would include events in the field of food and wine, such as trade shows.

Although the respective services recited herein are different, we find that registrant's advertising agency services and applicant's arranging trade show exhibitions in the field of food and wine are commercially related. Again, the test is not whether purchasers would confuse advertising agency services generally with arranging and conducting trade

show exhibitions in the field of food and wine, but rather whether purchasers would be confused as to the source of these services. On balance, we conclude that this factor favors the position taken by the Trademark Examining Attorney.

**Trade Channels**

It is clear on the face of registrant's recitation of services that its customers are retailers seeking promotional services and advice on retail sales events.

As to applicant's services, the record demonstrates that the success of the "Twin Cities Food and Wine Experience," the event with which this mark is used, depends upon the response of demographically-targeted consumers - namely, women from the metropolitan areas of Minneapolis and St. Paul, Minnesota, having disposable income who are interested in an experience of gourmet food and fine wine. However, applicant does not dispute the fact that its primary customers are the featured gourmet chefs from area restaurants and vintners from various wineries - entrepreneurs on whose behalf the trade show is arranged each year. These same chefs and vintners may very well have had occasion in the past to seek out an advertising agency offering services like those provided by registrant.

Given this overlap of potential customers, we find that chefs and vintners familiar with **GIRLS NIGHT OUT** advertising services would likely believe that **GIRLS NIGHT OUT** for the

arranging and conducting of food and wine trade shows emanates from the same source, even though applicant does not provide advertising agency services.

**Conditions of Sale and Classes of Purchasers**

As to the du Pont factor focusing on the conditions under which and buyers to whom these sales are made, applicant argues that its customers are careful, sophisticated consumers:

For the present application, the sophistication of the consumers is a particularly important consideration in that the trade show events are complex and expensive events. Thus, the relevant consumer in the present case is going to be very discerning and will typically spend a large sum of time contemplating any purchase of services from the Applicant by first determining if and how the Applicant can effectively provide the trade show services.

Applicant's appeal brief, p. 11.

In response, the Trademark Examining Attorney argues that applicant has failed to prove that persons merely attending a wine and food exposition are sophisticated consumers (appeal brief, p. 7). Consistent with our discussion *supra* about trade channels, it appears from the above quotation that rather than referring to the women attending the food exposition, applicant is referring instead to restaurant owners, managers, vintners and gourmet chefs. Nonetheless, we are not convinced from this record that every restaurateur,

chef or vintner has a great deal of sophistication in marketing and promotional activities. Moreover, even if we accept the proposition "that the trade show events are complex and expensive events," and hence, presume that purchases of applicant's and registrant's related services will be made with at least some degree of care and sophistication, it is well settled that the fact that consumers may indeed exercise some deliberation in choosing the respective services at issue "does not necessarily preclude their mistaking one trademark for another" or that they otherwise are entirely immune from confusion as to source or sponsorship. Wincharger Corp. v. Rinco, Inc., 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also In re Decombe, 9 USPQ2d 1812, 1814-15 (TTAB 1988); In re Hester Industries, Inc., 231 USPQ 881, 883 (TTAB 1986); and In re Pellerin Milnor Corp., 221 USPQ 558, 560 (TTAB 1983). Such is especially the case where, as here, the marks at issue are identical in all respects.

**Resolve any doubt against the newcomer**

Finally, after weighing all the relevant du Pont factors, should we retain any doubt on the issue of likelihood of confusion, such doubt must be resolved in favor of the prior user and against the newcomer. Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768 (TTAB 1992).

### **Conclusion**

Accordingly, we conclude that customers and potential customers, who are familiar or acquainted with registrant's mark **GIRLS NIGHT OUT**, which is registered for providing advertising agency services for retailers and rendering sales promotion advice about retail sales events, would be likely to believe, upon encountering applicant's identical **GIRLS NIGHT OUT** mark for arranging and conducting trade show exhibitions in the field of food and wine, that such related services emanate from, or are sponsored by or associated with, the same source.

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