4/3/02

Paper No. 9
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Diane B. Coffey

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Serial No. 76/000,318

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Taylor M. Davenport of Coats and Bennett, P.L.L.C. for Diane B. Coffey.

Christopher L. Buongiorno, Trademark Examining Attorney, Law Office 109 (Ronald R. Sussman, Managing Attorney).

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Before Cissel, Hairston and Bottorff, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark RETRIEVER WORLD (in typed form; RETRIEVER has been disclaimed) for "computerized on-line ordering services, catalog services, and retail store services featuring sporting goods, namely, hunting, fishing, and animal training equipment," in Class 35.[1]

[1] Serial No. 76/000,318, filed March 14, 2000. The application is based on use in commerce under Trademark Act Section 1(a), and "1998" is alleged as the date of first use and date of first use in commerce. The application also covers Class 42 services

The Trademark Examining Attorney has refused registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the ground that applicant's mark is confusingly similar to the mark RETRIEVER, previously registered on the Principal Register for "bowfishing reels."[2] When the refusal was made final, applicant filed this appeal. Applicant and the Trademark Examining Attorney have filed appeal briefs, but no oral hearing was requested. We reverse the refusal to register.

Initially, we sustain the Trademark Examining Attorney's objection to the evidentiary materials applicant submitted with her appeal brief. Those materials (which purport to demonstrate the existence of third-party registrations and Internet usage of marks which include the word RETRIEVER) are untimely under Trademark Rule 2.142(d), and we have given them no consideration. Likewise, we have given no consideration to the mere listing of third-party

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recited as "computer services, namely, designing and implementing network web pages for others; hosting the web sites of others on a computer server for a global computer network." Registration was not refused as to these Class 42 services, and they are not involved in this appeal.

[2] Registration No. 2,253,559, issued June 15, 1999. The Trademark Examining Attorney initially issued a second Section 2(d) refusal based on Supplemental Register Registration No. 2,064,230, which is of the mark RETRIEVER TRAINER for "remote control devices for training retrievers, namely, electronic transmitters and receivers." The Trademark Examining Attorney withdrew this second refusal in his final office action.

registrations and applications (involving marks which include RETRIEVER) that applicant set forth in her response to the first office action. *See Weyerhauser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983); *In re Duofold, Inc.*, 184 USPQ 638 (TTAB 1974).

The evidence of record includes: (1) the Trademark Examining Attorney's submission of the following dictionary definition of "retriever": "one that retrieves; *esp* : a dog of any of several breeds (as a golden retriever) having a heavy water-resistant coat and used esp. for retrieving game"; (2) the Trademark Examining Attorney's submission of the following dictionary definition of "world":

> **1 a :** the earthly state of human existence **b :** life after death – used with a qualifier <the next ~> **2 :** the earth with its inhabitants and all things upon it **3 :** individual course of life : CAREER **4 :** the inhabitants of the earth : the human race **5 a :** the concerns of the earth and its affairs as distinguished from heaven and the life to come **b :** secular affairs **6 :** the system of created things : UNIVERSE **7 a :** a division of or generation of the inhabitants of the earth distinguished by living together at the same place or at the same time <the medieval ~> **b :** a distinctive class of persons or their sphere of interest <the academic ~> **8 :** human society <withdraw from the ~> **9 :** a part or section of the earth that is a separate independent unit **10 :** the sphere or scene of one's life and action

> <living in your own little ~> **11 :** an indefinite multitude or a great quantity or distance <makes a ~ of difference> <a ~ away> **12 :** the whole body of living persons **:** PUBLIC <announced their discovery to the ~> **13 :** KINGDOM 5 <the animal ~> **14 :** a celestial body (as a planet);

(3) the Trademark Examining Attorney's submission of printouts of four third-party use-based registrations which cover both Class 28 fishing equipment and Class 35 services in the field of fishing equipment;[3] and a printout of the above-referenced third-party Supplemental Register

[3] Reg. No. 1,932,748, of the mark CAPT. HARRY'S for "fishing supplies, namely rods and lures" and "retail stores featuring fishing supplies, retail outlets featuring fishing supplies, retail shops featuring fishing supplies, wholesale stores featuring fishing supplies, and mail order catalog services featuring fishing supplies"; Reg. No. 2,012,035, of the mark NYMPH MASTER for, inter alia, "hand held fishing nets for sportsmen, fishing fly boxes, fishing flies and tackle boxes" and "mail order catalog services featuring fishing related goods"; Reg. No. 2,306,481, of the mark CENTERLINE for "fishing equipment, namely, fish attractant scents, feeder tubes for bait, and fishing hook removers" and "mail order and mail order catalog services featuring fishing equipment and instructional fishing videos; wholesale distributorship services featuring fishing equipment and instructional fishing videos; computerized on-line retail services in the field of fishing equipment and instructional fishing videos"; and Reg. No. 2,346,450, of the mark THE SURFCASTER for "fishing equipment, namely, fishing rods, fishing lures, fishing reels, fishing rod holders, fishing reel bags, fishing gear bags, fly fishing stripping baskets, fly lines, gaffs, gaff holders, fishing hooks, fishing scales, fishing scalers, and fishing permit kits, namely kits containing fish hook removers, fishing scales, tow cables, tire deflation devices, tire pressure gauges, portable commodes, first aid kits, fire extinguishers, flashlights, shovels, jacks, jack boards, and carrying pouches" and "mail order catalog sale services featuring fishing equipment." Also of record are three additional third-party registrations of marks for Class 35 services in the field of fishing equipment; these three registrations do not include Class 28 fishing equipment per se.

registration of RETRIEVER TRAINER for "remote control devices for training retrievers, namely, electronic transmitters and receivers," originally cited by the Trademark Examining Attorney as a Section 2(d) bar to registration of applicant's mark (but later withdrawn).[4]

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours and Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind 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 our analysis by determining, under the first *du Pont* factor, whether applicant's mark and opposer's mark, when compared in their entireties in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when

[4] See *supra* at footnote 2.

subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather an a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.,* 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re National Data Corp.,* 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In terms of appearance and sound, we find that applicant's mark RETRIEVER WORLD and registrant's mark RETRIEVER obviously are identical to the extent that they both consist of or begin with the word RETRIEVER. However, the marks look and sound dissimilar to the extent that applicant's mark includes the word WORLD while registrant's mark does not.

In terms of connotation, we find that the word RETRIEVER in applicant's mark, as applied to applicant's

services, would be understood to mean, or to refer to, the sporting dogs known as "retrievers." We base this finding on the dictionary definition of "retriever" quoted above, and on the fact that applicant's services, as recited in the application, include the marketing and sale of "animal training equipment." Clearly, it was this "sporting dog" connotation of RETRIEVER as applied to applicant's "animal training equipment" that prompted the Trademark Examining Attorney to require (and applicant to supply) the disclaimer of RETRIEVER. Although applicant's recited services also include the sale of hunting gear and fishing equipment, not just animal training equipment, we find that purchasers viewing applicant's mark in connection with applicant's recited services readily will understand the word RETRIEVER as connoting the sporting dogs known as "retrievers."

Our finding that purchasers are likely to ascribe this "sporting dog" connotation to the word RETRIEVER in applicant's mark is bolstered by a review of applicant's advertisements (submitted as specimens of use in the application). *See In re P. Ferrero & C.S.p.A.,* 479 F.2d 1395, 178 USPQ 167 (CCPA 1973)(specimens of use are relevant to determination of meaning of mark). It appears from applicant's specimens that the primary focus of

applicant's business is the sale of the "animal training equipment" listed in the recitation of services, and the sale of dog training equipment in particular. Applicant's price list bears the heading "Quality Sporting Dog Equipment," and the products listed for sale appear to consist almost exclusively of such dog training equipment. Directly under the RETRIEVER WORLD mark at the top of the advertisement are the words (in quotation marks and in italic type) "Dedicated to Retrievers and Their Owners."

Next, we find that the word WORLD, as used in applicant's mark and as applied to applicant's services, would be understood to have the meaning set forth in the above-quoted dictionary definitions as entry number **7 b**, i.e., "a distinctive class of persons or their sphere of interest," and/or the meaning set forth as entry number **10**, i.e., "the sphere or scene of one's life and action." The other listed definitions clearly are less pertinent, if not also irrelevant, in the context of applicant's mark as applied to applicant's services. Given the obvious mere descriptiveness of the term RETRIEVER as applied to applicant's services, we find that the word WORLD plays a significant and even dominant role in the commercial impression created by applicant's mark.

Thus, considering applicant's mark RETRIEVER WORLD in its entirety as applied to applicant's services, we find that the mark connotes retriever sporting dogs and the sphere of interests and activities pertaining to or shared by such dogs and their owners.

Turning now to the cited registered mark RETRIEVER, we find that its connotation, as applied to registrant's goods, clearly is dissimilar to the connotation of applicant's mark RETRIEVER WORLD. Registrant's goods are "bowfishing reels." When considered in connection with such goods, the mark RETRIEVER perhaps connotes or suggests that the reel will allow the fisherman to "retrieve" fish, or it might suggest some feature of the reel which allows the fisherman's line, or lure, to be "retrieved" easily.

Although the exact connotation of registrant's mark as applied to registrant's goods is not apparent on this record, it is clear that registrant's mark, unlike applicant's mark, does not connote retriever sporting dogs in any way. We find that this difference in the marks' connotations clearly and significantly weighs against a finding that the marks are confusingly similar. *See, e.g., Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998)(CRYSTAL CREEK for wine has different connotation than CRISTAL for

champagne; marks found to be dissimilar); *ConAgra Inc. v. Saavedra*, 4 USPQ2d 1245 (TTAB 1987)(PATIO for Mexican food has different connotation than TAPATIO for Mexican food; marks found to be dissimilar); *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987)(CROSS-OVER for bras has different connotation than CROSSOVER for ladies' sportswear; marks found to be dissimilar); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984)(PLAYERS for shoes has different connotation than PLAYERS for men's underwear; marks found to be dissimilar); and *Taj Mahal Enterprises Ltd. v. Trump*, 745 F.Supp. 240, 16 USPQ2d 1577 (D.N.J. 1990)(TAJ MAHAL for Indian restaurant has different connotation than TAJ MAHAL for Atlantic City hotel/casino; marks found to be dissimilar).

Having considered the marks in their entireties in terms of appearance, sound and connotation, we find (under the first *du Pont* factor) that they are more dissimilar than similar in their overall commercial impressions. The mere presence of the word RETRIEVER in both marks does not suffice to render the marks similar, especially in view of the fact that the word presents a different meaning and commercial impression in each mark, as applied to the respective goods and services. The presence of the word WORLD in applicant's mark further distinguishes the

appearance, sound and connotation of the two marks when considered in their entireties.

We turn next to the second *du Pont* evidentiary factor, (i.e., "the similarity or dissimilarity and nature of the goods or services"). We find that applicant's services, which involve, inter alia, the online, catalog, and retail sale of sporting goods, including fishing equipment, are similar and related to registrant's bowfishing reels. It is settled that confusion is likely to result if the same or similar marks are used for goods, on the one hand, and for services involving those goods, on the other. *See, e.g., In re Hyper Shoppes (Ohio) Inc.,* 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *see also* TMEP §1207.01(a)(ii) and cases cited therein. Applicant's services involve the sale of fishing equipment such as registrant's, and we find that the respective goods and services are related, at least to that extent.

Moreover, although the four third-party registrations made of record by the Trademark Examining Attorney[5] are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them, they nevertheless are probative evidence to the extent that they

[5] See *supra* at footnote 3.

suggest that the goods or services identified therein (i.e., fishing gear, and the services of selling fishing gear) are of a type which may emanate from a single source under a single mark. *See In re Albert Trostel & Sons Co.,* 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988).

There are no limitations or restrictions in either applicant's or registrant's identification of goods and/or services, and we therefore presume that those goods and services are marketed in all normal trade channels for such goods and services and to all normal classes of purchasers of such goods and services. *See In re Elbaum,* 211 USPQ 639 (TTAB 1981). Given the above-noted relationship between applicant's services and registrant's goods, we presume that applicant's and registrant's trade channels and purchasers overlap. In fact, in her appeal brief, applicant asserts that she sells registrant's RETRIEVER bowfishing reels. This overlap in trade channels weighs in favor of finding of likelihood of confusion under the third *du Pont* factor, i.e., "the similarity or dissimilarity of established, likely-to-continue trade channels."

Applicant argues that the purchasers of her services and registrant's goods are knowledgeable about those goods and services, and that because they are concerned about the

quality and safety features of their hunting and fishing equipment, they are selective and careful in making their purchasing decisions. However, there is no evidence in the record to support this contention. In any event, we are not persuaded that purchasers of these goods and services necessarily are so knowledgeable or careful that they would be immune to source confusion arising from the use of confusingly similar marks on or in connection with the respective goods and services. We find that the fourth *du Pont* factor, "the conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing," is neutral in this case, at best.

There is no evidence as to the fame of registrant's mark, and the fifth *du Pont* factor accordingly is neutral in this case. There likewise is no evidence in the record pertaining to the sixth *du Pont* factor, i.e., "the number and nature of similar marks in use on similar goods [and services]." As discussed above, applicant's proffered evidence of such third-party use was untimely-submitted and has not been considered.[6]

[6] Also, we are not persuaded by applicant's "examination consistency" argument, set forth in applicant's brief under the thirteenth "miscellaneous" *du Pont* factor. Even if applicant had proven the existence on the register of a third party's allegedly confusingly similar mark (and she has not), the existence of such a registration does not warrant registration of another confusingly similar mark to applicant. *See, e.g., AMF Inc. v.*

There is no evidence of any actual confusion (seventh *du Pont* factor). However, under the eighth *du Pont* factor, the absence of actual confusion is not dispositive nor particularly significant in our likelihood of confusion determination in this ex parte case. *See, e.g., In re Seiber & McIntyre, Inc.*, 192 USPQ 722 (TTAB 1976). There is no evidence as to the extent of either applicant's or registrant's use of their respective marks. Applicant apparently has used her mark only since 1998. Applicant asserts in her brief that she advertises and sells registrant's bowfishing reels on her website, but that she "is unaware of exactly how long" that has occurred. We cannot conclude from this record that there has been such an opportunity for actual confusion to have occurred that the absence thereof is surprising or legally significant. We find that the seventh and eighth *du Pont* factors are neutral in our likelihood of confusion analysis in this case.

Under the ninth *du Pont* factor ("the variety of goods on which a mark is or is not used"), it appears from this record that registrant uses its RETRIEVER mark only on a

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American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973); *Plus Products v. StarKist Foods, Inc.*, 220 USPQ 541 (TTAB 1983).

single product, i.e., bowfishing reels. Applicant uses her mark only in connection with the online, catalog and retail store services recited in the application, and not as a trademark for any "house brand" goods of her own.

With respect to the tenth *du Pont* factor (the "market interface" between applicant and registrant), applicant asserts in her brief that she has marketed registrant's bowfishing reels for some indeterminate amount of time without any actual confusion, and that although there is no formal agreement between the parties, she "believes that Registrant is aware of Applicant and consents to Applicant's use of RETRIEVER WORLD." However, there is no consent agreement of record, nor any other evidence establishing either that opposer consents to applicant's registration of the mark for the recited services, or that opposer in fact believes that no confusion is likely to result from applicant's use of the mark in connection with the recited services. We accordingly find that the tenth *du Pont* factor does not aid applicant in this case. *See generally In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001).

In summary, we have carefully considered all of the evidence of record pertaining to the *du Pont* likelihood of confusion evidentiary factors, and we conclude that there is no likelihood of confusion in this case. Applicant's

services and registrant's goods (and the trade channels and purchasers therefor) are related to the extent that applicant's services could involve, and apparently do involve, the marketing of registrant's goods, and those *du Pont* factors weigh in favor of a finding of likelihood of confusion. However, notwithstanding the relationship between the respective goods and services, we conclude that the marks are too dissimilar to warrant a finding of likelihood of confusion, and that the first *du Pont* factor accordingly is dispositive in this case. *See, e.g., Champagne Louis Roederer S.A. v. Delicato Vineyards, supra*; *Kellogg Co. v. Pack'em Enterprises,* 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). Specifically, because the connotation and commercial impression of applicant's mark would be perceived, understood and recalled as having to do primarily with retriever sporting dogs, and because registrant's mark as applied to registrant's goods has no such connotation or commercial impression, we find that purchasers are not likely to assume that a source connection exists as between applicant's services and registrant's goods.

Decision: The refusal to register is reversed.