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MARCH 23, 1998

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Rose Tree Gallery, Inc.

Serial No. 74/684,146

Bruce Allen Herald, Esq. for The Rose Tree Gallery, Inc.

Kathleen Cooney-Porter, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

Before Seeherman, Hohein and Walters, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

The Rose Tree Gallery, Inc. has filed an application to register the mark "TOOTSIE," in the stylized form reproduced below,

for "dolls, doll clothes, doll shoes, doll hats, [and] doll story cards."[1]

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "TOOTSIETOY," which is separately registered by the same registrant for:

> (i) "miniature toys--namely, automobiles, trucks, tractors, aeroplanes, boats, submarines, zeppelins, trains, cannons, dishes, doll-houses, badges, whistles, children's basketballs, guns, pistols, telephones, fire-engines, derricks, ladders, scales, bath-room fixtures, fortune-telling sets, living-room suites, bedroom suites, dining-room sets, rockers, chairs, davenports, desks, dressers, tables, beds and other toy furniture";[2] and
>
> (ii) "miniature toys and novelties, including automobiles, trucks, tractors, airplanes, boats, submarines, trains, cannon[s], dishes, badges, whistles, guns, pistols, fire-engines, derricks, ladders, scales, [and] bath-room fixtures";[3]

as to be likely to cause confusion, mistake or deception.

[1] Ser. No. 74/684,146, filed on June 5, 1995, which alleges dates of first use of April 20, 1995.

[2] Reg. No. 505,201, issued on December 28, 1948, which sets forth dates of first use of April 20, 1921; second renewal.

[3] Reg. No. 365,092, issued on February 21, 1939, which sets forth dates of first use of April 20, 1921; second renewal.

Applicant has appealed. Briefs have been filed,[4] but an oral hearing was not requested. We affirm the refusal to register.

As indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), "in any likelihood of confusion analysis[,] two key considerations are the similarity of the goods and the similarity of the marks."[5] Applicant, in its initial brief, essentially concedes that this appeal is one "where there are similar or identical marks." We agree, in this respect, with the Examining Attorney that, as applied to the respective goods, applicant's "TOOTSIE" mark and registrant's "TOOTSIETOY" mark "are very similar in their overall commercial impression, sound, appearance and connotation." The

[4] Applicant, in its initial brief, has included a list of "numerous prior registrations for similar marks" which, in addition to the two cited registrations, sets forth 16 third-party registrations for marks which consist of or feature the term "TOOTSIE" or its phonetic equivalent. The Examining Attorney, in her brief, has objected to the third-party registrations referred to by applicant, correctly noting that such evidence, having been furnished for the first time with applicant's initial brief, is untimely under Trademark Rule 2.142(d). In addition, a mere listing of third-party registrations is in any event insufficient to make them of record since the Board does not take judicial notice of registrations which reside in the Patent and Trademark Office. See In re Duofold Inc., 184 USPQ 638, 640 (TTAB 1974). Instead, as the Examining Attorney correctly points out, the proper procedure for making third-party registrations of record is timely to submit copies of the actual registrations or the electronic equivalents thereof, namely, printouts of the registrations taken from the Patent and Trademark Office's own computerized database. See, e.g., In re Consolidated Cigar Corp., 35 USPQ2d 1290, 1292 (TTAB 1995) at n. 3; In re Smith & Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994) at n. 3; and In re Melville Corp., 18 USPQ2d 1386, 1388-89 (TTAB 1991) at n. 2. Accordingly, while we sustain the Examining Attorney's objection, we observe that even if the evidence of third-party registrations were to be further considered as forming part of the record, it would make no difference in the outcome of this appeal.

[5] The court, in particular, pointed out that: "The 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."

presence of the generic term "TOY" in registrant's "TOOTSIETOY" mark simply does not significantly distinguish such mark from applicant's "TOOTSIE" mark, given the arbitrary or fanciful nature of the term "TOOTSIE". Consequently, when considered in their entities, the marks "TOOTSIE" and "TOOTSIETOY" so resemble each other that, if used in connection with the same or similar goods, confusion as to the source or sponsorship of such products would be likely to occur.

This brings us to consideration of the respective goods. Applicant, referring to the supporting affidavit of its president, Whitney Smith, which it submitted with its request for reconsideration of the final refusal, argues that notwithstanding the broad manner in which its goods are identified in the application, it uses its "TOOTSIE" mark only with respect to porcelain collectible dolls and accessories therefor.[6] In particular, applicant urges that, in reality, confusion is not likely because, as asserted in its initial brief:

> The collectible dolls sold by the applicant are high in price ($69 to $99). The dolls are made with porcelain. They are not toys.
>
> Applicant uses the mark exclusively in connection with collectible dolls. There is

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[6] Among other things, applicant's president states in her affidavit that she has examined registrant's recent catalogs, which applicant has made of record, "and found no doll houses in such catalogs"; that she "has also investigated the available doll houses on the market"; and that she "believes that [registrant] ... has discontinued use of their mark in connection with doll houses." Applicant's suggestion, however, that registrant may have abandoned the "TOOTSIETOY" mark for doll houses constitutes a collateral attack on the validity of Reg. No. 505,201 and, in the absence of a petition for partial cancellation thereof, will not be given further consideration. See, e.g., In re Calgon Corp., 435 F.2d 596, 168 USPQ 268, 270 (CCPA 1971).

> a defined market of consumers who purchase collectibles. There are defined channels of trade (collectibles magazines). Applicant's collectible dolls have not been and will not be sold in mass market toy stores where the registrant's goods are sold.
>
> Applicant has used the mark extensively in commerce in connection with the sale of her goods, including national television advertising and a nationally published magazine for doll collectors without any evidence of confusion by consumers or a protest by the prior registrant.
>
> Sellers of toys do not market in publications that target collectible [doll] purchasers. Applicant does not use the mark or claim any rights in the mark in connection with toys ....

In addition, with respect to the various third-party registrations relied upon by the Examining Attorney (as discussed below) to support her position that the goods identified in applicant's application are closely related to the goods set forth in the cited registrations, applicant asserts that:

> The Examining Attorney was able to find only one registration for collectible dolls by a registrant (Heritage Mint, Ltd.) who also sold "toy furniture" and "toy wagons". The nature of the registrant, as well as the registered name (Happy Memories Toddler Collection)[,] suggests [sic] that the registrant sells collectibles rather than toys and that the registrant used the word "toy" as synonymous with the word "miniature". The word "[M]int" in the registrant's name also suggests that the registrant is a seller of collectibles rather than toys. Note that the names of two of the collectible marketers referenced in Applicant's Affidavit contain the word "[M]int" and that the name of another collectible marketer also referenced in Applicant's Affidavit contained the word "[C]ollections" as does the registration [for the mark] "Happy Memories Toddler Collection" by Heritage Mint, Ltd.

The Examining Attorney, on the other hand, correctly notes that it is well settled that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the involved application and cited registrations. See, e.g., CBS, Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Furthermore, as the Examining Attorney also accurately points out, where the cited registrations describe the goods broadly and there are no limitations as to their nature, type, channels of trade or class of purchasers, it must be presumed that the goods encompass all goods of the nature and type described therein, that they move in all channels of trade which would be normal for such goods and that they would be purchased by all potential buyers thereof. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). Thus, in the present case, the cited registrant's goods encompass "miniature toys" of all types and specifically include such doll accessories as doll houses and other kinds of playthings for use with dolls such as miniature dishes, living-room suites, bedroom suites, dining-room sets, rockers, chairs, davenports, desks, dressers, tables, beds and other toy furniture.

To support her position that "those who sell dolls, doll clothes, doll shoes, doll hats and doll story cards ... also

sell related miniature toys," the Examining Attorney has made of record the following evidence:

> (i) Over a dozen use-based third-party registrations for marks which, in each instance, are registered for dolls, including porcelain and collectors' dolls, and such doll accessories as doll houses;
>
> (ii) Almost a dozen use-based third-party registrations for marks which, in each case, are registered for dolls or collectible porcelain dolls, on the one hand, and toy furniture or doll furniture on the other hand;[7] and
>
> (iii) Nearly a dozen use-based third-party registrations for marks which, generally speaking, are registered for dolls, doll houses and/or other doll accessories and such diverse toys as toy vehicles, toy boats, caps for toy pistols, toy dishes, toy airplanes, toy guns, toy telephones, toy whistles, toy rockets, toy cars, toy trucks, toy motorcycles, toy train sets, noise makers, construction equipment, plastic cookware play sets, plastic baking sets and/or plastic miniature cars.[8]

The Examining Attorney has also made of record dictionary definitions from Webster's New Collegiate Dictionary (1979), which at 335 defines "doll" as "a small-scale figure of a human being used esp. as a child's plaything" and at 1227 lists "toy"

[7]Such group includes the registration, specifically addressed by applicant, of the mark "HAPPY MEMORIES TODDLER COLLECTION" by Heritage Mint, Ltd. for "collectible porcelain dolls, toy furniture and toy wagons".

[8] It is settled that while third-party registrations are not evidence that the different marks shown therein are in 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 are of a kind which may emanate from a single source. See, e.g., In re Albert Trostel & Sons Co. Inc., 29 USPQ2d 1783, 1783, 1785-86 (TTAB 1993) and In re Mucky Duck Mustard Co., Inc., 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6.

as, inter alia, "something for a child to play with" and "something diminutive".

Like applicant's doll clothes, shoes, hats and story cards, there is no doubt that registrant's miniature toy doll-houses are doll accessories and, as such, are closely related to applicant's goods, including its dolls. As identified in the application, applicant's goods are not restricted to collectible porcelain dolls and accessories therefor and, thus, include the types of toy dolls for which registrant's miniature toy doll-houses would constitute an accessory. Moreover, even if applicant had restricted the identification of its goods to collectible porcelain dolls and accessories for such dolls, registrant's miniature toy doll houses likewise would include those which constitute collectors' items. In addition, the third-party registrations demonstrate that it is common for dolls, including porcelain and collectors' dolls, to come from the same sources as do such doll accessories as doll houses. It is plain, therefore, that contemporaneous use of the mark "TOOTSIE" for goods broadly identified as "dolls, doll clothes, doll shoes, doll hats and doll story cards" and the substantially similar mark "TOOTSIETOY" for miniature toy doll-houses would be likely to cause confusion as to source or sponsorship.

Furthermore, the third-party registrations, when read in light of the commonly understood meanings of the words "doll" and "toy," also establish that not only do those who produce or market dolls, including collectible porcelain dolls, offer doll or other toy furniture, but that makers or sellers of dolls, doll

houses and other doll accessories additionally provide, like the cited registrant, a wide range of such toy products as automobiles (including plastic miniature cars), trucks and other vehicles, airplanes, boats, trains, noise makers (including whistles), firearms and dishes. In particular, it is plain by the very nature of the cited registrant's *miniature* toy dishes and items of *miniature* toy furniture that such goods would often be used, just like doll accessories, for play by children with their dolls. Moreover, the third-party registrations show that toy dishes, toy furniture and the other additional toy items mentioned above, including toy vehicles, are all the kinds of toy products or playthings which the purchasing public has become conditioned to expect to be manufactured or marketed by the same entities which also offer toy dolls and/or doll accessories, such as doll houses.

Purchasers, therefore, who are familiar or otherwise acquainted with the line of miniature toys and novelties sold by the cited registrant under the "TOOTSIETOY" mark could reasonably believe, upon encountering dolls, doll clothes, doll shoes, doll hats and doll story cards marketed by applicant under the substantially similar mark "TOOTSIE," that the latter products constitute a related line of goods from the cited registrant. Such an association would be especially likely inasmuch as the cited registrant's miniature toys and novelties, which by their very nature require less space for display or storage, are particularly suitable as collectors' items.

Decision: The refusal under Section 2(d) is affirmed.

E. J. Seeherman

G. D. Hohein

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board