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THE TTAB**

Mailed: August 30, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pure & Natural Company

Serial No. 77153360

A Kate Huffman, Esq. for Pure & Natural Company.

David C. I, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Walters, Holtzman and Cataldo, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Pure & Natural Company has filed an application to register the standard character mark FIRESIDE GLOW on the Principal Register for "air fresheners, air deodorizer, car deodorizer, carpet deodorizer, household deodorizer, room deodorizer, room freshener, carpet fresheners and odor eliminators, all purpose disinfecting and deodorizing preparations, garbage disposer fresheners, odor neutralizing preparations for use on carpets, textiles, and in the air; aromatic preparations and substances for freshening the air;

perfumed air freshening preparations; air purifying preparations," in International Class 5.¹ The application includes a disclaimer of FIRESIDE apart from the mark as a whole.

The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the standard character mark FIRESIDE WARMTH, previously registered for the goods shown below² that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Registration No. 3405321:

"Bleaching preparations and other substances for laundry use, namely, laundry bleach and laundry detergents; laundry preparations for dry cleaners, namely, dry cleaning fluids and starch; polishing preparations for kitchen and glassware; cleaning, polishing, scouring and abrasive preparations for domestic purposes; carpet cleaners; shampoo detergents; soaps; decalcifying and descaling preparations for domestic purposes; laundry additives, namely, fabric softeners, laundry bluing laundry pre-soaks; stain removing preparations; **perfuming preparations for the atmosphere, namely sachets; potpourri; incense; perfume oils; scented oils, essential oils for domestic use,**" in International Class 3; and

"Sanitary sterilizing preparations; all purpose disinfectants; disinfectant preparations for sanitary purposes; all purpose disinfectant solutions for use in wiping surfaces;

¹ Serial No. 77153360, filed April 10, 2007, based on an allegation of a bona fide intention to use the mark in commerce.

² Registration No. 3405321, issued April 1, 2008, to Reckitt Benckiser Inc.

disinfectants for domestic use or for hygiene and sanitary purposes; all purpose disinfecting agents and preparations having disinfecting properties; anti-bacterial cleaning preparations; fungicides for domestic use; **air freshening preparations, namely, air fresheners; air purifying preparations, namely air deodorizers; room air fresheners; preparations for perfuming or fragrancng the air, namely air deodorants; preparations for neutralizing odors in households, namely, air fresheners; deodorants for household use,"** in International Class 5.
(Emphasis added)

Applicant has appealed. Both applicant and the examining attorney have filed briefs.

The Section 44 Basis of the Cited Registration

Before beginning our discussion of the refusal herein, we must address applicant's argument that, because the cited registration was filed and registered under Section 44 of the Trademark Act, the registration should be afforded a more narrow scope of protection than a use-based registration in the context of a Section 2(d) likelihood of confusion analysis. Applicant reasons that the scope of the cited registration should be limited because the mark was registered without a showing of use and, thus, the statute and underlying treaty obligation, give a foreign national an "unfair" advantage over U.S. applicants and registrants.

Applicant admits that the cases it cites in support of its position, discussed below, do not pertain to likelihood of confusion, but argues that the reasoning therein is applicable in this case. In fact, these cases pertain to

Board construction and interpretation of issues related to the basis for filing an application under the provisions of Section 44. None of the cases, as discussed below, sets legal limitations on a Section 44 application or registration based on any notion of "fairness" and it would be inaccurate to read such a factor into the Trademark Act. In *Societe D'Exploitation de la Marque Le Fouquet's*, 67 USPQ2d 1784 (TTAB 2003), the Board, noting that it was construing Section 44 narrowly, held that the language in Section 44, "... a mark duly registered in a country of origin of a foreign national may be registered ...," requires that the foreign registration forming the basis of the U.S. application must be valid at the time the U.S. registration issues.

The relevant issue in *Marmark, Ltd. v. Nutrespa, SA*, 12 USPQ2d 1843 (TTAB 1989), was whether the Board could interpret broadly the identification of goods in the Spanish registration serving as the basis for registration in the United States. The Board found that the goods were limited to the items following the term "namely" in the identification and that to find otherwise would render the identification meaningless. This finding is a matter of sentence construction as opposed to a "narrow" construction of Section 44.

In *United Rum v. Distiller's Corp.*, 9 USPQ2d 1481 (TTAB 1988), the Board held that the trademark in a U.S. application must be "materially the same" as, but not "identical" to, the trademark in the foreign registration forming the basis, under Section 44, of the U.S. application. The Board characterized this as a "narrow" construction of Section 44 to prevent the anomalous situation where a foreign national might register a trademark in the United States to which the applicant was not entitled in its country of origin. However, the drawing standard adopted is the same as the standard applied to the required correlation between the applied-for mark and the mark on the specimens in a use-based application.

Applicant also argues that any doubt regarding likelihood of confusion should not be resolved in favor of a registration based on Section 44 because of the inherent unfairness of permitting registration without a showing of use. There is absolutely no basis in law or precedent for this argument and we have not considered it further.

Therefore, we reject applicant's arguments pertaining to Section 44 and we have made our determination herein based on established trademark law and precedent, regardless of the Section 44 basis of the cited registration.

Applicant has also attacked the validity of the cited registration, alleging that the registrant of record is a

domestic corporation who improperly asserted Section 44 to obtain its registration; and that the owner of the cited registration impermissibly differs from the owner of the U.K. registration that formed the basis, under Section 44, of the registration in the United States. As the examining attorney correctly stated, the validity of the cited registration is not at issue in the context of this ex parte proceeding, which determines only the registrability of the mark in this application. Thus, applicant's arguments in this regard have not been considered. Rather, one proper forum for applicant's concerns about the validity of the cited registration is in the context of a cancellation proceeding.

Likelihood of Confusion

Turning now to the Section 2(d) refusal that is the basis for this appeal, we note that our determination 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. *See In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie*

Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 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); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

The Goods

We consider, first, the goods involved in this case, noting that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence may show the goods or services actually are.

Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Moreover, likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the

application, see *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). The Office need show only that at least one of the identified goods in the application is related to the goods identified in the cited registration. We will focus our comments on the issue of likelihood of confusion with respect to the goods in the cited registration shown in bold typeface above and repeated below, since these are the recited goods that are the most similar to those recited in the application:

"perfuming preparations for the atmosphere, namely sachets; potpourri; incense; perfume oils; scented oils, essential oils for domestic use," in International Class 3; and

"air freshening preparations, namely, air fresheners; air purifying preparations, namely air deodorizers; room air fresheners; preparations for perfuming or fragrancng the air, namely air deodorants; preparations for neutralizing odors in households, namely, air fresheners; deodorants for household use," in International Class 5.

The goods identified in the application are also repeated below:

"air fresheners, air deodorizer, car deodorizer, carpet deodorizer, household deodorizer, room deodorizer, room freshener, carpet fresheners and odor eliminators, all purpose disinfecting and deodorizing preparations, garbage disposer fresheners, odor neutralizing preparations for use on carpets, textiles, and in the air; aromatic preparations and substances for freshening the air; perfumed air freshening preparations; air purifying preparations," in International Class 5.

The examining attorney presented no evidence regarding the relationship between the goods, therefore we base our

finding on the plain meanings of the words used in the identifications of goods. Clearly, both the cited registration and the application include the identical goods, "air fresheners" and "air deodorizers." The remaining items listed in both identifications of goods in International Class 5 are closely related and expressly perform the similar and related functions of freshening, deodorizing and neutralizing the air and/or the smell of household items. The goods identified in International Class 3 of the cited registration are also related to applicant's identified goods because they are items that are used in freshening, deodorizing and neutralizing the air. In particular, applicant's goods are very similar to the "aromatic preparations and substances for freshening the air" and "perfumed air freshening preparations" identified in International Class 3 of the cited registration. Thus, we find that applicant's goods are the same as and/or closely related to those of registrant.

This *du Pont* factor weighs in favor of a finding of a likelihood of confusion.

Channels of Trade/Purchasers

Although some of the goods in both the application and the cited registration are limited to specific uses, there are no limitations on trade channels and, thus, we presume that the goods would be offered in all ordinary trade

channels for these goods and to all usual classes of purchasers, including consumers of each others' goods. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). In other words, the trade channels are the same or, at least, overlapping.

Regarding the buyers to whom sales are made, we note that because there are no restrictions in this regard in the identifications of goods, both applicant's and registrant's goods may be purchased by members of the general public, who will likely exercise only ordinary care in purchasing these common items.

These *du Pont* factors weigh in favor of a finding of likelihood of confusion.

The Marks

We consider, now, whether applicant's mark and the registered mark, when viewed in their entirety, are similar in terms of appearance, sound, connotation and commercial impression.

Applicant contends that the term FIRESIDE is merely descriptive in both marks in connection with the identified goods because it is recognized as a fragrance name that is commonly used in connection with the same and related goods. In this regard, applicant submitted excerpts from twenty-nine unrelated websites showing the use of the term "fireside" to identify a fragrance. Of these excerpts,

eight sites showed air fresheners or sprays with a "fireside" scent; seven sites showed essential oils and scents with a "fireside" fragrance; ten sites showed candles with a "fireside" scent; and four sites showed perfumes with a "fireside" fragrance. Examples of other fragrances listed on these sites include "peppermint," "allspice," "grass," "autumn," "green tea," "musk," "rose," "peach," and "seabreeze."

Applicant contends that, because of the descriptive significance of "fireside" in connection with its goods and those of registrant, it is a weak term in both marks; and that its mark is distinguishable from the registered mark by the differing second terms, i.e., "glow" in its mark versus "warmth" in the registered mark. Applicant argues that these are obvious differences visually and aurally and that the connotations differ in that "glow" suggests light, which is a quality that appeals to the sense of sight; whereas "warmth" appeals to the sense of feel.

The examining attorney contends that both marks are arbitrary. To establish this, he asks us to take judicial notice of the definitions of the terms "fireside," "glow," and "warmth," but makes no mention of the evidence submitted by applicant. We decline to take judicial notice and note that, regardless of the dictionary definition of "fireside," applicant has provided a substantial amount of evidence that

the term describes a fragrance in connection with applicant's and registrant's goods. Applicant does not dispute that "glow" and "warmth" are arbitrary terms in the context of the goods.

The examining attorney makes the following statement in the Office Action of April 9, 2009, and repeats these sentiments in his brief: "There is only one registered trademark with the term 'fireside' used in connection with air fresheners. It is irrelevant if every manufacturer in the industry uses the term 'fireside' to represent their air freshening scents if they have not registered a trademark for the same." The examining attorney's position is incorrect in so many ways. First, the cited registration is not evidence that the term "fireside" is in use in connection with the identified goods. On the other hand, the Internet website excerpts submitted by applicant are evidence that the term "fireside" is used as a scent name in connection with the same and related goods. This is strong evidence of its descriptive significance. Second, it is very relevant that numerous third-parties in the industry use the term "fireside" to describe a scent. It is precisely because of this evidence that we find "fireside" is merely descriptive, if not generic, of a scent for air fresheners and related goods. Finally, there is absolutely no requirement that a business register its trademark in

order to have legally enforceable rights in that mark. Additionally, a business cannot, in general, register a merely descriptive term.

Having found that "fireside" is a merely descriptive term in connection with the respectively identified goods, we now consider the marks in their entirety. Both are two-word marks that begin with the merely descriptive term "fireside." Both second terms, "glow" and "warmth" suggest features of a fire, as described by applicant. While neither term directly modifies the term "fireside" in the respective marks, both "glow" and "warmth" suggest different aspects of the experience of sitting at a fireside. At the same time, the terms "glow" and "warmth" have no significance in the context of the respectively identified goods in this case and, therefore, are clearly the dominant terms in the marks. Therefore, we find that applicant's mark, FIRESIDE GLOW, is sufficiently distinguished from the cited registered mark, FIRESIDE WARMTH, by the second term in each mark.

Conclusion

When we consider the record and the relevant likelihood of confusion factors, and all of applicant's arguments relating thereto, including those arguments not specifically addressed herein, we conclude that the weakness of the registered mark and differences between the two marks

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outweighs the similarities in the goods, trade channels and purchasers so that confusion as to source is unlikely.

Decision: The refusal under Section 2(d) of the Act is reversed.