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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bookriff Media Inc.

Serial No. 77537045

P. Jay Hines and Robyn S. Lederman of Cantor Colburn for Bookriff Media Inc.

Charles L. Jenkins Jr., Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Quinn, Ritchie and Lykos, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Bookriff Media Inc. filed an application to register the mark BOOKRIFF (in standard character form) for "electronic publications, namely, fiction and non-fiction books featuring a variety of topics for use by purchasers in the field of self book publishing" (in Class 16); and "book publishing, custom books publishing and online publishing of books; providing a web site featuring on-line publications in the nature of fiction and non-fiction books on a variety of topics; providing a web-based system and

online portal featuring online downloadable and non-downloadable software tools that enables users to access written and visual materials for building books online, to create, share and print custom books, and to make available their own written and visual materials for other users to purchase and use in building custom books" (in Class 41).¹

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 applied to applicant's goods and/or services, so resembles the previously registered marks RIF (in typed form) for "newsletters dealing with reading" (in Class 16),² and CLUB RIF (in typed form) for "publications, namely, books, guides and lesson plans for use in conducting comprehensive reading and literacy programs which pair teens as mentors with younger children (in Class 16), and for "educational services, namely, conducting comprehensive reading and literacy programs which pair teens as mentors with younger children" (in Class 41),³ as to be likely to cause confusion. Both registrations are owned by the same

¹ Application Serial No. 77537045, filed August 1, 2008, based on Canadian application no. 1383625 filed February 15, 2008; Canadian Registration No. TMA754832 issued December 8, 2009.

² Registration No. 1075006, issued October 11, 1977; renewed.

³ Registration No. 2791448, issued December 9, 2003; combined Sections 8 and 15 affidavit accepted and acknowledged.

entity.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.⁴

After briefing, the Board determined that the appeal was not ripe for a final decision and, accordingly, the Board, on June 6, 2011, suspended proceedings on the appeal and remanded the application to the examining attorney. More specifically, the Board remanded the application to the examining attorney for formal consideration of amended identifications of goods and services. On remand, the examining attorney, on July 15, 2011, accepted the amended identifications (as set forth above), but essentially maintained the final refusal under Section 2(d). The Board, on July 18, 2011, resumed the appeal.

Applicant argues that its mark BOOKRIFF is readily distinguishable from registrant's marks RIF and CLUB RIF. The following statements essentially sum up applicant's argument regarding the marks:

We know that the designation RIF in Registrant's marks stands for Reading Is Fundamental and relates to the reading and literacy programs that are

⁴ Applicant submitted, for the first time with its appeal brief, copies of the specimens from the file of the cited registration. The examining attorney, in his brief, neither objected to nor considered the evidence. Applicant's submission is untimely, and we have not considered this evidence in making our decision. Trademark Rule 2.142(d). See TBMP §§1207.01 and 1207.03 (3d ed. 2011).

the subject of Registrant's goods and services. We know that the designation RIFF in applicant's mark has no significance and that its goods and services have to do with self publishing. It is these differences that confer upon the marks different connotations and commercial impressions in the context of the goods and services identified. It follows that there is no reason for someone familiar with the Registrant's marks, upon encountering the Applicant's mark, to assume an affiliation, connection or association as to source.
(Brief, p. 5).

Applicant also points to the different meanings between "riff" and "rif." As to the goods and/or services, applicant states that they "are arguably related only by a tenuous connection to books and reading." (response, 2/18/09). Applicant goes on to contend that the focus of its business is building books online, that is, self publishing, whereas registrant is a non-profit addressing reading and literacy with programs that pair teens as mentors with younger children. Applicant specifically points to the limitations recited in its identifications of goods and services, namely that they involve self book publishing and custom book publishing; as well as to the limitations in registrant's identifications, namely that the goods and services involve reading and literacy programs which pair teens as mentors with younger children.

In support of its position applicant submitted third-party registrations of marks comprising, in part, either "RIF" or "RIFF" for goods in Class 16 and services in Class 41; and dictionary definitions for the terms "rif" and "riff."

The examining attorney maintains that the marks are similar, asserting that the "RIFF" or "RIF" portion of the respective marks is dominant. The examining attorney also states that the goods are related because entities that offer electronic publications also offer printed publications like newsletters and books. Also noteworthy, the examining attorney argues, is that applicant's books, identified as covering a "variety of topics," may feature content about reading and lesson plans for use in conducting comprehensive reading and literacy programs that pair teens as mentors with younger children. In support of the refusal the examining attorney submitted several third-party registrations showing that the same entity registered the same mark for both books and newsletters, as well as other registrations covering both electronic publications and printed publications.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d

1357, 177 USPQ 563 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first turn to compare the marks in their entirety as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test, under the first *du Pont* factor, is not whether the marks can be distinguished when 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 and/or services 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 than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Applicant submitted dictionary definitions of the word "riff": "an ostinato phrase (as in jazz) typically supporting a solo improvisation; a rapid energetic often improvised verbal outpouring, especially one that is part of a comic performance; a succinct usually witty comment; a distinct variation or take." (www.merriam-webster.com) As for "rif," applicant contends that it is the acronym of registrant's name, "Reading Is Fundamental." Applicant also points out that it means "the act of dismissing an employee" and "a coastal region in N. Morocco. (Webster's New World College Dictionary).

We find that applicant's mark BOOKRIFF and registrant's marks RIF and CLUB RIF are somewhat similar in sound and appearance. All of the marks include "RIFF" or "RIF" which are identical in sound, and very similar in appearance.

As to meaning, applicant's mark BOOKRIFF may convey the idea that its goods and services present a distinct variation or take on publishing books. This idea is not directly conveyed by either of registrant's marks, although it may be that "RIF" will be perceived as a shortened form of "RIFF," likewise conveying the meaning that registrant's goods and services offer a distinct variation or take relative to the similar services of others. Suffice it to

say, we put no credence in applicant's notion that "RIF" means "dismissing an employee" or a geographical area in Morocco. These meanings of "rif" have no relevancy when considered in the context to registrant's goods and services. Similarly, while it is likely that "RIF" in registrant's mark stands for registrant's name, "Reading Is Fundamental," there is nothing in the record to indicate that relevant consumers will even know this or likely perceive it as such.

As to overall commercial impression, we recognize the presence of "BOOK" in applicant's mark, and "CLUB" in one of registrant's marks, as well as the differences in spelling between "RIFF" and "RIF." Nevertheless, we find that the similarities between the marks outweigh the differences, and that the marks engender similar overall commercial impressions.

The similarities between applicant's mark BOOKRIFF and registrant's marks RIF and CLUB RIF weigh in favor of a finding of likelihood of confusion.

Applicant argues that the number of third-party registrations of RIFF or RIF marks shows that the cited mark is entitled to a relatively narrow scope of protection. In this connection, applicant introduced copies of four third-party registrations of marks

comprising, in part, the word "RIFF" for goods in Class 16 or services in Class 41. In addition, there are copies of four third-party applied-for marks comprising, in part, the word "RIFF" (or, in one instance, "RIF") for which the Office has issued a Notice of Allowance. It is applicant's position that the coexistence of these marks mandates the registration of applicant's mark.

This evidence is not persuasive. Although we have considered the four third-party registrations, they are of limited probative value to support applicant's position because "[t]he existence of [third-party] registrations is not evidence of what happens in the market place or that consumers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive." *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); and *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010). Moreover, the registrations pertain to goods and services in the field of music, different from the goods and services involved herein. See *In re Melville*, 18 USPQ2d 1386, 1388-89 (TTAB 1991) (registrations for goods and services unrelated to the goods and services at issue are irrelevant to the

likelihood of confusion analysis). With respect to the three third-party applications for which a Notice of Allowance has been issued, this evidence has no probative value except to show that the applications were filed. *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1264 (TTAB 2011); and *In re Binion*, 93 USPQ2d 1531, 1535 n.3 (TTAB 2009).

In sum, the existence of the third-party registrations is a factor that is neutral in the *du Pont* analysis.

We next turn to compare applicant's goods and services with registrant's goods and services. It is well settled that the goods and/or services need not be identical or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods and/or services are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or 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 & Telegraph Corp.*, 197 USPQ 910,

911 (TTAB 1978). The question of likelihood of confusion is determined based on the identification of goods and/or services in the application vis-à-vis the goods and/or services as set forth in the cited registration. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); and *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). The issue, of course, is not whether purchasers would confuse the goods and/or services, but rather whether there is a likelihood of confusion as to the source of the goods and/or services. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

The examining attorney's sole evidence bearing on the relatedness of the goods and/or services consists of several third-party registrations. "Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source." *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd*, 864 F.2d 149 (Fed. Cir. 1988). See also *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-

86 (TTAB 1993). The registrations show, not surprisingly, that the same entity has registered the same mark for both books and newsletters, or for publications, both in printed and electronic form. None of the registrations, however, appear to cover books or other publications being self-published by the user.

We find that the goods and services, as identified in the respective application and registrations, are distinctly different and noncompetitive. Each of the identifications contains limiting language, making any potential overlap less than likely. Applicant is essentially providing a web-based product that allows users to create customized books, either in print form or downloadable form, as well as online publishing services and ancillary online tools for facilitating the process of custom publication, whether in print or online. Thus, applicant's goods and services involve books and services about self publishing, whereas registrant's services involve reading and literacy with programs pairing teens as mentors with younger children.

The prospective customers for the goods and/or services would be different, with registrant's consumers seeking to create and publish their own books in print and online form, versus applicant's customers seeking reading

materials on literacy programs and educational/mentoring programs in the field of literacy.

The mere fact that applicant's and registrant's goods and services all fall under the broad category of books or related publication services is too tenuous a connection upon which to base a finding that they are sufficiently related for purposes of likelihood of confusion; we reiterate that the respective identifications include significant limitations regarding the specific nature of the goods and services. To demonstrate that the involved goods and/or services are related, it is not sufficient that a particular term (such as "book" or "publications") may be found which may broadly describe the goods and/or services. See *In re W.W. Henry Co.*, 82 USPQ2d 1213, 1215 (TTAB 2007). When we examine the involved identifications that include specific limitations, the goods and/or services do not appear to be related in a manner that would be likely to cause confusion.⁵

⁵ In saying this, we recognize that one of applicant's services is "providing a web site featuring on-line publications in the nature of fiction and non-fiction books on a variety of topics." We find it unreasonable to assume, as the examining attorney has done, that these publications would encompass ones of such extremely limited scope, as in the case of registrant's guides and lesson plans for use in conducting comprehensive reading and literacy programs which pair teens as mentors with younger children. To the extent that this situation could occur, we agree with applicant that the chances are very de minimis.

In view of the above, we find that the goods and services of applicant and registrant are sufficiently different so that, even when sold under similar marks, consumers in the marketplace are not likely to be confused.

Based on the record before us, we see the likelihood of confusion refusal as amounting to only a speculative, theoretical possibility. In view of the specific differences between the goods and/or services, as clearly delineated in the involved identifications, we find that the examining attorney, by submitting only the third-party registrations that cover various publications in the broadest of terms, has not met his burden of establishing that confusion is likely to occur, even when similar marks are involved. Language by our primary reviewing court is helpful in resolving the likelihood of confusion issue in this case:

We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 21 USPQ2d at 1391 (Fed. Cir. 1992), citing *Witco Chemical Co. v. Whitfield Chemical Co., Inc.*, 418 F.2d

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1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g* 153 USPQ
412 (TTAB 1967).

Decision: The refusal to register is reversed.