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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Phoenix Intangibles Holding Company

Serial Nos. 77732429, 77799403 and 77799400

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Before Walters, Holtzman and Zervas, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Phoenix Intangibles Holding Company has filed three
applications to register, respectively, the mark GIFTERGO in
standard characters¹ and the marks in the designs shown
below, with one design including the additional wording

¹ Serial No. 77732429, filed May 8, 2009, based on an allegation of a
bona fide intention to use the mark in commerce. ('429 application)

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GIANT EAGLE. All three applications seek registration on the Principal Register for "online retail store services featuring downloadable gift cards," in International Class 35.

Serial No. 77799403 ('403 application) (based on allegation of a bona fide intention to use the mark in commerce):

Description: The mark consists of the word "Gifter" in cursive-type font including four squares which form the dot above the letter "i" with the word "Go." A curved line, which appears under "GifterGo" is also shown. Color is not claimed as a feature of the mark.



Serial No. 77799400 ('400 application) (based on allegation of a bona fide intention to use the mark in commerce):

Description: The word "Gifter" is blue in cursive-type font including four squares in the color blue which form the dot above the letter "i" with the word "Go" printed in green. The "GIANT EAGLE" red shield is below a curved green line, which appears under "GifterGo". The words "GIANT EAGLE" appear in the color white.

Color Claim: The color(s) blue, green, red, and white are claimed as a feature of the mark.



The examining attorneys have issued final refusals to register in all three applications, under Section 2(d) of

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the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's marks so resemble the standard character mark GIFTANGO, previously registered for "service provider (*sic*), namely retail store featuring gifts, stored value cards, gift cards and gift certificates," in International Class 35,"² that, if used on or in connection with applicant's goods, the marks would be likely to cause confusion or mistake or to deceive.

Applicant has appealed the refusal in each application. Both applicant and the examining attorneys have filed briefs in each appeal.

Because of the similarity in the facts and issues presented in the refusals in each application, we have considered them together herein and we have issued a single decision pertaining to all three applications. Our decision takes into account the differences in the marks and the records among the applications.

Our determination under Section 2(d) 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*

² Registration No. 3249333, issued June 5, 2007, to Giftango Corporation.

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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, "[w]hile it must consider each factor for which it has evidence, the Board may focus its analysis on dispositive factors, such as similarity of the marks and relatedness of the goods." *Han Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001). See also *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1357, 192 USPQ 24 (CCPA 1976) ("[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"); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

The Services

Considering, first, the services involved in the cited registration and the three applications, we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's applications vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial*

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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).

In this case, registrant's services are "... retail store services ...," which encompass both brick-and-mortar stores and online stores, which are identified in the applications. Moreover, registrant's stores feature, *inter alia*, "gift cards," which encompass applicant's "downloadable gift cards." Thus, applicant's identified services are encompassed within registrant's identified services and, to this extent, are legally identical. It is immaterial that registrant's services also feature other goods for sale or that applicant limits its retail presence to online services and downloadable cards.³ "Likelihood of confusion may be found based on any item that comes within the identification of goods [or services] in the involved application and registration." *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008).

³ Applicant made reference for the first time in its brief to its and registrant's websites. No excerpts from these sites are of record. The examining attorney for Application Serial No. 77732429 objected to consideration of any reference to the websites because the information is untimely. We have not considered this information and discussion by applicant probative in any of the applications because, as discussed herein, our analysis is based on the identifications of services in the applications and registration. Moreover, applicant did not properly make copies of the websites of record in the applications. Applicant requests that we take judicial notice of the websites, which we decline to do as such matter is not appropriate for judicial notice.

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Further, to the extent that the services in the involved applications and the cited registration are identical, the channels of trade for applicant's online retail services are the same as those for the online portion of registrant's retail services. We also presume that these services will be offered to all usual classes of purchasers, including consumers of each other's services. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).

The Marks

Considering, next, the marks, we note that in determining likelihood of confusion, a lesser degree of similarity between marks is required when, as in this case, the marks are applied to services that are, in part, legally identical. *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd* 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990). See also *In re J.M. Originals*, 6 USPQ 1393 (TTAB 1987).

We evaluate the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041 (TTAB 1988).

The test 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 impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715 (TTAB 2008).

In support of its position that the cited registered mark is weak, in each application applicant submitted copies of the following active third-party registrations,⁴ all owned by different entities:

<u>Mark</u>	<u>Goods/services</u>	<u>Registration No.</u>	<u>Registration Date</u>
GIFTS TO GO	gift sets; disclaim gifts	2,747,119	August 5, 2003
GIFT CARDS TO GO	providing gift cards for others; disclaim gift cards	2,903,938	November 16, 2003
GRAB-N-GO GIFTS	retail and wholesale gift sets; disclaim gifts	2,851,955	June 8, 2004
GIFTS TO GO	organizing and conducting trade shows; disclaim gifts	2,700,129	March 25, 2003
FRAN'S GIFTS TO GO	catalog and online sales of candies, cakes, crackers etc.; disclaim gifts	3,390,683	March 4, 2008

Third-party registrations cannot assist applicant in registering a mark that is likely to cause confusion with a

⁴ Applicant submitted copies of two additional third-party registrations that are cancelled and, thus, of no evidentiary value. We have not considered these registrations.

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registered mark. *See AMF Incorporated v. American Leisure Products, Inc.*, 177 USPQ 268 (CCPA 1973).

Not only are these registrations of limited value as they are not evidence of use of the marks in commerce, but the registrations submitted are too few in number to persuade us that the cited registered mark is weak. Moreover, while the third-party marks include the words GIFT(S) and GO, the marks as well as the goods and services in these third-party registrations are varied. The two registrations identifying, respectively, trade show services and online sales of candies, cakes crackers, etc., are wholly unrelated to the services herein; and the relationship, if any, between applicant's and registrant's services and "gift sets," identified in two of the registrations, is unclear.

Turning to a comparison of applicant's marks to the mark GIFTANGO in the cited registration, we begin with the standard character mark GIFTERGO in the '429 application. We are reminded that the focus of our analysis is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See In re Association of the United States Army*, 85 USPQ2d 1264, 1269 (TTAB 2007); and *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, it is

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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).

Both marks begin and end with GIFT and GO, and the two words are separated in each mark by a two-letter syllable, AN and ER, respectively, and applicant has not offered any meaning for "er" or "gifter." Because GIFT and GO are actual words, consumers are likely to perceive both marks as the word GIFT separated by some letters from the word GO. As such, the general appearance of the marks is substantially similar. The fact that the syllables separating the words differ between the two marks is less likely to be remembered and consumers are likely to perceive GIFT and GO as the dominant portions in each mark. The fact that "an" in the registered mark may suggest "and," whereas "er" in the application has no apparent meaning is of little significance. Rather, the commercial impression of the marks is substantially similar.

The mark in the '403 application includes stylized script with four dots in a box shape over the "I," a wavy line under part of the mark and font that emphasizes the word GO in the mark. We do not find this design element to

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add anything sufficient to distinguish applicant's mark from the cited registered mark in the recollection of relevant purchasers. Further, the darker font used for the word GO in applicant's mark merely emphasizes a portion of this mark that is identical to the same portion in the registered mark.

The mark in the '400 application adds color and the house mark GIANT EAGLE in a red box to the mark in the '403 application. The contrasting color between GIFTER and GO serves primarily to emphasize and distinguish the word GO which is, again, identical to the same portion in the registered mark. The house mark appears in much smaller font below the term GIFTERGO and, as such, is unlikely to serve to distinguish the marks in any way. As a general rule, the mere addition of a trade name, house mark or the like to one of two otherwise confusingly similar marks will not serve to avoid confusion between them. *See In re Champion Oil Co.*, 1 USPQ2d 1920 (TTAB 1986); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) and cases cited therein. Here, the differences between GIFTANGO and the GIFTERGO portion of applicant's mark are so slight that the addition of applicant's GOLDEN EAGLE mark does not overcome the similarity of the marks. *See In re C.F. Hathaway Co.*, 190 USPQ 343 (TTAB 1976) (HATHAWAY GOLF CLASSIC for knitted sports shirts confusingly similar to GOLF CLASSIC for men's

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hats). In fact, when, as in this case, marks are otherwise substantially similar, the addition of a house mark is more likely to add to the likelihood of confusion than to distinguish the marks; it is likely that the two products sold under such marks would be attributed to the same source. *In re Dennison Mfg. Co.*, 229 USPQ 141, 144 (TTAB 1986) (holding GLUE STIC for general purpose adhesive in stick form likely to be confused with UHU GLU STIC for adhesives for paper and stationery); *Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co.*, 216 USPQ 168, 170 (TTAB 1982) (holding SKIN SAVERS for face and throat lotion likely to be confused with MENNEN SKIN SAVER for hand and body lotion). See also *Hammermill Paper Co. v. Gulf States Paper Corp.*, 337 F.2d 662, 663, 143 USPQ 237, 238 (C.C.P.A. 1964) (holding HAMMERMILL E-Z CARRY PAK and E-Z PAPER PAK for carrying cases or boxes for typewriter or duplicator paper likely to be confused with E-Z PAK and E-Z CARI for paper bags); TMEP §1207.01(b)(iii).

In 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 in view of the substantial similarity in the commercial impressions of applicant's mark GIFTERGO in standard characters and with variations in each of its three

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applications, and registrant's mark, GIFTANGO, their contemporaneous use on the same services involved in this case is likely to cause confusion as to the source or sponsorship of such services.

To the extent that any doubts might exist as to the correctness of our likelihood of confusion conclusion, we resolve such doubts against applicant. See *Century 21 Real Estate Corp.*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992); *Ava Enterprises Inc. v. Audio Boss USA Inc.*, 77 USPQ2d 1783 (TTAB 2006); and *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844 (TTAB 2004).

Decision: The refusal under Section 2(d) of the Act is affirmed in each application.