

This Opinion is not a
Precedent of the TTAB

Mailed: July 15 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Romantic Tours, Inc.

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Serial No. 77908876

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Joseph J. Weissman of Johnson, Pope, Bokor, Ruppel & Burns, LLP for Romantic
Tours, Inc.

Tejbir Singh, Trademark Examining Attorney, Law Office 106,
Mary I. Sparrow, Managing Attorney.

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Before Seeherman, Ritchie and Adlin,
Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Romantic Tours, Inc. (“Applicant”) has appealed the Trademark Examining
Attorney’s refusal of registration of the mark BLACK BOOK in standard characters
for “providing on-line non-downloadable software for keeping track of online
companions and organizing online communications, correspondence history, events,
profiles and preferences in the field of online relationships and dating” in Class 42.¹

¹ Application Serial No. 77908876, filed January 11, 2010, based on Section 1(a) of the
Trademark Act, 15 U.S.C. § 1051(a), and asserting first use and first use in commerce at
least as early as May 24, 2004.

Registration was refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the mark XXXBLACKBOOK in standard characters for services in Classes 38 and 42, listed below, that as used in connection with Applicant's identified services it is likely to cause confusion or mistake or to deceive:

Chat room services for social networking; telecommunication services, namely, transmission of webcasts; providing on-line chat rooms for transmission of messages and photographs among computer users interested in meeting other people concerning personal relationship issues; electronic transmission of messages and images relating to dating; providing email services, namely, providing access to email boxes on a dating website; electronic transmission of mail and user-provided information, personal profiles and information via the Internet; instant messaging services via the Internet; electronic transmission of information and sound and video clips; providing on-line forums for transmission of messages among computer users; chat room services for social networking; providing on-line electronic bulletin boards for transmission of messages among computer users concerning personal relationship issues (Class 38); and

Hosting online websites for others for organizing and conducting online meetings, gatherings and interactive discussions (Class 42).²

We affirm the refusal to register.

I. Preliminary Matters

With its appeal brief Applicant submitted 28 pages of evidence, consisting of exhibits that Applicant asserts it previously submitted during prosecution of the

² Registration No. 4051248, issued November 8, 2011. The registration also includes services in Classes 35, 41 and 45 which are not the basis for the refusal.

During the course of examination, the Examining Attorney also refused registration on the bases of two additional registrations, Registration No. 3926282 for Blackbook27 and Registration No. 4065116 for BLACKBOOK 27 in stylized form, both for "Internet based introduction and social networking services," and both owned by the same party. He later withdrew the refusals based on these registrations.

application. The Board strongly discourages resubmitting evidence that is already of record; the Board considers all evidence that is properly of record. In addition to adding to the bulk of the file, ascertaining whether exhibits to a brief are properly of record wastes the Board's time. *In re Lorillard Licensing Co.*, 99 USPQ2d 1312, 1315 (TTAB 2011); *In re SL&E Training Stable Inc.*, 88 USPQ2d 1216, 1220 n.9 (TTAB 2008) (attaching as exhibits to brief material already of record requires Board to determine whether attachments had been properly made of record and adds to the bulk of the file); *In re Thor Tech Inc.*, 85 USPQ2d 1474, 1475 n.3 (TTAB 2007) (attaching evidence from record to briefs is duplicative and is unnecessary). Accordingly, we have not separately reviewed the exhibits to Applicant's brief; to the extent that copies of the exhibits were properly made of record, we have considered them.

With his appeal brief the Examining Attorney has included a definition of XXX, and asks that we take judicial notice of it. As Applicant correctly points out, this definition was not made of record. However, the Board may take judicial notice of dictionary definitions, *see University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). We therefore grant the Examining Attorney's request, although we add that the probative value of this definition, which states that XXX is the Roman numeral for 30, is very limited.

II. Statutory Refusal

The only ground for refusal is likelihood of confusion. Our determination of this issue 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, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also, In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In fact, both Applicant and the Examining Attorney have concentrated their arguments on these two factors, with Applicant including, as a subset of its comments regarding the similarity of the marks, that the cited mark is “relatively weak.” Brief, 9 TTABVUE 10.

We turn first to the *du Pont* factor of the similarity or dissimilarity and nature of the services. It is not necessary that the services be similar or even competitive to support a finding of likelihood of confusion. Instead, likelihood of confusion can be found if the respective services “are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.” *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012), quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007). We consider

the services as they are described in Applicant's application and the cited registration. *du Pont*, 177 USPQ at 567.

Applicant's services are identified as "providing on-line non-downloadable software for keeping track of online companions and organizing online communications, correspondence history, events, profiles and preferences in the field of online relationships and dating" in Class 42. The Class 42 services in the cited registration are "hosting online websites for others for organizing and conducting online meetings, gatherings and interactive discussions," while the most relevant of the Class 38 services are "providing on-line chat rooms for transmission of messages and photographs among computer users interested in meeting other people concerning personal relationship issues"; "electronic transmission of messages and images relating to dating" and "providing on-line electronic bulletin boards for transmission of messages among computer users concerning personal relationship issues."

Applicant characterizes its services as "providing non-downloadable software for maintaining specified records," while it contends that the cited registration is for "dating services and actual communications seemingly related to online adult dating, sex and/or pornography." Brief, 9 TTABVUE 14 (emphasis in original). Neither characterization is correct. Applicant's services, as shown by the identification, are not just providing software for "maintaining specified records"; the software it provides is for organizing information, communications, etc. "*in the field of online relationships and dating.*" The Registrant's Class 38 services that we

have listed above are specifically for “computer users interested in meeting other people concerning personal relationship issues,” “transmission of messages and images relating to dating” and “transmission of messages among computer users concerning personal relationship issues.” Thus, both Applicant’s and the Registrant’s services, as identified, are in the field of online relationships and dating, and are directed to computer users, since Applicant’s services are identified as being on-line services.

Applicant would also have us restrict the Registrant’s services to “adult” dating, sex or pornography, because the Registrant’s services in Class 45 are identified as “online adult dating.” However, the Registrant’s services in Classes 38 and 42 have no such limitation, and we cannot read such a limitation into these identifications. A multiple-class application/registration may be viewed as a group of applications/registrations of one mark in connection with goods or services in particular classes, all combined into one application/registration. *See* TMEP § 1403. *See also, In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224, 1226 (TTAB 1987) (noting multiple-class application for goods and services is essentially two separate applications combined for convenience of applicant and USPTO); *Electro-Coatings, Inc. v. Precision National Corp.*, 204 USPQ 410, 420 (TTAB 1979) (“there are, in law, three applications and three oppositions to be adjudicated, because each class in a multiple class application constitutes a separate case.”). Thus, in considering the services, we must treat the Registrant’s Class 38 services as encompassing personal relationships and dating in general; in other words, they are basically in

the same field as Applicant's online relationship and dating services. As for the Registrant's Class 42 services, they are more generally described as "hosting online websites for others for organizing and conducting online meetings, gatherings and interactive discussions," without any restriction as to the subject of such meetings, gatherings and discussions. This broad identification of services therefore encompasses online relationships and dating, since those topics could certainly be the subject of a meeting, gathering or discussion.

We also point out that Applicant's services, as identified, could be in the field of online "adult" dating. In this connection, we note that Applicant's specimen shows use of the mark for what might be considered dating of an "adult" nature.³ The website is called "Hot Russian Brides," and advertises online chatting with "Beautiful Russian Women," some of whose attributes (age, height and weight) are listed.

Based on the identifications as written, we find that the services are related, in that they have the same subject matter (dating/personal relationships) and the same consumers, i.e. computer users who are interested in online dating/relationships. Applicant's services of providing non-downloadable software for keeping track of online companions, etc. for online relationships and dating would certainly be complementary to the Registrant's services of transmitting messages relating to dating, providing an on-line chat room for transmission of such

³ Applicant uses "adult" in the same manner as Registrant uses the word in its Class 45 identification of "online adult dating" or in the phrase "adult entertainment." We use it for the same meaning in our opinion.

messages, and the like. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ1289, 1290 (Fed. Cir. 1984) (complementary use [of products that are used together] has long been recognized as a relevant consideration in determining a likelihood of confusion).

Further, the Examining Attorney has submitted evidence from third-party websites showing that entities that provide online dating services also provide ancillary services similar to those of both Applicant and Registrant. For example, the website for match.com states that it is an online dating provider that hosts web sites, and makes it possible for “members” to see photos and read about potential matches in their area, with communications between members going through an “anonymous” email network.⁴ It also has a dating app that allows the customer to “browse profiles, upload photos and exchange emails anywhere,” and to “see who’s peeked at your profile” and “check out who likes your photos.”⁵ The website for OKCupid Dating shows that this dating site has a dating app that gives access to “Messages, Visitors, and Matches” and can be used on a “hand computer.”⁶ The website for Zoosk claims it has the “#1 Dating App” that allows one to chat with local singles, message singles, scan and show interest in other local singles and use unlimited chat to get to know other local singles better.⁷ Zoosk states that its Messenger app allows customers to text and video chat, and Zoosk helps with

⁴ November 7, 2013 Office action, p. 13.

⁵ May 23, 2014 Office action, pp. 4-5.

⁶ *Id.* at 2-3.

⁷ *Id.* at 7-8.

“Relationship Needs,” telling customers “what you need in a relationship, where you screwed up (without knowing it) in past relationships and a customized action plan to make your next relationship successful.”⁸ And the play.google.com apps store site featuring POF (Plenty of Fish) online dating states that POF is the world’s largest dating site, and customers can “chat, flirt, and exchange messages with local singles....” It also says the POF app allows one to, *inter alia*, send and receive messages, and operates a forum by which people can post on such topics as “Relationship Issues,” “Dating Over 30” and “Ask a Guy.”⁹

This evidence shows that online dating companies offer apps for consumers to communicate with other singles, to be in chat rooms, and to discuss relationship and dating issues. Although Applicant’s software is designed to keep track of online companions and organize online communications, etc., the function of the software is so similar to the services that the Registrant provides, and the services associated with dating sites in general, that consumers are likely to believe that such software comes from the same source as the Registrant’s identified Class 38 and 42 services if they were offered under similar marks. We understand Applicant’s argument that its software is not downloadable, and the evidence of third-party use relates to a great extent to downloadable apps, but we think it unlikely that consumers would believe the services come from different sources merely because some software is downloadable and other software offered under a similar mark is non-downloadable.

⁸ *Id.* at 24, 27.

⁹ *Id.* at 10-11, 28.

We find that Applicant's and the Registrant's identified services are closely related, and that the *du Pont* factor of the similarity of the services favors a finding of likelihood of confusion.

The trade channels for and classes of consumers of the services overlap, as they are offered to computer users for use in connection with online dating. This *du Pont* factor favors a finding of likelihood of confusion, as does the conditions of purchase factor. These services are offered to the public at large, who would not be expected to be particularly knowledgeable or have a sophistication about such services.

We now turn to the factor of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. There are clear similarities in the marks, as both contain the term BLACK BOOK. The fact that there is a space between BLACK and BOOK in Applicant's mark, and the words are run together in the Registrant's mark, does not serve to distinguish them. *See Seaguard Corp. v. Seaward Int'l, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (SEAGUARD and SEAGUARD are "essentially identical"); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827 (TTAB 1984) (BEEFMASTER and BEEF MASTER "practically identical"). The Registrant's mark would readily be understood to be composed of the elements XXX, BLACK, BOOK. Indeed, the only difference in the marks is that the cited mark also contains the element XXX. There has been much discussion as to what meaning XXX conveys for these services, with Applicant asserting that it represents pornography, noting an entry for "Pornography" in Wikipedia in which a representation of XXX has the caption, "The XXX symbol used

to designate pornographic material in the U.S. and other regions around the world,” and an entry for “.xxx” in which it is described as “a sponsored top-level domain (sTLD) intended as a voluntary option for pornographic sites on the Internet.”¹⁰ The Examining Attorney, on the other hand, has submitted a listing for “XXX” from InternetSlang.com stating that it means “kisses”¹¹ and the aforementioned Roman numeral for “thirty.”

It seems unlikely to us that, simply because XXX is the Roman numeral for thirty, consumers will view it as such when used in the cited mark. We also are not persuaded that XXX as used in the cited mark would clearly be understood as “kisses.” The only evidence for this meaning of XXX is from a website called “InternetSlang.com.” It appears from the single page submitted by the Examining Attorney that this website attempts to provide meanings for abbreviations used in online messaging, and to provide “trending Slang, Words and Acronyms.” To the extent that XXX means “kisses,” we agree with Applicant that it is more likely to be used at the end of a message, rather than the manner in which it is used in the Registrant’s mark.

We do accept that, in the context of these services, XXX can mean “pornography,” and that consumers would understand the term to have this meaning. In this connection, we note the evidence submitted with the December 19, 2014 Office action that “dating sites” can involve pornography, and are advertised as having pornographic activities as a central feature. *See, e.g.,* ,

¹⁰ November 24, 2014 request for reconsideration, pp. 7-13.

¹¹ December 19, 2014 Office action, p. 2.

www.liveporndating.com, which has the heading “Join Live Porn Dating And Get All The Fun Of Porn With Dating”;¹² PornDating Site, www.porndatingsite.com;¹³ and Adult Friend Finder, which advertises itself as “The World’s Largest Sex Dating Site & Swinger Personals Community,” with a magazine “where you’ll find sex advice, adult information, and steamy erotica submitted by other AdultFriendFinder members.”¹⁴

As a result, the XXX portion of the Registrant’s mark has a descriptive connotation, and thus we cannot agree with Applicant’s position that XXX is the dominant portion of the cited mark. Typically, descriptive portions of a mark are entitled to less weight in the likelihood of confusion analysis. “That a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark.” *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

As for BLACK BOOK, Applicant has submitted several definitions relating to “black book”:

little black book: a book containing the names and addresses of acquaintances who are potential dates, usually put together by men. : *Am I in your little black book, or can you already tell that I wouldn’t go out with you?*¹⁵

Little black book: A related term [to Address book] that has entered the popular lexicon is **little black book** (or simply **black book**). Such

¹² p. 7.

¹³ *Id.* at 9.

¹⁴ *Id.* at 14-23.

¹⁵ Dictionary of American Slang and Colloquial Expressions (2007), reported in dictionary.com. Response filed May 7, 2014, p. 9.

books are used as dating guides, listing people who the owner has dated in the past or hopes to in the future, and details of their various relationships. More explicit variations are guides for sexual partners. It is unclear how prevalent this is in practice or when it originated, though such books have been mentioned in many pieces of popular culture. For example, the 1953 film version of *Kiss Me, Kate* features a musical scene in which Howard Keel's character laments the loss of the social life he enjoyed before marriage, naming numerous female romantic encounters while perusing a miniature black book. More recently, the mid-2000 Guinness Brewmasters advertising campaign features the "little black book" as an invention of one of the brewmasters.¹⁶

black book: A book kept by a single man, containing a list of women whom he calls occasionally for a social date;--usually used in the phrase little black book.¹⁷

These definitions show that BLACK BOOK is usually used as part of the phrase LITTLE BLACK BOOK, and that LITTLE BLACK BOOK is a term used in connection with dating, namely a notebook in which one keeps information about potential and past dates. Even if we accept that BLACK BOOK *per se* can have this meaning, it has only a slightly suggestive connotation for services related to dating, including online dating. We cannot agree with Applicant's position that BLACK BOOK is highly suggestive of either the Registrant's or Applicant's services. A series of mental steps must be taken to go from "black book" as a term for a notebook in which men write down the names and phone numbers of women they dated or are interested in dating to, in the Registrant's case, hosting online websites so that people can engage in gatherings and discussion and online chat rooms for

¹⁶ The Free Dictionary, reported in <http://encyclopedia.thefreedictionary.com>, *Id.* at 11.

¹⁷ *The American Heritage Dictionary of the English Language*, 4th ed, reported in www.wordlink.com. *Id.* at 12. The same definition appears in the Collaborative International Dictionary of English, reported in [Online Dictionary, Datasement.com](http://OnlineDictionary.com). *Id.* at 13.

computer users interested in meeting other people concerning personal relationships, etc., and in Applicant's case, to software that organizes online communications and the like in the field of dating.

Applicant also points to four third-party registrations for marks that contain the term BLACK BOOK. Registration No. 4013916 is for JANIS SPINDELS VIRTUAL BLACK BOOK for dating and matchmaking services; No. 3476068 for MATT'S LITTLE BLACK BOOK for, *inter alia*, matchmaking services; and the two registrations owned by the same entity, No. 3926282 BLACKBOOK 27 and No. 4065116 for BLACKBOOK 27 in stylized form, both for Internet based introduction and social networking services. (As previously noted, the latter two were originally cited against Applicant's application.) There is no evidence of use of these registrations and, in fact, the registration for MATT'S LITTLE BLACK BOOK has been cancelled pursuant to Section 8. Third-party registrations are entitled to little weight on the question of likelihood of confusion where there is no evidence of actual use, although they may be given some weight to show the meaning of a mark in the same way that dictionaries are used. *Id.* While the third-party registrations alone, because of their limited number and lack of evidence of actual use, would have no probative value in establishing commercial weakness, in view of the dictionary definitions we can consider them as giving some support for the suggestive meaning of BLACK BOOK.

Applicant has also submitted some evidence of third-party use of "black book." The first has the heading "black book chat," and is a printout from

www.blackbookchat.com. The webpage has the subheadings “APPS, SIGN UP, CHAT, WHO IS ONLINE?, BROWSE and SEARCH, but otherwise the page is basically blank.¹⁸ We cannot ascertain anything from this evidence in terms of whether a mark is even in use, let alone to ascertain the goods or services. The second use is from a company called Rusty Brick, Inc., with the logo RB and design, advertising an iPhone application called Little Black Book.¹⁹ There is no information as to the cost, or the number of sales, if any. Further, although it is described as an app that would allow the user to keep track of dates, there is no indication that it would be connected to online dating or ancillary services for online dating. There are two third-party listings for “black book” in connection with the title of a book: “The Player’s Black Book,” described as containing “my favorite pick-up techniques...,”²⁰ and “The Little Black Book of Dating Secrets,” described as “A complete, powerful, easy to follow guide to dating....”²¹ Such uses as titles are not considered to be trademark use. *See Herbko Int’l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *In re Cooper*, 254 F.2d 611, 117 USPQ 396 (CCPA 1958). Finally, there are webpages from www.blackbookdirectory.com/au, which appear to be advertising a “high class Sydney escort.”²² Even if we were to regard the listing of Blackbook Directory as trademark use, third-party use of a mark in Australia would not be relevant to the

¹⁸ Response filed May 7, 2014, pp. 15-16.

¹⁹ *Id.* at 17.

²⁰ *Id.* at 18.

²¹ *Id.* at 23-27.

²² *Id.* at 19-22.

sixth *du Pont* factor, the number and nature of similar marks in use on similar services). In short, there is not sufficient evidence of actual third-party use in the United States of BLACK BOOK marks for similar services for us to conclude that consumers would look to other elements in the marks to distinguish one BLACK BOOK mark from another. We consider the sixth *du Pont* factor to be neutral.

This is not to say that the cited mark XXXBLACKBOOK is a strong mark. As noted above, BLACK BOOK is somewhat suggestive for dating and ancillary services. However, as the Examining Attorney points out, suggestive marks are still entitled to protection. In the present case BLACK BOOK in both marks conveys the same suggestive meaning. When the marks are considered in their entirety, and despite the fact that the cited mark includes the term XXX and Applicant's mark does not, overall the similarities in the marks outweigh the differences. The *du Pont* factor of the similarity of the marks favors a finding of likelihood of confusion.

Accordingly, we find that Applicant's mark for its identified services is likely to cause confusion with the mark and the Class 38 and 42 services in the cited registration.

Decision: The refusal to register Applicant's mark BLACK BOOK is affirmed.