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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Delta Dental of California

Serial No. 77921755

John C. Baum and Kathleen E. Letourneau of Owen, Wickersham & Erickson for Delta Dental of California.

Seth A. Rappaport, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Quinn, Grendel and Taylor,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Delta Dental of California filed, on January 27, 2010, an application to register the mark MY SMILEKIDS (in standard characters) for "providing a website featuring information in the field of dental care; providing information in the field of dental care."¹

¹ Applicant claims first use anywhere and first use in commerce on January 22, 2010. Applicant claims ownership of Registration No. 2823405 of the mark SMILEKIDS (in standard characters) for "providing a web site concerning dental care and distributing information relating thereto."

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 used in connection with applicant's services, so resembles the previously registered mark MYSMILE for "providing health information"² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. Applicant requested an oral hearing, but subsequently withdrew the request.

Applicant argues that the examining attorney "ignored the integrity of unitary elements in each mark - by dividing up the coined composites 'SMILEKIDS' and 'MYSMILE' - and disregarded the connotative differences between the marks owing to the fact that [applicant's] MY SMILEKIDS mark refers directly to [applicant's] long-standing incontestable registration for SMILEKIDS (Reg. No. 2,823,405) for the same services. [Applicant's] SMILEKIDS registration has subsisted on the Register for more than eight years." (Brief, p. 1). Further, applicant contends that the common elements of the marks (MY and SMILE) are weak, that the dissimilar commercial impressions engendered

² Registration No. 2849640, issued June 1, 2004; combined Sections 8 and 15 affidavit accepted and acknowledged.

by the marks are so significant that consumers will likely be able to distinguish the marks, and that the coexistence of applicant's prior registered mark with the cited mark is probative to show that there is no realistic likelihood of confusion. It is applicant's position that the common pronoun MY should be discounted in comparing the marks because, in marks such as applicant's where it precedes an existing brand name, it serves as a conventional means to connote a user-defined service and thus has a limited source identifying function. Applicant also points to the common use of SMILE by other registrants in the dental field. In support of its arguments, applicant submitted dictionary listings of the term "my"; a printout of its registered mark; and copies of seven third-party registrations of marks beginning with "MY", and ten third-party registrations of marks that include the term "SMILE," all for dental-related services.³

³ Applicant also submitted for the first time with its appeal brief excerpts of four third-party websites showing use of "my smile" in connection with dental information services. The examining attorney objected to consideration of this evidence due to its untimely submission. The objection is sustained in view of Trademark Rule 2.142(d) providing that the record in an application should be complete prior to the filing of an appeal, and that the Board ordinarily will not consider additional evidence submitted after the appeal is filed. See TBMP §1207.01 (3d ed. 2011). In any event, even if considered, this evidence would not result in a different decision on the merits.

The examining attorney maintains that the marks MYSMILE and MY SMILEKIDS are similar, with the KIDS portion of applicant's mark being relegated to a subordinate source-identifying role due to its descriptiveness of the intended audience for the services. Also, according to the examining attorney, the services are closely related. As to applicant's ownership of a prior registration, the examining attorney accords little relevance to this fact. The examining attorney also discounts the absence of actual confusion. In support of the refusal, the examining attorney introduced third-party registrations and excerpts of third-party websites to show that the provision of both health and dental information may emanate from the same source.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). 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. Ft. Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first turn to compare the services. Applicant does not seriously dispute that the involved services are related; rather it implicitly concedes the point. (Brief, pp. 18-19). According to applicant, it operates "a [user-defined] website where their children can learn about dental health in a fun way, with stories, games and tips." (Brief, p. 17). It is not necessary that the respective services be identical or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective services are related in some manner, and/or that the conditions and activities surrounding the marketing of the 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 originated from the same producer. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991). The issue is not whether consumers would confuse the services themselves, but rather whether they would be confused as to the source of the services.

We make our comparison of the services, including between the respective channels of trade and classes of purchasers, based on the services as they are identified in the application and the cited registration. *In re Giovanni*

Food Co., 97 USPQ2d 1990, 1991 (TTAB 2011). If the cited registration describes the services broadly, and there is no limitation as to their nature, type, channels of trade, or class of purchasers, it is presumed that the registration encompasses all services of the type described, that they move in all normal channels of trade, and that they are available to all classes of purchasers. See, e.g., *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638 (TTAB 1990) ("We have no authority to read any restrictions or limitations into the registrant's description of goods."). Accordingly, if the cited registration has a broad identification of services, an applicant does not necessarily avoid a likelihood of confusion merely by more narrowly identifying its related services. See, e.g., *In re Diet Center, Inc.*, 4 USPQ2d 1975 (TTAB 1987) (noting that, although applicant had limited its identification to indicate that its goods were sold only through franchised outlets offering weight-reduction services, the cited registration's identification contained no limitations as to trade channels or classes of customers and thus it must be presumed that registrant's goods travel through all the ordinary channels of trade).

In the present case, registrant's recitation of services broadly reads "providing health information,"

while applicant's services are recited a bit more specifically as "providing a website featuring information in the field of dental care; providing information in the field of dental care." Because of the broad language in registrant's recitation, registrant's services are presumed to encompass the provision of all types of health information, including information pertaining to dental care. Further, registrant's services, as worded in the recitation, would include providing such information by way of a website. When the services are compared in this manner, as they must for purposes of our likelihood of confusion analysis, the services are legally identical or otherwise closely related. In view thereof, the trade channels and purchasers are presumed to be identical.

Lest there be any doubt about this *du Pont* factor, the examining attorney submitted third-party registrations, each showing a single registered mark for services of providing health and dental information. Given that dental wellness is part of an individual's overall health, this fact comes as no surprise. "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 legal identity between the services, trade channels and purchasers are factors that weigh heavily in favor of finding a likelihood of confusion between the two marks.

As for the marks, we examine the similarities and dissimilarities between applicant's mark MY SMILEKIDS and registrant's mark MYSMILE in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (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 services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who

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normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Where, as in the present case, the marks appear in connection with legally identical services, the degree of similarity between the marks that is necessary to support a finding of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applicant's mark MY SMILEKIDS and registrant's mark MYSMILE are similar in sound and appearance; the first three syllables (comprising two words) of applicant's mark are identical to the entirety of registrant's mark. *See Loreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438-39 (TTAB 2012) (it is often the first part which is likely to be impressed upon the mind of a purchaser and remembered). The absence or presence of a space between MY and SMILE in the respective marks is not a factor in distinguishing the two marks. *See, e.g., Stockpot, Inc. v. Stock Pot Restaurant, Inc.*, 220 USPQ 52, 54 (TTAB 1983), *aff'd*, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) ("There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The words are phonetically identical and visually almost identical."); and *In re Best Western*

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Family Steak House, Inc., 222 USPQ 827, 827 (TTAB 1984)

("There can be little doubt that the marks [BEEFMASTER and BEEF MASTER] are practically identical.").

In terms of connotation, we recognize that the presence of the term KIDS in applicant's mark conveys the meaning that applicant's dental information features information about children. This idea is absent from the cited mark.

We believe, however, that the similarities between the marks outweigh any differences, and that the differences will not have any meaningful impact on the overall commercial impressions of the marks. Rather, we find that the marks engender similar overall commercial impressions. Even those who notice the differences will not ascribe them to differences in the source of the services, but will see the marks as variations of each other, pointing to a single source. That is to say, consumers familiar with registrant's services rendered under its mark MYSMILE will assume that registrant has extended its line of providing health information services to include providing dental information about children under the mark MY SMILEKIDS.

The similarity between the marks MYSMILE and MY SMILEKIDS is a factor that weighs in favor of a finding of likelihood of confusion.

In considering the marks, we have taken into account the third-party registrations relied upon by applicant in an attempt to diminish the distinctiveness of registrant's mark. The registrations are not evidence of use of the marks or proof that consumers are familiar with such marks as to be so accustomed to the existence of similar marks in the marketplace that they can distinguish between them based on small differences. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982). In any event, even if we were to find, as applicant urges, that registrant's mark is weak and entitled to a narrow scope of protection, the scope is still broad enough to prevent the registration of a similar mark for legally identical services. See *In re Farah Mfg. Co., Inc.*, 435 F.2d 594, 168 USPQ 277, 278 (CCPA 1971).

Applicant's argument based on its ownership of Registration No. 2823405 of SMILEKIDS for "providing a web site concerning dental care and distributing information relating thereto" is of little relevance to our likelihood of confusion analysis in this case. The focus of the analysis in this case must be on the mark applicant seeks to register, MY SMILEKIDS, and not on the other mark applicant already registered. See *In re Cynosure Inc.*, 90

USPQ2d 1644, 1645 (TTAB 2009). In saying this, we recognize that applicant has not couched its argument in terms of a family of marks, but rather that through use over eight years "the SMILEKIDS component of applicant's MY SMILEKIDS mark has become a well-recognized source identifier among consumers" (Brief, p. 1), and that "consumers will interpret the possessive pronoun 'MY' as a modifier to the name of a distinct service, SMILEKIDS." (Reply Brief, p. 7). There is no evidence of record to suggest that prospective consumers of applicant's services under the mark MY SMILEKIDS will even be aware of applicant's mark SMILEKIDS. Nevertheless, we remain of the opinion that the use of MY in applicant's mark enhances the likelihood of confusion with the cited mark MYSMILE rather than detracts from it. *See In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004).

The absence of actual confusion evidence is not troubling. *See In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) ("uncorroborated statements of no known instances of actual confusion are of little evidentiary value"). *See also In re Bisset-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of applicant's corporate president's unawareness of instances

of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). In any event, the lack of evidence of actual confusion carries little weight, *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965), especially in an *ex parte* context. Moreover, applicant only began use of its mark in January 2010; thus, there has been a minimal period of contemporaneous use of the marks. The record is devoid of probative evidence relating to the specific extent of use of registrant's and applicant's registered marks and, thus, whether there have been meaningful opportunities for instances of actual confusion to have occurred in the marketplace. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000); and *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Further, the coexistence of applicant's prior registration with the cited registration is entitled to little weight; as we noted earlier, the addition of MY in the applied-for mark brings it closer to the cited mark. Accordingly, the *du Pont* factor of the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion is considered neutral.

Based on the record before us, we conclude that consumers familiar with registrant's "providing health information" rendered under the mark MYSMILE would be likely to mistakenly believe, upon encountering applicant's mark MY SMILEKIDS for "providing a website featuring information in the field of dental care; providing information in the field of dental care," that the services originated from or are associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.