

Hearing:
June 26, 2008

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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July 31, 2008
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Vast Resources, Inc., dba Topco Sales

Serial No. 78692514

Jay H. Geller for Vast Resources, Inc., dba Topco Sales.

Colleen Kearney, Trademark Examining Attorney, Law Office 113
(Odette Bonnet, Managing Attorney).

Before Hairston, Bucher and Walsh, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Vast Resources, Inc., dba Topco Sales, seeks registration
on the Principal Register of the mark **CLIMAX** (*in standard
character format*) for goods identified as follows:

"adult sexual aids, namely, electric and non-electric
massage devices and accessories for massaging or
vibrating portions of the face and body; imitation
sexual organs, namely penises, penises and testicles,
dildoes, vaginas and breasts; devices for aiding in
sexual intercourse and masturbation, namely
reproductions of parts of the male and female
anatomy, stimulation devices for aiding in sexual
arousal and performance; vibrators and vibrator
sleeves; and vacuum pumps and vacuum pump
accessories, namely a cylinder sleeve, cushion
inserts, constriction rings and constriction ring
loaders for use to maintain penile rigidity" in
International Class 10.¹

¹ Application Serial No. 78692514 was filed on August 15, 2005
based upon applicant's allegation of a *bona fide* intention to use the
mark in commerce.

This case is now before the Board on appeal from the final refusal of the Examining Attorney to register applicant's mark based upon Section 2(d) of the Trademark Act, 15 U.S.C.

§ 1052(d). The Trademark Examining Attorney asserts that applicant's mark, when used in connection with the identified goods, so resembles the following mark,



which is registered for "electric massage apparatus, namely, vibrators" in International Class 19,² as to be likely to cause confusion, to cause mistake or to deceive. Applicant and the Trademark Examining Attorney have fully briefed the case.

In discussing the similarities of the marks, the Trademark Examining Attorney takes the position that the word "Climax" in registrant's mark is most dominant visually, that the term "Jelly" is merely descriptive and properly disclaimed, and that the word "Maximizer" "merely serves as a modifier that enforces the dominance of the term Climax." By contrast, in arguing for registrability, applicant contends that its mark is not confusingly similar to the cited mark in that the marks do

² Registration No. 2275401 issued on September 7, 1999; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

not sound alike, they do not look alike, they have different connotations and they have different commercial impressions. Applicant argues that the Examining Attorney improperly dissects registrant's mark, explains the "modifying" role of the word "Maximizer," while criticizing registrant's disclaimer of the word "Climax." Finally, applicant argues that the Trademark Examining Attorney has improperly ignored applicant's own claimed registrations for **CLIMAX** for related goods.

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

We turn first to the *du Pont* factor focusing on the relationship of the goods herein. Applicant does not dispute the fact that registrant's electric massage devices, i.e., vibrators, are included in the range of adult novelty items identified by applicant. Accordingly, the goods are identical in part and otherwise related, and this *du Pont* factor favors a finding of likelihood of confusion. If the cited registration contains no limitation as to the channels of trade or classes of purchasers, it is presumed that the registration encompasses all goods of the type described, that they move in all channels of trade normal for these goods, and

that they are available to all classes of purchasers for the described goods and services. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). These related *du Pont* factors also favor a finding of likelihood of confusion.

We turn then to the critical *du Pont* factor that the Trademark Examining Attorney and applicant discuss at length in their briefs involving the similarities or dissimilarities in the appearance, sound, connotations and commercial impressions of the respective marks. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

As noted by the Trademark Examining Attorney, the descriptive term "Jelly" in registrant's composite mark is presented in relatively small letters, and registrant correctly disclaimed it apart from the cited mark as a whole. Additionally, the Trademark Examining Attorney placed into the record a copy of a website describing the use of "jelly" materials in constructing adult novelty items.³

Applicant does not dispute this basic principle, but points out that the word "Jelly" is nonetheless part of the composite mark cited against its mark, and notes further that registrant, in arguing against an outstanding descriptiveness refusal under Section 2(e)(1) of the Act, agreed to disclaim

³ <http://www.mybodyvibes.com/store/vibrators/jelly/>

both words, "Jelly Climax." [Application Serial No. 75371757, Office action of November 2, 1998].

Applicant repeatedly points out that registrant has disclaimed the term "Climax" as merely descriptive of its vibrators. "It is a jelly product that maximizes and [sic] sexual climax (orgasm)." Applicant's reply brief at 3. Thus, in the context of registrant's mark, applicant is adamant that the word "Climax" is merely descriptive. By contrast, when used in the context of applicant's own related goods, applicant makes the counter-argument that the word "Climax" alone functions as an inherently distinctive trademark.

In arguing against registrability herein, the Trademark Examining Attorney has consistently focused on the relatively large size of the word "Climax" in registrant's composite mark. Undeniably, this word is in a larger, more distinctive style of lettering than the other two words making up the composite. Yet, in an apparent effort to bolster her argument for our finding a likelihood of confusion herein, the Trademark Examining Attorney argues that the cited registration is flawed:

The examining attorney notes that the term CLIMAX is incorrectly disclaimed from the registered mark. ... [T]he examining attorney notes that the disclaimer of the term CLIMAX from the registered mark was in error and should not be considered for the purposes of this analysis. ... Moreover, the examining attorney did not issue a Section 2(e)(1) descriptiveness refusal in the instant case as the term CLIMAX is not descriptive, but rather suggestive and capable of registration on the Principal Register,

without a showing of secondary meaning. The term CLIMAX cannot be viewed in the same light as the term JELLY, as CLIMAX is in fact a suggestive term, and does not describe the goods.

Trademark Examining Attorney appeal brief at unnumbered 10.

Applicant describes this approach by the Trademark Examining Attorney as "incredulous," "outrageous," "erroneous," "unfortunate" and "unconscionable." Without commenting further on applicant's characterizations, we agree with applicant that the Trademark Examining Attorney cannot eviscerate a cited registration in this manner. In the face of a registration bar under Section 2(e)(1) of the Act when prosecuting the cited registration, registrant was successful in overcoming this refusal by disclaiming the words "Jelly Climax."

Hence, the only non-descriptive, non-disclaimed matter in the cited registration is the word "Maximizer." Nonetheless, the Examining Attorney argues that "the term MAXIMIZER ... merely serves as a modifier ... of the term CLIMAX":

The term MAXIMIZER, while not descriptive, merely serves as a modifier that enforces the dominance of the term CLIMAX. The term MAXIMIZER, meaning to increase to a maximum or to make the most of, simply implies that the suggested CLIMAX will be increased or maximized. Thus, the mere addition of the modifying term MAXIMIZER does not obviate the dominance of the term CLIMAX. Potential consumers encountering the marks used in connection with the goods at issue would interpret the goods as emanating from the CLIMAX brand, one being the more intense or maximized variety, and the other being the more standard variety.

Trademark Examining Attorney's appeal brief at unnumbered 9 and 10. Furthermore, she asks that we take judicial notice

of the definition of "maximizer" as a transitive verb meaning "1: to increase to a maximum, 2: to make the most of, 3: to find a maximum value of ..." ⁴

However, we cannot fault the previous Trademark Examining Attorney tasked with examining registrant's application in deciding that among the three words making up that composite mark, the word "Maximizer" is the strongest candidate for inherent distinctiveness when used in the connection with vibrators. Accordingly, we find the word MAXIMIZER to be the dominant portion of the cited mark.

As a corollary, we also find that the present Trademark Examining Attorney has analyzed the cited mark incorrectly. As to parts of speech within registrant's composite mark, the word "Climax" is used as an adjective modifying the word "Maximizer" - used in registrant's mark as a noun and not a verb as the Trademark Examining Attorney's dictionary entry suggests.

As to sound, registrant's mark is eight syllables, with applicant's two syllable term buried in the middle thereof. Thus, the sound of these respective marks is quite dissimilar.

As to the appearance of registrant's composite, it is clear that the lettering of the word "Climax" is the largest and most distinctive stylistically. While this is the strongest argument for the position of the Trademark Examining

⁴ MERRIAM-WEBSTER'S COLLEGIATE® DICTIONARY, Eleventh Edition, also available at www.m-w.com.

Attorney that "Climax" is the dominant portion of the cited mark visually, given the fact that it is the second of two adjectives modifying the term "Maximizer," we cannot agree that the word "Climax" retains such an elevated status when one is looking to identify the most salient feature of the composite for purposes of discerning commercial impression and connotation. We disagree with the conclusions of the Trademark Examining Attorney that the meaning prospective consumers acquainted with both marks would draw from registrant's mark is that registrant's listed product offers "the more intense or maximized" experience available from the respective **CLIMAX** branded products.

When used alone by applicant in the context of adult sex toys, the word **CLIMAX** appears suggestive of the ultimate, intended effect of the goods. However, within the three-word phrase, "Jelly Climax Maximizer," the word "Climax" is merely descriptive inasmuch as it modifies the word "Maximizer," and tells the prospective purchaser precisely what the product does. We find this to be true despite the relatively large, stylized letters in which the word "Climax" is presented. As we noted above, registrant has disclaimed the word "Climax," and there is no indication that the registrant has subsequently sought a registration without such a disclaimer - a change that would likely not go unnoticed by registrant.

While the cited mark, in its entirety is arguably somewhat laudatory, we must assume, in the instant context, that it is inherently distinctive overall.

In conclusion, in spite of the fact that we are faced with overlapping goods moving through the same presumed channels of trade ultimately to be purchased by the same ordinary customers, we reverse this Section 2(d) refusal based upon the dissimilarity of the marks. Both of these marks are somewhat weak as applied to these goods, and when viewed in their entireties, we find that the respective marks are not confusingly similar.

We have reached this determination without giving weight to applicant's arguments that it is entitled to registration of its **CLIMAX** mark for the goods involved herein because it already owns two registrations for the identical mark for personal lubricants. Our task in deciding this appeal is to determine the registrability of applicant's mark for the involved goods. Applicant's ownership of registrations for the identical mark for different goods is not a factor in our likelihood of confusion determination.

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