

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

*Decision Mailed:
October 17, 2007
GDH/gdh*

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Rach

Serial No. 78811345

David R. Haarz of Harness, Dickey & Pierce, P.L.C. for Stephanie Rach.

Mark Rademacher, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Seeherman, Quinn and Hohein, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Stephanie Rach has filed an application to register on the Principal Register in standard character form the mark "THE CHIPPER TRAVEL SERIES" for "musical sound recordings; pre-recorded CD's, video tapes, laser disks and DVD's featuring stories for children; [and] prerecorded audio cassettes featuring music and stories for children" in International Class 9 and "children's books" in International Class 16.¹

¹ Ser. No. 78811345, filed on February 9, 2006, which is based on an allegation of a bona fide intention to use such mark in commerce. The words "TRAVEL SERIES" are disclaimed.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to her goods, so resembles the mark "CHIPPER CHAT," which is registered on the Principal Register in standard character form for "teaching and motivational aids in the nature of a game that consists of magnetic chips, magnetic wand, and game boards for use by the general public, public and private teachers, [and] health professionals or therapists" in International Class 28,² as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed and briefs have been filed. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). See also In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.³ See also In re Dixie Restaurants Inc., 105 F.3d

² Reg. No. 2,532,135, issued on January 22, 2002, which sets forth a date of first use anywhere and in commerce of October 19, 2000.

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the

1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). Here, inasmuch as applicant, as noted by the Examining Attorney, concedes in her brief that "[f]or the purposes of this appeal, Ms. Rach does not contest the determination that board games on the one hand and books, CD's and DVD's on the other can be considered related goods," the primary focus of our inquiry is on the similarities and dissimilarities in the respective marks when considered in their entirety.

Turning, therefore, to consideration of the respective marks, applicant argues in her brief that, while she does not dispute the Examining Attorney's contention that the word "CHIPPER" is the primary or dominant element of both marks, she maintains that "the respective marks are quite different," thereby precluding any likelihood of confusion. In particular, applicant contends that (emphasis in original):

[T]o understand the commercial impression of CHIPPER CHAT, the goods for which CHIPPER CHAT is registered must be considered. Those goods are "Teaching and motivational aids in the nature of a game that consists of magnetic **chips**, magnetic wand, and game boards for use by the general public, public and private teachers, [and] health professionals or therapists" (emphasis supplied). The "CHIPPER" in the mark CHIPPER CHAT refers to the fact that it is a board game which utilizes "chips." CHAT refers to talking. Thus, the mark CHIPPER CHAT is suggestive of a board game played with chips that involves "chat" or talking.

On the other hand, THE CHIPPER TRAVEL SERIES is suggestive of a group of videos, CD's and other recordings which feature the travels of someone named "CHIPPER," in this

essential characteristics of the goods and differences in the marks." 192 USPQ at 29.

case a squirrel named "CHIPPER." Chipper is applicant's copyrighted squirrel. A copy of applicant's US Copyright Certificate for her squirrel character was made of record during the prosecution of this application. CHIPPER will travel around the world and be the subject of a series of children's books, videos, CD's and other recordings sold under THE CHIPPER TRAVEL SERIES mark.

Applicant consequently urges that "[i]n light of the differences between the respective marks, CHIPPER CHAT for a game which uses 'chips' to encourage children to 'chat,' and THE CHIPPER TRAVEL SERIES for a series of books, videos and CD's featuring the travels of a squirrel named CHIPPER, the respective marks are not confusingly similar in sound and appearance when viewed in their entirety and certainly not in light of the differences in meaning and overall commercial impression."

The Examining Attorney, emphasizing that applicant does not dispute in her brief that the term "CHIPPER" is the primary or dominant element of both marks, argues on the other hand that:

Neither the term "travel series" in applicant's mark nor the term "chat" in the registered mark alters the connotation of the term "chipper," from that in the other mark. In both cases the term "chipper" primarily suggests cheerfulness or liveliness. The examining attorney refers to the dictionary definition attached to the final office action

Such definition, from The American Heritage Dictionary of the English Language (4th ed. 2000), defines "chipper" as an adjective meaning "[i]n lively spirits; cheerful." In view thereof, the Examining Attorney maintains that:

Applicant's assertion that "chipper" suggests game chips would require consumers to ignore the dictionary definition of the word ["]chipper.["] Moreover, consumers would

have to ignore the fact that the dictionary definition of the word ["]chipper["] more clearly fits in the combination CHIPPER CHAT than any meaning suggestive of chip pieces in a game. Notably, there is no evidence ... such as a dictionary definition of the term "chipper" that relates to game chips.

As to applicant's assertion that the term "CHIPPER" in her mark would be regarded as identifying a worldly traveling squirrel character who is the subject of applicant's books and recordings, the Examining Attorney contends that:

[T]he fact that the word CHIPPER may also be the name of a squirrel does not change the fact that the word CHIPPER connotes something lively or cheerful. Squirrels are generally thought of as having these traits. The term ["]chipper["] used to identify a character still gives the impression of something lively or cheerful.

The Examining Attorney consequently insists that because "the term CHIPPER has the same connotation and commercial impression in both marks" and constitutes the dominant element of each, "the marks as a whole are sufficiently similar to be likely to cause confusion when used on related goods."

While the issue is a close one, we find that confusion is likely from contemporaneous use of the respective marks in connection with the related goods at issue. In this regard, it must be kept in mind that it is well settled that the issue of likelihood of confusion must be determined on the basis of the goods at issue as they are set forth in the involved application and the cited registration rather than in light of what the goods may actually be as shown, for instance, by extrinsic evidence. See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990);

Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Thus, although applicant's goods may indeed feature applicant's copyrighted squirrel character, as indicated by the copy of record of her U.S. Copyright Certificate for such, it is improper to limit or restrict the goods identified and distinguished by applicant's THE CHIPPER TRAVEL SERIES mark to children's books and recordings featuring music and/or children's stories which have as their central character or subject matter a globe-trotting squirrel named "Chipper." Rather, such goods must at the very least be regarded as including books and recordings on a wide variety of travel topics.

Similarly, it is impermissible to confine the subject matter of registrant's "CHIPPER CHAT" teaching and motivational aids in the nature of a game consisting of magnetic chips, a magnetic wand, and game boards for use by the general public, public and private teachers, and health professionals or therapists to those which do not involve children's games on such topics as world travel or geography. Instead, such goods must be treated as encompassing, *inter alia*, a game which involves travel-related themes.

In light thereof, we think that even if consumers were to view the word "CHIPPER" in registrant's "CHIPPER CHAT" mark as

suggestive of the magnetic chips used in its motivational games pertaining to travel, it is still the case that as the dominant part of the mark such word also conveys, as it does as the dominant element of applicant's "THE CHIPPER TRAVEL SERIES" mark, a connotation and overall commercial impression of a lively, spirited or cheerful activity when used in connection with, respectively, registrant's motivational games which could have a travel-related theme and applicant's children's books and recordings for children on travel subjects. Moreover, the Examining Attorney in any event has additionally made of record excerpts from the MyToyBox.Com website which show the same character name mark used in connection with games for children as well as children's books (including sound books), videos and DVD's. In view of such evidence, it would be likely that even if purchasers were familiar or acquainted with the term "CHIPPER" as the name of the squirrel who constitutes the principal character or subject matter of the travel books and recordings for children offered by applicant under the mark "THE CHIPPER TRAVEL SERIES," those consumers are also likely to assume that registrant's motivational games feature the same character and, hence, that they emanate from or are sponsored by the same source when marketed under the similar mark "CHIPPER CHAT."

Nonetheless, as a final consideration, to the extent that applicant's contention with respect to specific differences in the marks at issue as to their connotation and overall commercial impression may serve to raise any doubt as to our conclusion with respect to the issue of likelihood of confusion,

we resolve such doubt, as we must, in favor of the registrant. See, e.g., In re Chatam International Inc., 380 F.3d 1340, 71 USPQ2d 1944, 1948 (Fed. Cir. 2004); In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 156, 223 USPQ 1289, 1290 (Fed. Cir. 1984); and In re Pneumatiques Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729, 729 (CCPA 1973).

We accordingly conclude that purchasers who are familiar or otherwise acquainted with registrant's "CHIPPER CHAT" mark for "teaching and motivational aids in the nature of a game that consists of magnetic chips, magnetic wand, and game boards for use by the general public, public and private teachers, [and] health professionals or therapists" would be likely to believe, upon encountering applicant's similar "THE CHIPPER TRAVEL SERIES" mark for "musical sound recordings; pre-recorded CD's, video tapes, laser disks and DVD's featuring stories for children; prerecorded audio cassettes featuring music and stories for children"; and "children's books," that such commercially related products emanate from, or are sponsored by or affiliated with, the same source. Consumers, for example, could reasonably regard applicant's and registrant's goods as constituting a line of "CHIPPER" branded products.

Decision: The refusal under Section 2(d) is affirmed.