

This Opinion is not a  
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Flair Leisure Products PLC*

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Serial No. 79130383

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Colleen Flynn Goss of Fay Sharpe LLP,  
for Flair Leisure Products PLC.

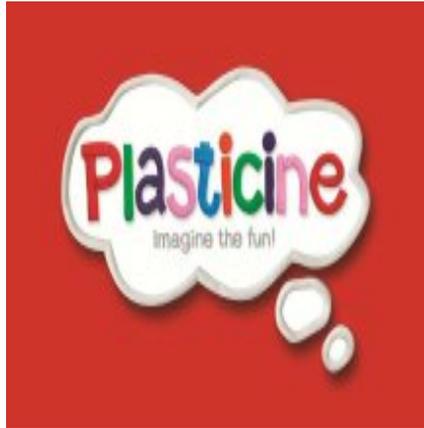
Laura Golden, Trademark Examining Attorney, Law Office 103,  
Michael Hamilton, Managing Attorney.

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Before Quinn, Zervas and Lynch,  
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

Flair Leisure Products PLC (“Applicant”) seeks registration on the Principal Register of the mark that includes the literal element PLASTICINE IMAGINE THE FUN! as shown below



for the following goods:

Hand tools and hand implements for use in modelling and in working modelling material, namely plastic and wooden modelling tools for cutting, trimming, shaping and forming modelling material  
INT. CLASS 008

Craft paper; craft paper articles and cardboard articles namely, pictures; printed matter, namely, magazines and leaflets relating to modeling and crafts; books in the field of modelling and crafts; paint brushes; modelling clay; printed instructional and teaching materials in the field of modelling and crafts  
INT. CLASS 016

Toys, games and playthings, namely, hobby and modelling sets, comprised of toy modelling material, shape cutters, shaping tools, molds, play mats, plastic rollers, picture trays, and picture cards  
INT. CLASS 028.<sup>1</sup>

The Examining Attorney refused registration of Applicant's mark under § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), as likely to cause confusion with the registered mark IMAGINE THE FUN (standard characters) for "Retail services through direct solicitation by salespersons directed to end-users featuring toys, balls and toy sports equipment" in International Class 35 (Registration).<sup>2</sup> After the

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<sup>1</sup> Application Serial No. 79130383 was filed on March 14, 2013, under the Madrid Protocol pursuant to § 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a).

<sup>2</sup> Registration No. 4272346, issued January 8, 2013.

Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

### I. Applicable Law

The determination under § 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

With respect to the marks, we must compare them “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). The test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods and services offered under the respective marks is likely to result. *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101

USPQ2d 1713, 1721 (Fed. Cir. 2012). *See also Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012).

As to the goods and services, we must determine whether their degree of relatedness rises to such a level that consumers would mistakenly believe the goods and services emanate from the same source. The comparison of Applicant's goods to Registrant's services must be assessed as they are identified in the application and registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The Examining Attorney need not prove likelihood of confusion with respect to each of the goods identified in Applicant's application; if there is likelihood of confusion with respect to any good in the class, we affirm the refusal of registration as to that class. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

## II. Analysis

Turning first in the likelihood of confusion analysis to the relatedness of Applicant's goods to Registrant's retail services, it has often been recognized that likelihood of confusion may arise where confusingly similar marks are used on goods, on the one hand, and in connection with retail sales of such goods, on the other. *See In re Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629, 1640 (TTAB 2006); *In re Thomas*, 79 USPQ2d 1021, 1023 (TTAB 2006) (holding the use of similar marks both for jewelry and for retail-jewelry and mineral-store services was

likely to cause confusion); *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992) (holding the use of nearly identical marks both for coats and for retail outlets featuring items including coats was likely to cause confusion, noting that “there is no question that store services and the goods which may be sold in that store are related goods and services for the purpose of determining likelihood of confusion”); 4 J. Thomas McCarthy, *McCarthy On Trademarks And Unfair Competition* § 24:25 (4th ed. 2015). In this case, the Registration covers the retail sale of toys and toy sports equipment, and Applicant’s goods include, *inter alia*, toys in International Class 28, modelling clay, paint brushes, craft paper, and craft books in International Class 16, and hand tools for use with modelling material in International Class 8. We note that the Registration’s retail services involve “direct solicitation by salespersons directed to end-users.”

The Examining Attorney provided third-party website evidence of the same marks used by a single entity on the types of goods Applicant identifies and in connection with retail services featuring toys.<sup>3</sup> For example, the mark PLAY-DOH appears as the service mark for a retail website for toys, and also appears as the trademark for modelling dough, dough kits with associated hand tools, and other craft supplies.<sup>4</sup> Another set of screenshots of the ALEX website reflects use of that mark both for the service of retailing toys, crafts, and sports equipment and on modelling clay, modelling hand tools, and toys.<sup>5</sup> Yet another example shows the

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<sup>3</sup> July 5, 2013 Office Action at pp. 7-35; March 5, 2014 Office Action at pp. 11-41.

<sup>4</sup> March 5, 2014 Office Action at pp. 18-21.

<sup>5</sup> *Id.* at pp. 11-17.

mark MELISSA AND DOUG displayed both as the online retail store service mark and as the trademark appearing on craft paper, modelling clay, and modelling tools.<sup>6</sup> Other evidence reflects use of the mark CRAYOLA for clay and art paper, and also as a retail service mark for the sale of the same types of goods.<sup>7</sup> This evidence and other evidence of record establish that goods such as Applicant's often are sold under the same mark used for retail store services featuring toys.

The Examining Attorney also provided six use-based third-party registrations,<sup>8</sup> four of which<sup>9</sup> cover, *inter alia*, the types of Class 16 and 28 goods in the Application and Class 35 retail services featuring toys, as follows:

- Registration No. ("RN") 2408939 AMERICAN GIRL includes International Class 16 craft books, International Class 28 toys, and International Class 35 retail store services featuring toys and games;<sup>10</sup>
- RN 3726765 PAUL FRANK includes International Class 16 notebook pads and stationery, International Class 28 toys and games, and International Class 35 retail store services featuring toys;<sup>11</sup>

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<sup>6</sup> July 5, 2013 Office Action at pp. 7-17.

<sup>7</sup> *Id.* at pp. 18-21.

<sup>8</sup> July 5, 2013 Office Action at pp. 36-59.

<sup>9</sup> One of the other third-party registrations, Registration No. 4272629, includes relevant goods, but the retail store services feature only clothing and housewares. The second remaining third-party registration, Registration No. 3788258, includes relevant goods, but the retail store services feature books and hunting goods. Therefore, we do not find these registrations probative as to relatedness of the goods and services at issue in this case. *See In re Melville Corp.*, 18 USPQ2d 1386, 1388-89 (TTAB 1991).

<sup>10</sup> July 5, 2013 Office Action at pp. 36-39.

<sup>11</sup> *Id.* at pp. 45-48.

- RN 3989816 FUNLEY'S includes International Class 16 coloring books, sticker albums, International Class 28 toys and toy sports equipment, and International Class 35 retail store services featuring toys;<sup>12</sup>
- RN 4314725 CP TOYS includes International Class 16 modeling clay, paint brushes, construction paper, International Class 28 toys and toy sports equipment, and International Class 35 retail store services featuring toys.<sup>13</sup>

We find that the unrestricted retail store services identifications in these registrations encompass direct solicitation by salespeople, as set forth in the Registration, because direct solicitation occurs as part of the retail store services. Third-party registrations which cover the same types of goods and services and are based on use in commerce also have some probative value by suggesting that the listed goods and services may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). Although Applicant criticizes the third-party registration evidence because some of the registrations contain numerous classes, we note that the goods and services in the four registrations we consider appear reasonably tailored within the particular classes, such that these registrations do not contain the type of "laundry list" of goods and services that might negate probative value as to relatedness. Rather, this third-party registration

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<sup>12</sup> *Id.* at pp. 53-56.

<sup>13</sup> *Id.* at pp. 57-59.

evidence suggests that Applicant's International Class 16 and 28 goods emanate from the same sources as the services identified in the Registration.

While Applicant contends that the quantity of evidence does not suffice given the "global retail community," we are satisfied that the websites from several sources in the record reflect the broader realities of the marketplace. Moreover, the third-party registrations noted above further support relatedness. Thus, in this case, the evidence is substantial.

As our principal reviewing court has noted, "trademarks for goods find their principal use in connection with *selling* the goods" and accordingly, marks for goods and marks for the service of selling such goods will impact the purchasing public in the same marketplace. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988). We find that this *du Pont* factor weighs in favor of likely confusion.

Applicant also argues that differing channels of trade weigh against likely confusion based on the limitation in the Registration that the retail services occur through direct solicitation by salespersons. We presume, as we must, that Applicant's goods, for which the identification is unrestricted, travel through all usual channels of trade. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 948, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (Where the identification is unrestricted, "we must deem the goods to travel in all appropriate trade channels to all potential purchasers of such goods"). Thus, the same toys that Applicant offers for sale may be offered through direct solicitation by salespersons. Although Applicant asserts

that direct solicitations, as identified in the Registration, greatly differ from general retail services, Applicant provides no evidentiary support for this proposition. *See In re Consol. Specialty Rests. Inc.*, 71 USPQ2d 1921, 1929 (TTAB 2004) (“[A]ttorney argument without support in the record . . . does not overcome the prima facie case.”). Applicant asserts that the Examining Attorney failed to provide evidence that “entities which engage in direct sales solicitations also have retail stores and on-line retail sites or that a consumer would expect to find direct solicitation sellers with on-online or bricks and mortar stores.”<sup>14</sup> Nothing in the plain meaning of the identification in the Registration precludes the direct solicitation by salespeople from occurring within a retail store or an online retail environment where salespeople communicate directly with customers to solicit their business, and no evidence in the record indicates otherwise. Therefore, we find Applicant’s contention as to the distinction in trade channels overreaching.

Nonetheless, even assuming, *arguendo*, that retail services in general do not encompass direct solicitation, in response to Applicant’s argument, the Examining Attorney included evidence in the record of the same mark used for retail sale by direct solicitation and other methods. The record includes the Discovery Toys website showing that sales under its mark may occur through direct solicitation by salespeople at in-person parties, as well as online through the “shop now” option to place items in “your cart.”<sup>15</sup> In addition, the record includes more general evidence

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<sup>14</sup> 23 TTABVUE 18 (Applicant’s brief at 17).

<sup>15</sup> July 5, 2013 Office Action at pp. 22-26.

of consumer exposure to entities such as TUPPERWARE,<sup>16</sup> LATTICE & IVY,<sup>17</sup> and AVON<sup>18</sup> selling products under the same marks both through direct solicitation by salespeople at parties and through online retailing. Applicant criticizes the LATTICE & IVY and AVON evidence as “having no connection to the goods and services at issue in any way,”<sup>19</sup> but we find that the evidence has some probative value to show that the same marks are used in direct solicitation trade channels as in other types of retail service trade channels. Finally, the Examining Attorney’s evidence also demonstrates that consumers generally encounter the same marks in connection with various methods of retail sale, thereby minimizing the significance of the alleged distinction of the direct solicitation method, for our purpose.<sup>20</sup>

Considering all the relevant evidence and the applicable presumption regarding channels of trade, we conclude that this factor must be considered to favor likely confusion at least somewhat. Online retail services and retail services in brick-and-mortar locations may include direct solicitation by salespeople. Regardless, consumers are familiar with direct solicitation and other types of retail services offered under the same marks. The record contains substantial evidence that single

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<sup>16</sup> *Id.* at p. 44.

<sup>17</sup> *Id.* at pp. 45-46.

<sup>18</sup> *Id.* at p. 47.

<sup>19</sup> 23 TTABVUE 17 (Applicant’s Brief at 17).

<sup>20</sup> March 5, 2014 Office Action at pp. 18, 29-30 (PLAY-DOH sells modelling clay, hand tools, and toys through its own PLAY-DOH website as well as through third-party retailers); *Id.* at pp. 29-42 (the website for retailer TOYS R US indicates that consumers may buy online under its service mark as well as through its brick-and-mortar retail stores of the same name); *Id.* at pp. 27-35 (The website for THE VILLAGE TOY SHOP reflects use of that mark in connection with online retail sales as well as brick-and-mortar store locations).

sources offer goods such as Applicant's and retail services featuring toys under the same mark. Thus, even though the services recited in the Registration pertain to direct solicitation by salespeople featuring toys, they must be considered to move in the same trade channels as the types of goods Applicant identifies.

The remaining relevant likelihood of confusion factor focuses on the similarity of the marks themselves. Both marks contain the identical wording IMAGINE THE FUN, though Applicant's mark includes the additional word PLASTICINE in relatively larger font, and features color and a design element of a "thought bubble" on which all the wording appears. As an initial matter, we remain mindful that Registrant may display its standard character mark in any lettering style or color, including that in which Applicant displays the identical wording encompassed in its mark. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348 (Fed. Cir. 2010). Applicant argues that PLASTICINE and the design element form the dominant focal point of Applicant's mark. However, as to the design element, the "thought bubble" serves as a background for the wording, and reinforces the reference to IMAGINE, as "thought bubbles" often depict what is being imagined. Thus, we do not find that the design element dominates the mark, but rather that it emphasizes the IMAGINE THE FUN wording in the mark.

Concerning the wording PLASTICINE in the mark, we agree with the Examining Attorney's assessment that in considering the mark as a whole, consumers would view the PLASTICINE word as a brand reference, and IMAGINE

THE FUN as an accompanying tagline or slogan. Applicant concurs that PLASTICINE would be perceived as its “product line mark,” and describes IMAGINE THE FUN! as an accompanying “slogan.”<sup>21</sup> Consumers familiar with Registrant’s services who encounter the same slogan on Applicant’s related goods likely would believe that Registrant introduced a product line that uses the slogan in conjunction with the additional PLASTICINE mark that is specific to the product line. Thus, we find that the larger wording PLASTICINE does not sufficiently distinguish Applicant’s mark from the Registrant’s mark to avoid likely confusion.

Applicant further attempts to downplay the identical wording by characterizing it as laudatory, weak, and “somewhat descriptive,” but we disagree. Applicant provided no evidentiary support for its proposition. To the contrary, in the context of the toys, art supplies, and other creative goods at issue, or in retail services featuring toys, the use of IMAGINE in the phrase creates a memorable double entendre. Applicant concedes that its “craft and hobby kits ... by their very nature engage the user’s imagination,”<sup>22</sup> and we find that the same holds true for these types of goods sold through retail services. Turning to the double entendre of the shared wording in both marks, on one hand, in a use similar to the expression, “imagine that!,” the phrase calls on the potential purchaser generally to imagine, or consider, that fun could be had with the goods. On the other hand, IMAGINE THE FUN suggests that the user may derive fun from using his or her imagination in playing with or using the modelling material and other goods. Thus, in the context

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<sup>21</sup> 23 TTABVUE 11 (Applicant’s Brief at 11).

<sup>22</sup> *Id.*

of Applicant's mark, the clever dual meaning renders the wording significant and memorable to consumers, despite its smaller appearance relative to PLASTICINE.

Applicant has cited numerous cases in support of its argument that the marks are different in commercial impression. After careful consideration of these cases,<sup>23</sup> we do not find them analogous. The assessment of visual and phonetic similarities and distinctions constitutes a highly fact-specific inquiry. The nature of the specific differences between the marks in the cases cited by Applicant and the nature of the marks in their entirety do not closely parallel those at issue in this case. For example, the design element with two Rs, race flag designs, and hearts in *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014), the superhero torso doubling as a face in *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007), and the design elements in the several other cases cited, appear much more significant than the thought bubble background design in Applicant's mark. *See id.* at 1017 ("design is very noticeable and has the effect of catching the eye and engaging the viewer before the viewer looks at the word").

Overall, we find that Applicant's mark incorporates the entirety of Registrant's mark, and this wording forms a significant portion of Applicant's mark. Even with the addition of PLASTICINE and the color and design element, considering Applicant's entire mark, the shared wording and the nature of its incorporation into the mark as a whole contributes to a commercial impression and connotation

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<sup>23</sup> 23 TTABVUE 13-15 (Applicant's Brief at 13-15).

similar to Registrant's mark, as well as to visual and phonetic similarity. Accordingly, this factor favors likely confusion.

Thus, the similarity of the marks and the trade channels, as well as the relatedness of the goods and services, favor likely confusion. Applicant and the Examining Attorney have not presented evidence or argument as to other *du Pont* factors and, accordingly, we treat those factors as neutral. Balancing the relevant factors, we consider the Application likely to result in consumer confusion based on the Registration.

**Decision:** The refusal to register Applicant's mark under § 2(d) for its goods in International Classes 8, 16 and 28 is affirmed.