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PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*In re PixelMags, Inc.*

Serial No. 85379299

John Gerben of Gerben Law Firm for PixelMags, Inc.

Dannean J. Hetzel, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Quinn, Kuhlke and Wellington,  
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

PixelMags, Inc. filed, on May 11, 2012, an application under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), to register the mark READR (in standard characters) on the Supplemental Register for “computer application software for mobile phones, portable media players and portable computers, namely, software for viewing digital magazines” in International Class 9. Applicant alleges first use anywhere and first use in commerce on July 15, 2011.

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 goods, so resembles the previously

registered mark **READER** (in typed form) for “computer software for page recognition and rendering for use in viewing, printing, navigating, editing, annotating and indexing electronic documents, filling in and submitting forms on-line, and transferring electronic documents via a local or global communications network; computer e-commerce software to allow users to perform electronic business transactions via a local or global communications network; computer software for the encryption and access control of electronic documents; and instructional books and manuals sold as a unit therewith” in International Class 9,<sup>1</sup> as to be likely to cause confusion.

When the refusal to register was made final, Applicant appealed and requested reconsideration. The request for reconsideration was denied, and Applicant and the Examining Attorney filed briefs.<sup>2</sup> Applicant requested an oral hearing, but subsequently withdrew its request.

Applicant argues that the goods differ in purpose and that consumers will distinguish between them on this basis. Further, the terms “**READ**” and “**READER**” are used so frequently in third-party marks for software that consumers will readily differentiate between the sources of the products based on even small differences

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<sup>1</sup> Registration No. 2548832, issued March 19, 2002; renewed. Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i) (April 2014).

<sup>2</sup> The Examining Attorney also issued a final refusal on the ground that Applicant’s mark, when used in connection with Applicant’s goods, is merely descriptive thereof under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). Applicant, in its appeal brief, amended its application to seek registration on the Supplemental Register. In her brief, the Examining Attorney accepted the amendment to the Supplemental Register, and withdrew the mere descriptiveness refusal. Thus, as noted by the Examining Attorney, the only issue on appeal is likelihood of confusion.

between marks, as in the case of Applicant's mark READR and Registrant's mark READER. With respect to the likelihood of confusion refusal, Applicant introduced dictionary definitions of "read" and "reader," excerpts from Applicant's and Registrant's websites, and third-party registrations.<sup>3</sup>

The Examining Attorney maintains that the marks are similar and that the goods are related. The Examining Attorney did not submit any evidence in connection with the Section 2(d) refusal.

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, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first turn to consider the second *du Pont* factor regarding the similarity/dissimilarity between the goods. It is well settled that the goods need not be identical or competitive, or even be offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods of Applicant and Registrant are related in some manner, and/or that the

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<sup>3</sup> Applicant accompanied its appeal brief with copies of third-party registrations. The Examining Attorney, in her brief, objected to any of the third-party registrations that were not properly made of record during prosecution. *See* Trademark Rule 2.142(d). The objection is sustained, and any registration not previously submitted during prosecution has not been considered. We further note it is unhelpful when applicants attach to their briefs the evidence submitted during prosecution of the application. *In re SL&E Training Stable Inc.*, 88 USPQ2d 1216, 1220 n.9 (TTAB 2008).

conditions and activities surrounding the marketing of the goods 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 originate from the same source. *See Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue here, of course, is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of these goods. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

We make our determination regarding the similarities between the goods, channels of trade and classes of purchasers based on the goods as they are identified in the application and registration, respectively. *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011). Applicant's identification of goods reads "computer application software for mobile phones, portable media players and portable computers, namely, software for viewing digital magazines"; Registrant's identification, in relevant part, reads "computer software for page recognition and rendering for use in viewing, printing, navigating, editing, annotating and indexing electronic documents."

Applicant "acknowledges that both Applicant and Registrant provide software products." (Brief, unnumbered p. 9). Applicant contends, however, that the

software products are not merely used for viewing digital data, but rather have different applications; Applicant's software "is used specifically for reading magazines" whereas Registrant's software "enables users to view and print PDF files." (Brief, unnumbered p. 3). According to Applicant, consumers will not believe that a software product used to edit PDF documents, submit forms online and transfer documents over email accounts emanates from the same source as a software application designed specifically to read and view magazines. The Examining Attorney counters by asserting that the "electronic documents" listed in Registrant's identification are broadly worded and, thus, encompass the "digital magazines" listed in Applicant's identification.

We find that the respective software products have a similar function, namely to view digital data; Applicant's software is used to view "digital magazines" and Registrant's software is used to view "electronic documents." The term "electronic documents" is broad enough to encompass digital magazines or similar media.<sup>4</sup> Given the similarity in the software applications, as identified, the goods are likely to move in similar trade channels to similar classes of purchasers.

The similarity between the goods, trade channels and purchasers are factors that weigh in favor of a finding of likelihood of confusion.

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<sup>4</sup> Applicant has relied on Registrant's website in an attempt to restrict Registrant's software to use in viewing only PDF documents. Registrant's identification of goods does not contain this limitation, and the broadly-worded terminology "electronic documents" is construed to include all types of such documents, including types similar to digital magazines. See, e.g., *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764-65 (TTAB 1986) (an applicant may not restrict the scope of the goods covered in a cited registration by extrinsic argument or evidence).

We next direct our attention to the *du Pont* factor of the similarity/dissimilarity between the marks. We must compare the marks in their entirety as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1960 (Fed. Cir. 2005), quoting *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Applicant, while acknowledging that “the marks both contain the term ‘READ’ and are pronounced the same way” (Response, 4/19/12), attempts to distinguish the marks, stating that its mark is an unfamiliar, coined term, unlike Registrant’s mark, which is a familiar, well-known word. We find, however, that Applicant’s mark READR is a simple misspelling of the term “reader”; this difference may not even be noticed by some consumers. Applicant’s mark READR and Registrant’s mark READER differ by only one letter and, thus, are similar in

appearance. Even with the one letter difference, the marks still are identical in sound, as conceded by Applicant.

As to meaning, the term “reader” is defined, in pertinent part, in terms of “optical scanning”: “the process of interpreting data in printed, handwritten, bar-code, or other visual form by a device (optical scanner or reader) that scans and identifies the data.” (<dictionary.com>) (Response, 10/7/12). Both marks convey the idea that the computer software sold thereunder serves or functions as a “reader.” Given these similarities, the marks engender substantially similar overall commercial impressions.

The similarity between the marks weighs in favor of a finding of likelihood of confusion.

Applicant’s principal argument focuses on the sixth *du Pont* factor, namely the number and nature of similar marks in use on or registered for similar goods. Applicant perceives the cited mark to be “weak” and “diluted” due to “the extensive use of the terms READ/READER by third parties, particularly in connection with software.” (Brief, unnumbered p. 4). Thus, Applicant concludes, consumers are not likely to believe that all goods associated with a mark containing the terms READ or READER emanate from the same source. In connection with this argument, Applicant submitted over sixty third-party registrations of marks that include the term “READER” covering software.<sup>5</sup> Although we have considered Applicant’s

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<sup>5</sup> Throughout prosecution and in its brief, Applicant makes reference (without any particulars) to hundreds of third-party registrations of READ and READER-formative marks for software in Class 9. To make a third-party registration of record, a copy of the registration, either a copy of the paper USPTO record, or a copy taken from the electronic

evidence of the third-party registrations, it is of limited probative value to support Applicant's position because "[t]he existence of [third-party] registrations is not evidence of what happens in the marketplace or that consumers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive." *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010). In any event, none of these registrations is as close in sound, appearance, meaning and commercial impression to the cited registered mark as is Applicant's applied-for mark. As pointed out by the Examining Attorney, "these third-party registrations all include additional distinctive terminology in addition to the word 'reader,'" and "[u]nlike these third-party registrations, [A]pplicant seeks to register the single word READR with no other distinctive elements." (Brief, unnumbered p. 4).

Nevertheless, it is clear that Registrant's mark READER is, at the very least, highly suggestive for computer programs for use in viewing electronic documents.<sup>6</sup>

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records of the Office, should be submitted during prosecution/examination of the application. Thus, Applicant's mere reference to other third-party registrations is insufficient to make them of record for our consideration. See TBMP § 1208.02 (3d ed. rev.2 2013). We have considered only those third-party registrations for which copies were timely submitted during prosecution of the application.

<sup>6</sup> To the extent that Applicant contends that Registrant's mark is merely descriptive, this argument is impermissible. Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in connection with the goods and/or services identified in the certificate. During *ex parte* prosecution, including an *ex parte* appeal, an applicant will not be heard on matters that constitute a collateral attack on the cited registration. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992). See TMEP §



In this connection we have given some weight to the third-party registration evidence to show the meaning of the marks READR and READER (as indicated earlier) in the same way that dictionaries are used. *See Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 914, 189 USPQ 693, 696 (CCPA 1976); *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1518 (TTAB 2009). Thus, the third-party registrations show that the commonly registered term “reader” has a suggestive or descriptive significance for computer software such that differences between two marks may be sufficient to render the marks as a whole distinguishable.

In the present case, however, the marks READR and READER are extremely similar as discussed above. The Federal Circuit and the Board have recognized that weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 73 USPQ2d at 1693; *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1026 (TTAB 2009); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1957-58 (TTAB 2006); *In re Cent. Soya Co.*, 220 USPQ 914, 916 (TTAB 1984). Nevertheless, even a weak mark is entitled to protection against the registration of a similar mark for closely related goods as is the situation in the present case. *See King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401 182 USPQ 108, 109 (C.C.P.A. 1974).

Although Registrant’s mark is entitled to a narrow scope of protection, that scope is wide enough to cover Applicant’s similar mark for similar goods. That is to

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1207.01(d)(iv). Accordingly, no consideration has been given to applicant’s arguments in this regard.

say, the similarities between the marks and goods sold thereunder outweigh any inherent weakness of the cited mark. *See In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49 (Fed. Cir. 1986). We conclude that consumers familiar with Registrant's "computer software for page recognition and rendering for use in viewing, printing, navigating, editing, annotating and indexing electronic documents" sold under the mark READER would be likely to mistakenly believe, upon encountering Applicant's mark READR for "computer application software for mobile phones, portable media players and portable computers, namely, software for viewing digital magazines," that the goods originated from or are associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by Applicant raises a doubt about likelihood of confusion, we must resolve it in favor of the prior Registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *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.