

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: October 16, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Cardeologie, Inc.

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Serial No. 85826725

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Natah C. Belzer of Belzer PC for Cardeologie, Inc.

Nakia D. Henry, Trademark Examining Attorney, Law Office 117 (Hellen Bryan-Johnson, Managing Attorney).

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Before Quinn, Shaw, and Gorowitz,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Cardeologie, Inc. (“Applicant”) filed an application to register the mark CARDEOLOGIE (in standard characters) for “greeting cards, invitation cards, notecards, postcards” in International Class 16; and “retail store services featuring greeting cards, notecards, invitation cards, postcards and gift items” in International Class 35.¹

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,

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¹ Application Serial No. 85826725, filed January 18, 2013 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging first use anywhere and first use in commerce on November 2, 2012.

when used in connection with Applicant's goods and services, so resembles the previously registered mark shown below

CARDologists

(in standard character form) for “announcement cards; blank cards; blank note cards; cards bearing universal greetings; cards, namely, greeting cards, holiday cards, invitation cards, inspirational greeting cards, place cards, and blank cards; paper containers for cards, namely, paper boxes and paper mache boxes; Christmas cards; correspondence cards; gift cards; greeting cards; holders specially adapted for holding greeting cards; holiday cards; motivational cards; note cards; occasion cards; packaging, namely blister cards; paper boxes for storing greeting cards; place cards; social note cards” in International Class 16,² as to be likely to cause confusion.

When the refusal was made final, Applicant appealed. Applicant and the Examining Attorney filed briefs.

Applicant argues that the marks are distinguishable, that Applicant's services are not related to Registrant's goods, and that the mark in the cited registration is weak and entitled to a narrow scope of protection. In support of its arguments, Applicant submitted a printout of a TESS (Trademark Electronic Search System) report (Exhibit A), a listing from Wikipedia (Exhibit B), a translation retrieved from Google's website (Exhibit C), a listing from Wiktionary (Exhibit D), and a copy of an unpublished Board decision (Exhibit E).

² Registration No. 3463847, issued July 8, 2008; Section 8 affidavit accepted.

The Examining Attorney maintains that the marks are similar, and that the goods are identical in part, and that the goods and services are related. In support of the refusal the Examining Attorney introduced dictionary definitions,³ and excerpts of a third-party's website.

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 initially consider the second *du Pont* factor regarding the similarity/dissimilarity between Applicant's goods and services and Registrant's goods. It is well settled that the goods and/or services of Registrant and Applicant 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 and/or services of Registrant and Applicant are related in some manner, and/or that the conditions and activities surrounding the marketing of the

³ One of these definitions is attached to the Examining Attorney's brief, and of which the Examining Attorney requested the Board to take judicial notice. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006). *See In re Thomas White Int'l Ltd.*, 106 USPQ2d 1158, 1160 n.1 (TTAB 2013).

goods and/or 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 originate from the same source. *See Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993). The issue here, of course, is not whether purchasers would confuse the goods and/or services, but rather whether there is a likelihood of confusion as to the source of these goods and/or services. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). Likelihood of confusion must be found if there is likely to be confusion with respect to *any* item in a class that comes within the identification of goods and/or services in the application and cited registration. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007).

Applicant's goods include "greeting cards," "invitation cards," and "note cards." Each of these items also is listed in Registrant's identification of goods and, thus, the goods are identical in part.

Applicant's retail store services feature these same goods, namely greeting cards, invitation cards and note cards; as just noted, these goods are identical to the ones identified in the cited registration. Accordingly, Registrant's goods and Applicant's retail services featuring the identical goods are related for purposes of the likelihood of confusion analysis. It is well recognized that confusion may be likely to occur from the use of the same or similar marks for goods, on the one hand,

and for services involving those goods, on the other. *See, e.g., In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (holding BIGG'S (stylized) for retail general merchandise store services and BIGGS and design for furniture likely to cause confusion); *In re H.J. Seiler Co.*, 289 F.2d 674, 129 USPQ 347 (CCPA 1961) (holding SEILER's for catering services and SEILER'S for smoked and cured meats likely to cause confusion); *In re United Serv. Distribs., Inc.*, 229 USPQ 237 (TTAB 1986) (holding mark consisting of a design featuring silhouettes of a man and woman used in connection with distributorship services in the field of health and beauty aids and mark consisting of a design featuring silhouettes of a man and woman used in connection with skin cream likely to cause confusion); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (holding 21 CLUB for various items of clothing and THE "21" CLUB (stylized) for restaurant services likely to cause confusion); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (holding CAREER IMAGE (stylized) for retail women's clothing store services and CREST CAREER IMAGES (stylized) for uniforms likely to cause confusion). Indeed, Applicant itself offers both greeting cards and retail store services featuring greeting cards under the same mark.

Insofar as the trade channels and purchasers are concerned, because the goods identified in the application and the cited registration are in part legally identical, we must presume that the channels of trade and classes of purchasers are the same. *See In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and

classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion). The goods are likely to be sold through the same trade channels (*e.g.*, greeting card stores, stationery stores, online retailers of cards and stationery) to the same classes of purchasers (*e.g.*, ordinary consumers).

The similarity between Applicant's goods and services, and Registrant's goods, the identical or otherwise similar trade channels, and the overlap in purchasers are factors that weigh in favor of a finding of likelihood of confusion.

With respect to the marks, we must compare the marks in their entireties 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, 1691 (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 Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). In comparing the marks when used in connection with Applicant's and Registrant's goods, we are mindful that where, as here, the goods are in part legally identical, the degree of similarity between the marks necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007). This legal maxim does not apply, of course, with respect to a comparison between the marks for Applicant's services and Registrant's goods.

Applicant points out in exacting detail the differences between the marks. Although there are specific differences between the marks, Applicant's mark CARDEOLOGIE and Registrant's mark CARDologists are similar in appearance and sound. Prospective purchasers are likely to perceive the marks as misspelled plays on the commonly recognized words "cardiology" and "cardiologists," respectively. The word "cardiology" means "the medical study of the structure, function, and disorders of the heart." The word "cardiologist" is defined as "a doctor who studies the heart and deals with the diseases that affect it."

(<education.yahoo>). The suffix “-ology” means “a combining form [suffix] used in the names of sciences or bodies of knowledge,” and the suffix “-logist” means “a person who studies or is an expert in the related ‘-logy.’” (<Wikipedia.com> and <Wiktionary.com>). In addition, the respective marks playfully suggest the study of cards, and one whose specialty is the study of cards, whether greeting cards, notecards, invitation cards or otherwise; stated differently, both suggest an expertise in such cards. Thus, the marks likewise are similar in meaning when used in connection with cards or retail store services featuring cards. Given all of these similarities, the marks engender similar overall commercial impressions, especially when considered in the context of identical goods and related goods and services.

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

In connection with the sixth *du Pont* factor involving the number and nature of similar marks in use on similar goods and/or services, Applicant argues that the cited mark is weak and entitled to only a narrow scope of protection, relying on a TESS printout of 285 third-party registrations of marks that include “CARD” for greeting cards. During prosecution, Applicant did not furnish copies of any of the listed registrations. The Examining Attorney waited until the brief to object “to this evidence because the proposed registrations were incorrectly attached.” (6 TTABVue 13).

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 records of the

Office, should be submitted during prosecution of the application. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372-73 (TTAB 2006). Thus, the mere submission of the TESS search results listing the third-party registrations, without copies of the registrations, is insufficient to make the registrations of record. Inasmuch as the Examining Attorney did not advise Applicant that the TESS search report is insufficient to make the registrations of record at a point when Applicant could have corrected the error, the Examining Attorney is deemed to have waived any objection to consideration of the list itself, for whatever probative value it may have. *See In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013). However, the mere listing of the registrations in the TESS search report, showing only the registration number, registered mark and whether the registration is live/dead, is entitled to very little probative weight. *See In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1264 n.6 (TTAB 2011).

Even if the registrations themselves had been submitted, the evidence would be 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 market place 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). Even a weak mark is entitled to protection against the registration of a similar mark for related goods and/or services.

Notwithstanding the very limited probative value of the TESS printout, we acknowledge that the “CARD” portion of Applicant’s and Registrant’s marks when considered by itself is descriptive, a fact borne out by the printout and the common meaning of the word “card.” But when “CARD” is combined with the “-eologie” and “-ologists” portions of the respective marks, the entire marks are suggestive and, as we indicated above, convey the same or very similar suggestion. *See In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009).

We have carefully considered all of the evidence made of record pertaining to the issue of likelihood of confusion, as well as all of the arguments related thereto, including any evidence and arguments not specifically discussed in this opinion. We conclude that purchasers familiar with Registrant’s “announcement cards; blank cards; blank note cards; cards bearing universal greetings; cards, namely, greeting cards, holiday cards, invitation cards, inspirational greeting cards, place cards, and blank cards; Christmas cards; correspondence cards; greeting cards; holiday cards; motivational cards; note cards; occasion cards” sold under the mark CARDologists would be likely to mistakenly believe, upon encountering Applicant’s mark CARDEOLOGIE for “greeting cards, invitation cards, notecards, postcards” and “retail store services featuring greeting cards, notecards, invitation cards, postcards and gift items,” that the goods and/or services originate from or are associated with or sponsored by the same entity.

Decision: The refusal to register is affirmed.