

This Opinion is not a
Precedent of the TTAB

Mailed: April 12, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

In re FiftyThree, Inc.
—

Serial No. 86180291
—

Stacey J. Watson of Markery Law LLC,
for FiftyThree, Inc.

Robert Clark, Trademark Examining Attorney, Law Office 101,
Ronald R. Sussman, Managing Attorney.

—
Before Bergsman, Gorowitz and Heasley,
Administrative Trademark Judges.

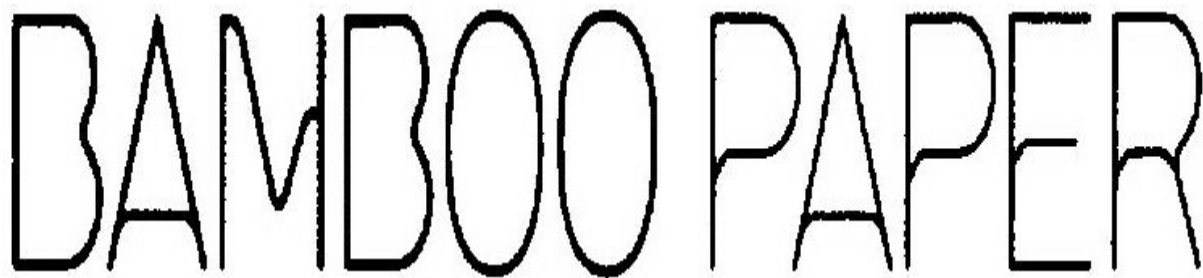
Opinion by Bergsman, Administrative Trademark Judge:

FiftyThree, Inc. (“Applicant”) seeks registration on the Principal Register of the mark PAPER (in standard characters) for “computer application software for smart phones and tablets, namely, software for use in writing on smart phones and tablets with either a stylus or finger and sharing that content with others via a social network,” in Class 9.¹ Applicant claimed ownership of Registration No. 4457350 for

—
¹ Application Serial No. 86180291 was filed on January 30, 2014, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as March 29, 2012.

the mark PAPER BY FIFTYTHREE (in standard characters) for the same description of goods.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the registered mark BAMBOO PAPER and design, shown below,

The image shows the words "BAMBOO PAPER" in a large, hand-drawn, slightly irregular font. The letters are black and have a sketchy, artistic quality. The word "BAMBOO" is followed by a space and then the word "PAPER".

for, the goods set forth below, as to be likely to cause confusion:

Coordinate input devices for computers; computer cursor control devices, namely, digitizer tablets; input tablets for computers; electronic pens in the nature of visual display units; touch panels for computers; electronic whiteboards; input devices for computers; data processing apparatus; software for computer input, namely, computer software for operating a coordinate inputting system and for drawing, painting; computer software for recording and processing input information; electronic machines, apparatus and parts therefor, namely, computer peripheral devices; computer hardware and software for recording hand-written digital signature; computers; telecommunication machines and apparatus, namely, telecommunication terminals; personal digital assistants; image processing software; television apparatus, namely, televisions; digital cameras; liquid-crystal displays; optical discs, namely, blank optical discs, magnetic discs, namely, blank magnetic discs; calculating machines; downloadable electronic publications, namely, magazines and books in the field of computers, art and music; game programs for home video game machines; electronic circuits and CD-ROMs recorded with programs for hand-held video games

with liquid crystal displays; cases especially made for tablet computers; touch panels for PDA (personal digital assistants), in Class 9.²

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We reverse the refusal to register.

Our determination under Section 2(d) is based on 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, 567 (CCPA 1973) (“*du Pont*”) cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 135 S.Ct.1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *du Pont* factor that is relevant and for which there is evidence of record. See *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). 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 *In re Chatam Int’l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The

² Registration No. 4643067, registered November 25, 2014. As the filing basis for the application for this registration, Registrant requested an extension of protection under Section 66 of the Trademark Act, 15 U.S.C. § 1141f.

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.”); *see also In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015).

A. The similarity or dissimilarity and nature of the goods.

Applicant is seeking to register its mark PAPER for “computer application software for smart phones and tablets, namely, software for use in writing on smart phones and tablets with either a stylus or finger and sharing that content with others via a social network.” According to Applicant’s counsel, “[t]his app enables users to sketch, draw, diagram and write on an iPad, and then share their works with friends and colleagues through social media.”³ Counsel’s explanation is corroborated by the review posted on the Que website (quepublishing.com), “Using a Bluetooth Stylus with the iPad3 (The New iPad)” (May 29, 2012), which describes Applicant’s PAPER as “a drawing and sketching tool.”⁴

When the app launches, you’ll see several blank virtual notebooks displayed. ...

When you tap on a notebook to open it, what’s revealed are blank pages. Tap on any blank page to access the drawing tools offered within the app, which include a simulated fountain pen, sketch pencil, felt-tip marker, ballpoint pen, paintbrush and eraser. Choose your writing instrument, and then tap on an ink color. ...

Using your stylus or finger, simply begin writing or drawing on each blank page of the notebook. Swipe your finger from right to left, or from left to right, to turn the

³ Applicant’s Brief, p. 24 (7 TTABVUE 25).

⁴ December 17, 2015 Office Action, TSDR, pp. 26-27. All references to TSDR citations are to documents in the .pdf format.

page of the notebook, or perform a pinch motion with your fingers to exit the drawing/writing mode.⁵

An advertisement on the iTunes website (itunes.apple.com) describes Applicant's

PAPER software as follows:

Paper – Notes, Photo Annotation, and Sketches by
FiftyThree

By FiftyThree, Inc.

* * *

Description

When inspiration happens, put it on Paper. Paper is the best way to capture and connect your notes, photos, and sketches. Create checklists, spotlight details in photos, and sketch diagrams with unbeatable speed and ease – Paper is like a wall of sticky notes for everything that inspires you.⁶

Turning to Registrant's mark BAMBOO PAPER, it is registered for, as particularly relevant, the products listed below:

Coordinate input devices for computers; computer cursor control devices, namely, digitizer tablets; input tablets for computers; electronic pens in the nature of visual display units; touch panels for computers; electronic whiteboards; input devices for computers; data processing apparatus; software for computer input, namely, computer software for operating a coordinate inputting system and for drawing, painting; computer software for recording and processing input information...

⁵ *Id.*

⁶ December 17, 2015 Office Action, TSDR p. 14.

Registrant's website (wacom.com) explains that its BAMBOO PAPER turns "your tablet into a paper notebook."⁷ An advertisement posted on the iTunes website (itunes.apple.com) describes Registrant's BAMBOO PAPER as follows:

Bamboo Paper – Notebook

By Wacom

* * *

Description

Turn your iPad into a paper notebook and capture your ideas everywhere, anytime. Taking, notes, sketching, and drawing is as straightforward and simple as using real pen and paper.⁸

Both Applicant's computer application software and Registrant's "electronic whiteboards ... data processing apparatus; software for computer input, namely, computer software for operating a coordinate inputting system and for drawing, painting; computer software for recording and processing input information" identify digital notebooks that simulate paper notebooks. Thus, the goods are in part identical.

B. Established, likely-to-continue channels of trade.

Because the goods described in the application and the cited registration are in part identical, we must presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in same channels of trade to

⁷ December 17, 2015 Office Action, TSDR p. 49. *See also* the June 5, 2015 Office Action, TSDR p. 7.

⁸ December 17, 2015 Office Action, TSDR p. 10. *See also* TSDR p. 58.

same class of purchasers); *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); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011).

C. The number and nature of similar marks in use on similar goods.

The point of similarity between the marks is the word “Paper.” It is the entirety of Applicant’s mark and the noun modified by the adjective BAMBOO in the registered mark. Applicant contends that the numerous third-party users of marks consisting, in whole or in part, of the word “Paper” and the numerous third-party registrations incorporating the word “Paper” prove that “Paper” is a weak term, for the products in issue and is entitled to only a narrow scope of protection or exclusivity of use.⁹ “Marks that are descriptive or highly suggestive are entitled to a narrower scope of protection, *i.e.*, are less likely to generate confusion over source identification, than their more fanciful counterparts.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (citing *Drackett Co. v. H. Kohnstamm & Co.*, 404 F.2d 1399, 160 USPQ 407, 408 (CCPA 1969) (“The scope of protection afforded such highly suggestive marks is necessarily narrow and confusion is not likely to result from the use of two marks carrying the same suggestion as to the use of closely similar goods.”)).

⁹ Applicant’s Brief, pp. 14-21 (7 TTABVUE 15-22).

The following third-party uses consisting of the word “Paper” for products related to digital notebooks have been made of record:

1. **Pen and Paper** is an “app that allows you to combine multi-colored on-screen handwriting, sketches, and drawings with typed notes in order to create virtual notebooks.”¹⁰
2. **PAPERLESS DRAW** is identified as being similar to **Pen and Paper**.¹¹
3. **ePaper** is a “Sketch, Write, Paint and Take Notes on a Digital Paper Notebook.”¹² The description of this “app” includes a comparison to Applicant’s **PAPER** application (“If you want an app just like the top-rated ‘Paper’ app, but much better with more brushes, undo and ...”).

In addition to the evidence of use, in the May 6, 2014 Office Action, the Trademark Examining Attorney refused to register Applicant’s mark under Section 2(d) citing thirteen third-party registrations. The nine relevant registrations are listed below.¹³ Although that refusal was withdrawn in the November 17, 2014 Office Action, we use these registrations in the manner of a dictionary to show how the word “Paper” is

¹⁰ “Using a Bluetooth Stylus with the iPad 3 (The New iPad),” Que website (quepublishing.com) (May 29, 2012) attached to the December 17, 2015 Office Action, TSDR pp. 26-27. *See also* Google.com/store attached to the November 17, 2014 Office Action, TSDR p. 7 advertising the Pen & Paper app.

¹¹ The Google.com/store website advertised Paperless-Draw as a similar app. *See* the November 17, 2014 Office Action, TSDR p. 9.

¹² iTunes website (itunes.apple.com) attached to the November 17, 2014 Office Action, TSDR p. 4. The iTunes website noted that customers who bought PAPER by miSoft also bought ePaper-Sketch.

¹³ Registration No. 1951474 for the mark PAPER DIRECT and design, Registration No. 2559182 for the mark PAPERDIRECT, Registration No. 4156253 for the mark PaperC, and Registration No. 4152924 for the mark CLOUDPAPERS are registered for goods and services that are not remotely related to Applicant’s description of goods.

used for products such as those involved in this case. *See Juice Generation*, 115 USPQ2d at 1675 (quoting 2 **McCarthy on Trademarks and Unfair Competition** § 11:90 (4th ed. 2015) (“Third party registrations are relevant to prove that some segment of the composite mark which both contesting parties use has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusions that that segment is relatively weak.”)); *see also Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976) (even if “there is no evidence of actual use” of marks in “third-party registrations,” such registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used”).¹⁴ In other words, when the word “Paper” is part of a mark for the goods or services identified below, it suggests that the products or services may serve as some sort of paper substitute.

Mark	Reg. No.	Relevant Goods/Services
PAPER WARE	1834389	Software for use in document management
PAPERS	1994581	Computer software for hospitals and other medical businesses for use as a patient and health care/insurance provider electronic record system
PAPERDISK	2032916	Computer software for use in storing digital data on paper
PC PAPERS	2200752	Computer software for generating resumes, invitations and the like (“Papers” disclaimed)

¹⁴ While we may assume that use-based registrations issued only after their owners asserted to the USPTO that the marks were in use, the registrations themselves do not directly demonstrate that the marks are in fact present in the marketplace, the extent to which they have been used, or the extent to which customers have been exposed to them.

Mark	Reg. No.	Relevant Goods/Services
PUBLISH PAPER	3742586	Computer programs and software for creating customized on-line documents, reports, brochures, guides and newspapers
TECH PAPERS	3950327	Hosting a website through which business and technology professionals can receive or view whitepapers and other business-to-business content
PAPER DIRECT	3937561	Software for word processing, document formatting and presentation creation
BOARD PAPERS	4097384	Computer software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data
IPAPERZ	4498985	Downloadable software in the nature of a mobile application for the searching, sharing and viewing of news

The third-party uses of marks consisting of the word “Paper,” in whole or in part, and the third-party registrations for marks consisting of the word “Paper” in connection with computer applications allowing for the substitution of digital data for writing or drawing on paper are sufficient to prove that the word “Paper” has been extensively adopted, registered and used as a trademark or part of a trademark for computer software or related goods and services of this type.¹⁵ As a result, a mark comprising, in whole or in part, the word “Paper” in connection with such goods or services should be given a restricted scope of protection. *See Anthony's Pizza & Pasta*

¹⁵ The Trademark Examining Attorney agrees, having asserted that “[t]he word ‘PAPER’ in each mark brings to mind the same idea of using the goods to write, sketch and take notes like one would with pen and paper.” Trademark Examining Attorney’s Brief, 9 TTABVue 6.

Int'l Inc. v. Anthony's Pizza Holding Co., 95 USPQ2d 1271, 1278 (TTAB 2009), *aff'd*, 415 Fed. Appx. 222 (Fed. Cir. 2010) (cited in *Juice Generation*, 115 USPQ2d at 1675).

In this regard, we note that Applicant is the owner of Registration No. 4457350 for the mark PAPER BY FIFTYTHREE (in standard characters) for the same goods as are in the application at issue.¹⁶ This registration, in conjunction with the evidence of the third-party uses and registrations discussed above, leads us to the following conclusions:

- Registrant was satisfied to register its mark BAMBOO PAPER and design side-by-side with all the other PAPER marks by requesting an extension of protection under Section 66 of the Trademark Act, 15 U.S.C. § 1141f;
- The USPTO has been registering PAPER marks for computer software and related services for creating and utilizing digital data so long as there has been some difference between the marks as a whole or between the goods or services; and
- The number of registrations for various PAPER marks reflects a determination by the USPTO that various PAPER marks can be used and registered side-by-side without causing confusion, provided there are minimal differences between the marks and the goods or services.

¹⁶ Registration No. 4457350 for the mark PAPER BY FIFTYTHREE was registered on December 31, 2013, based on an application filed May 11, 2012 and published for opposition on October 15, 2013. By contrast, the mark in the cited registration (Registration No. 4643067) was registered on November 25, 2014, based on an application filed August 12, 2013.

See In re Hartz Hotel Servs. Inc., 102 USPQ2d 1150, 1153 (TTAB 2012) (citing *Plus Prods. v. Natural Organics, Inc.*, 204 USPQ 773, 779 (TTAB 1979); *Jerrold Electronics Corp. v. The Magnavox Company*, 199 USPQ 751, 758 (TTAB 1978) (third-party registrations “reflect a belief, at least by the registrants, who would be most concerned about avoiding confusion and mistake, that various ‘STAR’ marks can coexist provided that there is a difference.”); *In re Sien Equipment Co.*, 189 USPQ 586, 588 (TTAB 1975) (the suggestive meaning of the word “Brute” explains the numerous third-party registrations incorporating that word with other wording or material no matter how little additional significance they may add to the word “Brute” *per se*)).

We find that Registrant’s mark BAMBOO PAPER and design is not entitled to such a broad scope of protection so as to bar the registration of every mark comprising, in whole or in part, the word “Paper,” or variations thereof; it will only bar the registration of marks “as to which the resemblance to [Registrant’s mark] is striking enough to cause one seeing it to assume that there is some connection, association or sponsorship between the two.” *Anthony’s Pizza & Pasta*, 95 USPQ2d at 1278 (quoting *Pizza Inn, Inc. v. Russo*, 221 USPQ 281, 283 (TTAB 1983)).

D. The similarity or dissimilarity of the marks.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. The marks have the word “Paper” in common. However, as noted above, the word

“Paper,” when used as a mark or part of a mark for software for creating and utilizing digital data, is a weak term, entitled to a very narrow scope of protection.

The Examining Attorney contends that the word “BAMBOO in registrant’s mark modifies ‘PAPER’ in effect, telling which kind of paper it is, and therefore emphasizes the ‘PAPER’ portion, itself an arbitrary term as applied to the goods at issue.”¹⁷ To the extent the Examining Attorney is arguing that PAPER is the dominant term in the registrant’s mark and the entirety of Applicant’s mark, thereby making confusion more likely, we disagree. As we have discussed, “Paper” is a weak term for the involved goods, and thus we view BAMBOO as the dominant term in Registrant’s mark.

The record establishes that Registrant uses BAMBOO to identify the source of a line of products related to software for creating digital data and accessories for creating digital data. For example, Registrant uses BAMBOO as a standalone mark, as shown below, on its stylus used in connection with its BAMBOO PAPER and BAMBOO SMART software.¹⁸



¹⁷ Examining Attorney’s Brief, 9 TTABVUE 6.

¹⁸ Applicant’s June 17, 2016 Request for Reconsideration (4 TTABVUE 63). *See also* 4 TTABVUE 37, 44, 47, 54, 55, 64 and 66.

In the text of Registrant's website, Registrant refers to its stylus as the "Bamboo stylus."¹⁹ Also, Registrant promotes "Tips and News from Bamboo" explaining that "From inspiration to execution. Bamboo is here to help you make your ideas happen."²⁰

Other examples of Registrant using BAMBOO to identify items in its line of products are listed below:

1. Registrant uses the marks BAMBOO SMART,²¹ BAMBOO PAPER,²² and BAMBOO LOOP,²³ all shown below, for software for capturing digital data.

BAMBOO™ Smart

BAMBOO™ Paper

BAMBOO™ LOOP

¹⁹ Applicant's June 17, 2016 Request for Reconsideration (4 TTABVUE 65). *See also* 4 TTABVUE 74 ("Bamboo Stylus solo").

²⁰ Applicant's June 17, 2016 Request for Reconsideration (4 TTABVUE 58).

²¹ Applicant's June 17, 2016 Request for Reconsideration (4 TTABVUE 32). Registrant advertises that "[t]he precision and accuracy of the Bamboo Smart is only matched by your pen and paper writing." (4 TTABVUE 33).

²² Applicant's June 17, 2016 Request for Reconsideration (4 TTABVUE 38). *See also* 4 TTABVUE 101.

²³ Applicant's June 17, 2016 Request for Reconsideration (4 TTABVUE 96).

2. Registrant uses the marks BAMBOO FINELINE 2,²⁴ BAMBOO SOLO,²⁵ BAMBOO DUO,²⁶ BAMBOO ALPHA,²⁷ and BAMBOO STYLUS,²⁸ all shown below, to identify a particular stylus used in connection with its BAMBOO PAPER and BAMBOO SMART software.

BAMBOO™ Fineline 2

BAMBOO™ Solo

BAMBOO™ Duo

BAMBOO™ Alpha

BAMBOO™
STYLUS mini

We find that the marks are distinguishable because BAMBOO is the dominant part of Registrant's mark and Applicant's mark PAPER is very weak because it is highly suggestive, if not descriptive. *See Knight Textile Corp. v. Jones Investment Co.*,

²⁴ Applicant's June 17, 2016 Request for Reconsideration (4 TTABVUE 52).

²⁵ Applicant's June 17, 2016 Request for Reconsideration (4 TTABVUE 72). *See also* 4 TTABVUE 54.

²⁶ Applicant's June 17, 2016 Request for Reconsideration (4 TTABVUE 62).

²⁷ Applicant's June 17, 2016 Request for Reconsideration (4 TTABVUE 82).

²⁸ Applicant's June 17, 2016 Request for Reconsideration (4 TTABVUE 92).

75 USPQ2d at 1316. *See also New England Fish Co. v. The Hervin Co.*, 511 F.2d 562, 184 USPQ 817, 819 (CCPA 1975) (“there is no arbitrary rule of law that if two product marks are confusingly similar, likelihood of confusion is not removed by use of a company or housemark in association with the product mark. Rather, each case requires a consideration of the effect of the entire mark including any term in addition to that which closely resembles the opposing mark.”); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1478 (TTAB 2014) (“The addition of matter has been found sufficient to distinguish the marks under circumstances where the common element is descriptive or highly suggestive and/or has been frequently used and/or registered by others in the same or related fields.”); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1076 (TTAB 2011) (because the shared term “Elements” is suggestive, consumers viewing applicant’s mark ZU ELEMENTS will “focus on the larger, more prominent and more distinctive term, ZU, while attributing a meaning to the latter, smaller term ELEMENTS that is suggestive of apparel items.”); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1364 (TTAB 2007); *In re Christian Dior, S.A.*, 225 USPQ 533, 534 (TTAB 1985) (“where ... the product marks in question are highly suggestive or merely descriptive or play upon commonly used or registered terms, the addition of a housemark and/or other material to the assertedly conflicting product mark has been determined sufficient to render the marks as a whole sufficiently distinguishable.”)

We find that Applicant’s mark PAPER and Registrant’s mark BAMBOO PAPER and design are sufficiently different to avoid likelihood of confusion. We recognize

that Applicant's mark differs from the cited mark by only Registrant's inclusion of the word "Bamboo." However, because of the highly suggestive nature of the word "Paper," the proliferation of registered marks consisting in part of the word "Paper," and the unregistered uses of PAPER marks in connection with digital notebooks, Applicant's use of the word "Paper" as its mark is sufficiently different from the registered mark BAMBOO PAPER to avoid finding a likelihood of confusion..

Accordingly, we find that Applicant's mark PAPER for "computer application software for smart phones and tablets, namely, software for use in writing on smart phones and tablets with either a stylus or finger and sharing that content with others via a social network" is not likely to cause confusion with Registration No. 4643067 for the mark BAMBOO PAPER and design for, *inter alia*, "electronic whiteboards ... data processing apparatus; software for computer input, namely, computer software for operating a coordinate inputting system and for drawing, painting; computer software for recording and processing input information."

Decision: The refusal to register Applicant's mark PAPER is reversed.