

<p>This Opinion is Not a Precedent of the TTAB</p>

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sloane Construction Inc.

Serial No. 86441206

Gene Bolmarcich, Esq.
for Sloane Construction Inc.

Betty Chang, Trademark Examining Attorney, Law Office 115,
John Lincoski, Managing Attorney.

Before Quinn, Lykos and Kuczma,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Sloane Construction Inc., doing business as Sloane Painting (“Applicant”), seeks registration on the Principal Register of the mark THE TANNERY (in standard characters) for “tanning salons and skin tanning services for humans for cosmetic purposes” in International Class 44.¹

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, when

¹ Application Serial No. 86441206, filed October 31, 2014, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging first use anywhere and first use in commerce on March 23, 2012.

used in connection with Applicant's services, so resembles the previously registered mark CELSIUS TANNERY (in typed letters) for "tanning salon services" in International Class 42,² as to be likely to cause confusion.³

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

Applicant claims that the merely descriptive or suggestive nature of the shared term "TANNERY" in the marks, coupled with the presence of the additional arbitrary term "CELSIUS" in the cited registration, render the marks not confusingly similar. According to Applicant, the marks, when considered as a whole, are dissimilar. Applicant submitted a dictionary definition of the word "tannery."

The Examining Attorney maintains that the marks are similar, both sharing the term "TANNERY." Further, the Examining Attorney finds the additional term "CELSIUS" in Registrant's mark to be insufficient to distinguish the marks when they are used in connection with identical services. In support of the refusal, the Examining Attorney submitted a dictionary definition of "tannery."

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

² Registration No. 2558494, issued April 9, 2002; renewed.

³ 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) (2015).

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 and Registrant's services. In making our determination regarding the relatedness of the services, we must look to the services as identified in the application and the cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011). Both Applicant and Registrant render tanning salon services under their respective marks. Thus, we find the services to be identical, and Applicant does not contend otherwise.

Inasmuch as the services identified in the application and the cited registration are 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 Viterro 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 services are rendered

through tanning salons to the same classes of purchasers, including ordinary consumers.

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

The crux of the refusal centers on the similarity between the marks, and Applicant and the Examining Attorney have focused their attention on this first *du Pont* factor. With respect to 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, 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 services, we are mindful that where, as here, the

services are 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 services. *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).

Applicant relied upon a dictionary definition of the word “tannery”: “a place or building where skins and hides are tanned; a place where tanning is carried on.” (www.thefreedictionary.com). The Examining Attorney, with her brief, submitted a definition of “tannery” showing it defined as “a place where animal skins are made into leather.” (www.macmillandictionary.com).⁴ We take judicial notice of these additional definitions:

Tanning: the act or process of darkening your skin by exposing it to the bright light of the sun or a special type of lamp; the act or process by which a skin is tanned.

Tan: to cause (skin) to become darker especially from being exposed to the sun’s rays; to change (the skin of an animal) into leather by a chemical process.

-ery: suffix; place of doing, keeping, producing or selling (the thing specified) <fishery> <bakery> <eatery>.

Celsius: relating to, conforming to, or having the international thermometric scale on which the interval between the triple point of water and the boiling point of water is divided into 99.99 degrees with 0.01° representing the triple point and 100° the boiling point.

⁴ 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).

The: a unique member of its class; to designate one of a class as the best or most worth singling out.

(www.merriam-webster.com).

Applicant argues in its reply brief as follows:

Although the examining attorney purports to consider the marks as a whole while also giving appropriate weight to the shared portion, Applicant believes that undue weight has been given to the term “tannery” in the marks. Despite the definition of the word “tannery” that relates to animal hides, in this case, the nature of the word moves it down the spectrum of distinctiveness to a point that is just above the descriptive/suggestive line. This is because the word actually includes the formative “tann” (as in “tanning salon”) and it is a common form “XYZery,” a word that describes places that offer “XYZ.” Examples include “creamery,” “bakery,” “brewery,” “millinery” (as in “millinery shop” or a hat shop), “winery,” and “nunnery.” Consumers are accustomed to seeing words in this form where the prefix is the focus of the word and describes the essence of the thing defined by the word. To many consumers of tanning services, the connection between the word tannery and a place that tans animal hides would be lost or at least overshadowed by the descriptive portion of the word (i.e. “tan”).

(7 TTABVue 2-3)

The word “tannery” has an established meaning relative to the tanning of animal skins and changing the skins into leather. A more contemporary meaning relative to tanning salons is much less certain, and at worst, the word “tannery” is suggestive for tanning salons. Based on the record before us, especially the lack of other uses in the trade, we conclude that the word “tannery” is not merely descriptive for tanning salon services, but rather falls within the range of suggestive to highly suggestive. As is apparent from the above, the evidence before us is extremely sparse, comprising only dictionary definitions. Further, the record is

devoid of evidence of any third-party uses or registrations of similar marks utilizing the word “tannery” for tanning salon services. In this connection, the Examining Attorney stated “[the subject marks] are the only live marks in the Office’s X-Search database that include the word ‘TANNERY’ for tanning salon services” (6 TTABVUE 5); and that “[her] internet research has not revealed any use of the term [“tannery”] that is unrelated to registrant’s services.” (6 TTABVUE 8). Applicant did not dispute this characterization of the record and, indeed, there is no evidence showing that third-party tanning salons have adopted the word “tannery” or that the word has a commonly understood or recognized meaning for tanning salons. Nevertheless, we are inclined to agree with Applicant that consumers, being familiar with similarly constructed words like “brewery” and “bakery,” will perceive “tannery” as a combination of “tann” (as in “tanning”) and the suffix “-ery.” As such, consumers are likely to view the word “tannery” as suggestive when used for tanning salons.

With respect to Registrant’s mark, it is settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (“There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.”). In the cited mark, the word “CELSIUS” would appear

to be arbitrary, and is the dominant portion when compared to the suggestive word “TANNERY.” *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (“DELTA,” not the disclaimed generic term “CAFE,” is the dominant portion of the mark THE DELTA CAFE). Moreover, purchasers in general are inclined to focus on the first word or portion in a trademark; in Registrant’s mark, “CELSIUS” is the first portion. *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is likely to be impressed upon the mind of a purchaser and remembered”). *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 USPQ2d at 1692.

In addition to a difference in appearance between THE TANNERY and CELSIUS TANNERY, the presence of “CELSIUS” in the cited mark results in a mark that sounds differently from Applicant’s mark. As to meaning, we find that Applicant’s mark suggests that it is “the” or best tanning salon,⁵ while Registrant’s mark suggests a connection between heat and getting a tan. In sum, we find that the differences between the marks outweigh the similarities, and that the marks, when considered in their entirety, engender sufficiently different commercial impressions that consumers are not likely to be confused by the marks. In comparing the marks in their entirety, THE TANNERY versus CELSIUS TANNERY, the common element is the suggestive term “TANNERY”; we find that

⁵ This connotation is contrasted with the usual situation wherein the presence of “THE” in a mark is unlikely to play a role in how consumers are likely to perceive the mark. *See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (WAVE and THE WAVE are “virtually identical” and likely to be confused).

the presence of the additional arbitrary word “CELSIUS” in the cited registration is enough to distinguish the marks. *See, e.g., Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004); *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1044-45 (TTAB 2010); *Bass Pro Trademarks, L.L.C. v. Sportsman’s Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008).

Decision: The refusal to register is reversed.