

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re In re OEC, LLC

Serial Nos. 90274429 and 90350840

Gene S. Winter, St. Onge Steward Johnston & Reens LLC for OEC, LLC.

Emma Sirignano, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.

Before Lynch, Hudis, and Johnson,
Administrative Trademark Judges.

Opinion by Johnson, Administrative Trademark Judge:

OEC, LLC (“Applicant”) seeks registration on the Principal Register of the HOLIDAY ROAD¹ standard character mark, and the HOLIDAY ROAD composite mark in the form shown below (collectively, “Applicant’s Marks”), for “Online retail store services featuring bags, backpacks, blankets, holiday and seasonal decorations

¹ Application Serial No. 90274429 was filed on Oct. 23, 2020, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intent to use the mark in commerce. Applicant disclaims the exclusive right to use the word “HOLIDAY.”

and ornaments, holiday lights, toys, baskets, cups,” in International Class 35 (collectively, “Applicant’s Services”).



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The Trademark Examining Attorney refused registration of Applicant’s Marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that the marks are likely to cause confusion with the following standard character marks registered on the Principal Register by the same entity (collectively, “Cited Marks”):

² Application Serial No. 90350840 was filed on Dec. 1, 2020, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intent to use the mark in commerce. The mark is described in the application as follows: “The mark consists of the stylized word ‘HOLIDAY’ above the stylized word ‘ROAD’ with a star at the beginning, middle and end of each word, all within a circle broken into two semi-circles; atop the circle is the silhouette of a front-facing car surrounded by 4 evergreen trees, 2 on each side of the car.” Color is not claimed as a feature of the mark. Applicant disclaims the exclusive right to use the word “HOLIDAY.”

Citations to the appeal record are from the publicly available documents in TTABVUE, the Board’s electronic docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry, if applicable.

Citations to the application record are to downloadable .pdf versions of the documents in the Trademark Status and Document Retrieval (TSDR) database of the United States Patent and Trademark Office (USPTO).

- **HOLIDAY LANE**, for “musical figures and figurines made of plastic,” in International Class 20 and “musical figures and figurines made of glass,” in International Class 21;³
- **HOLIDAY LANE**, for “Christmas figures and figurines made of plastic,” in International Class 20 and “Christmas tree ornaments and decorations; Christmas garlands,” in International Class 28;⁴ and
- **HOLIDAY LANE**, for “electric Christmas tree lights,” in International Class 11⁵ (collectively, “Registrant’s Goods”).

When the refusals were made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the requests for reconsideration, the appeals proceeded. The appeals have been fully briefed. We affirm the refusals to register.

I. Appeals Consolidated

The Examining Attorney moved to consolidate the appeals (8 TTABVUE), and the Board granted the motion, based in part on the similarity of the records (9 TTABVUE). Unless otherwise indicated, we refer to the record in Serial No. 90274429 for the HOLIDAY ROAD standard character mark.

³ Registration No. 2029582 issued on Jan. 14, 1997; twice renewed. Registrant Macy’s IP Holdings, LLP disclaims the exclusive right to use the word “HOLIDAY.”

⁴ Registration No. 1985311 issued on July 9, 1996; twice renewed. Registrant Macy’s IP Holdings, LLP disclaims the exclusive right to use the word “HOLIDAY.”

⁵ Registration No. 2034376 issued on Jan. 28, 1997; twice renewed. Registrant Macy’s IP Holdings, LLP disclaims the exclusive right to use the word “HOLIDAY.”

II. Likelihood of Confusion

Section 2(d) of the Trademark Act provides that a mark must be refused registration if it “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods [or services] of the applicant, to cause confusion, or to cause mistake, or to deceive” 15 U.S.C. § 1052(d).

To determine whether there is a likelihood of confusion between the marks under Section 2(d), we analyze the evidence and arguments under the *DuPont* factors. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). We consider each *DuPont* factor for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019). “Not all *DuPont* factors are relevant in each case,⁶ and the weight afforded to each factor depends on the circumstances. ... Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at *3 (Fed. Cir. 2020). “In any likelihood of confusion analysis, two key considerations are the similarities between the marks

⁶ Applicant argues that the HOLIDAY LANE mark is not famous in the United States. *See* 6 TTABVue 14. However, the fifth *DuPont* factor, “the fame of the prior mark,” is not normally applicable in ex parte proceedings, as the owner of the cited registration (“the prior mark”) is not a party to the ex parte appeal, and the Examining Attorney is under no obligation to demonstrate the fame of the cited registered mark. *In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006). The registered mark is treated as valid and entitled to the statutory presumptions afforded by Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1517 (TTAB 2016). So, the “fame of the mark” factor generally is treated as neutral in an ex parte appeal. *See In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1086-88 (TTAB 2016).

and the similarities between the goods or services.” *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at *29 (TTAB 2021) (citing *In re Chatam Int’l Inc.*, 380 F.3d 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)).

A. The Similarity or Dissimilarity and Nature of the Goods and Services

We begin with the second *DuPont* factor, which concerns the “similarity or dissimilarity and nature of the goods [and] services as described in an application or registration.” When analyzing the second *DuPont* factor, we look to the identifications of goods and services in the applications and cited registrations. *Stone Lion Cap. Partners v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of [services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s [services], the particular channels of trade or the class of purchasers to which sales of the [services] are directed.”).

Likelihood of confusion may 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 Detroit Athletic Co.*, 903 F.3d 1297, 1307 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (finding clothing and sports apparel retail services related as “confusion is likely where one party engages in retail services that sell goods of the type produced by the other party”); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025

(Fed. Cir. 1988) (finding BIGGS for retail grocery and general merchandise store services likely to be confused with BIGGS for furniture); *In re H.J. Seiler Co.*, 289 F.2d 674, 129 USPQ 347 (CCPA 1961) (finding catering food services related to smoked and cured meats); *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *13-14 (TTAB 2019) (finding bread buns and retail bakery shops related); *In re United Serv. Distribs., Inc.*, 229 USPQ 237 (TTAB 1986) (finding skin cream and distributorship services in the field of health and beauty aids related); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949, 951 (TTAB 1986) (finding clothing and restaurant services related); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (finding retail women's clothing store services and uniforms related); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (finding refinishing of furniture, office furniture, and machinery related to office furniture and accessories); *Corinthian Broad. Corp. v. Nippon Elec. Co., Ltd.*, 219 USPQ 733 (TTAB 1983) (finding transmitters and receivers of still television pictures related to television broadcasting services).

Evidence of relatedness may include pages from third-party websites showing that the relevant goods and services are used by purchasers for the same purpose; advertisements showing that the relevant goods and services are advertised together; or copies of use-based registrations of the same mark for both Applicant's identified services and the goods listed in the cited registrations. *See, e.g., In re Detroit Athletic*, 128 USPQ2d at 1051-52; *In re Country Oven*, 2019 USPQ2d 443903, at *4-5.

Applicant's Services are "Online retail store services featuring bags, backpacks, blankets, holiday and seasonal decorations and ornaments, holiday lights, toys, baskets, cups," in International Class 35. Registrant's Goods are:

Musical figures and figurines made of plastic, in International Class 20;

Musical figures and figurines made of glass, in International Class 21;

Christmas figures and figurines made of plastic, in International Class 20;

Christmas tree ornaments and decorations; Christmas garlands, in International Class 28; and

Electric Christmas tree lights, in International Class 11.

Applicant argues that there is no *per se* rule that the goods and services are related, and that the products and services are different in nature and used for different purposes. (Applicant's Appeal Brief, 6 TTABVUE 9). However, we find that the goods at issue in classes 20, 21, and 28, and the services at issue in class 35 are highly related, inasmuch as Applicant's online retail store services feature holiday and seasonal decorations and ornaments, which would encompass Registrant's musical figures and figurines⁷ made of glass, musical figures and figurines made of plastic, Christmas figures and figurines made of plastic, Christmas tree ornaments and decorations, and Christmas garlands. We also find that the goods in class 11 and


⁷ A "figurine" is "a small ornamental figure of pottery, metal, plastic, etc.; statuette." COLLINS ENGLISH DICTIONARY (2022) (www.collinsdictionary.com/us/dictionary/english/figurine) (last accessed Nov. 28, 2022). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re tapio GmbH*, 2020 USPQ2d 11387, at *3 n.10 (TTAB 2020).

the services in class 35 overlap, inasmuch as Applicant’s online retail store services also feature holiday lights, which would encompass Registrant’s electric Christmas tree lights.

To show that the goods and services are related, the Examining Attorney made of record evidence from the USPTO’s X-Search database⁸ consisting of third-party marks registered for use in connection with the same or similar goods and services offered under Applicant’s Marks and the cited registrations:

<u>Reg. No.</u>	<u>Registered Mark</u>	<u>Relevant Goods/Services</u>
6450401	 <p>(“CHRISTMAS LIGHTS FACTORY” disclaimed)</p>	<p>“Outdoor lighted Christmas-themed ornaments not Christmas tree decorations; lights, electric, for Christmas trees; electric lights for Christmas trees; string lights for festive decoration; lamps for festive decoration; fairy lights for festive decoration; led light bulbs; LED light strips for decorative purposes,” in International Class 11.</p> <p>“On-line wholesale store and retail store services featuring festive decorations; retail store and online retail store services in relation to festive decorations; wholesale store and online wholesale store services in relation to festive decorations,” in International Class 35.</p>

⁸ Nov. 30, 2021 Final Office Action, pp. 13-43. The Examining Attorney also cited Registration

No. 2495612, for , and Registration No. 4809789, for NEST & NOEL, both of which are cancelled. Cancelled or expired registrations have no probative value other than to show that they once issued; they are not entitled to any of the statutory presumptions of Section 7(b) of the Trademark Act, including the presumption of an exclusive right to use the marks. *Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“a canceled registration does not provide constructive notice of anything”); *In re Kysela Pere et Fils*, 98 USPQ2d 1261, 1264 (TTAB 2011) (“dead’ or cancelled registrations have no probative previous value at all”).

<u>Reg. No.</u>	<u>Registered Mark</u>	<u>Relevant Goods/Services</u>
6533828	 <p>("CHRISTMAS" disclaimed)</p>	<p>"Christmas tree decorations and ornaments," in International Class 28.</p> <p>"Online wholesale and retail store services featuring Christmas decorations and ornaments," in International Class 35.</p>
3642472	<p>THE GINGERBREAD COLLECTION</p> <p>("COLLECTION" disclaimed)</p>	<p>"Artificial Christmas trees; artificial Christmas wreaths; Christmas tree ornaments and decorations," in International Class 28.</p> <p>"On-line retail store services featuring artificial Christmas trees, artificial Christmas wreaths, Christmas tree ornaments and decorations," in International Class 35.</p>
4577594	VINEWORKS	<p>"Christmas tree ornaments and decorations," in International Class 28.</p> <p>"Wholesale and retail store services featuring ornaments and decorative home accessories," in International Class 35.</p>
4912358		<p>"Modeled plastic toy figurines; attachable wearable, magnetic toy figurines; Christmas tree decorations," in International Class 28.</p> <p>"The bringing together, for the benefit of others, of a variety of goods and services, enabling customers to conveniently view and purchase those goods and services from an Internet web site particularly specializing in the marketing of the sale of goods and services of others; wholesale and retail store services featuring ... toys and playthings, ... Christmas decorations, ... bags, ..." in International Class 35.</p>

<u>Reg. No.</u>	<u>Registered Mark</u>	<u>Relevant Goods/Services</u>
5695642	GINGER COTTAGES (“COTTAGES” disclaimed)	<p>“Ornaments of wood,” in International Class 20.</p> <p>“Christmas tree ornaments,” in International Class 28.</p> <p>“On-line retail store services featuring Christmas tree ornaments, decorations made of wood, Halloween ornaments, souvenirs, carousel decorations, clocks, music boxes,” in International Class 35.</p>
5877529	TRIPAR	<p>“Ornaments, holiday decor, namely, ornament display stands, ... topiary ornaments being holiday ornaments of plastic not for Christmas trees,” in International Class 20.</p> <p>“On-line wholesale store services featuring finished home furnishings in the nature of furniture, displays, and décor; ... on-line retail store services featuring finished home furnishings in the nature of furniture, displays, and décor,” in International Class 35.</p>
5850006	BOSCOYO	<p>“Holiday decorations made of plastic, specially designed and manufactured for consumers to add their own lights for a lighted holiday display; decorative mounting hardware made of plastic for use in assembling, securing and displaying holiday lights; indoor and outdoor decorations made of wood, namely, statues, figurines, works of art, placards, and sculptures,” in International Class 20.</p> <p>“Online retail store services featuring holiday decorations, mounting hardware and tools used to assemble and secure holiday decorations and holiday lights, gifts, and home décor,” in International Class 35.</p>

As a general proposition, third-party registrations that cover goods and services identified in both a cited registration and an applicant's application are relevant to show that the goods and services are of a type that may emanate from a single source under one mark. *In re Detroit Athletic*, 128 USPQ2d at 1051; *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *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 third-party registrations are not evidence that the registered marks are actually in use or that the public is familiar with them, particularly in the absence of any evidence showing the extent of their use, we consider them for their probative value. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005) (citation omitted); *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 462-63 (CCPA 1973); *In re Midwest Gaming & Entm't*, 106 USPQ2d 1163, 1167 n.5 (TTAB 2013); *see also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1207.01(d)(iii) (July 2022).

The chart above shows third-party registrations covering the services offered by Applicant and various goods offered by Registrant. These third-party registrations confirm that Applicant and Registrant offer goods and services that are commonly manufactured, produced, or provided by the same source. As a result, we find the Examining Attorney's third-party use-based registrations to be probative of the relatedness of the goods and services at issue.

In addition, the Examining Attorney made of record pages from several third-party website pages, listed and described below, to demonstrate that the services identified in the applications and the goods identified in the cited registrations may derive from the same source under the same mark, and are offered through the same trade channels.⁹ See *In re Detroit Athletic*, 128 USPQ2d at 1051 (relatedness supported by evidence that third parties sell both types of goods under same mark, showing that “consumers are accustomed to seeing a single mark associated with a source that sells both.”).

Bronner’s Christmas Wonderland, bronn timers.com (“Icicle Teardrop 70 Warm White Lights,” “Personalized Plain Design Ornament 4 Inch”);¹⁰

Crate & Barrel, crateandbarrel.com (“Verde Ceramic Ball Christmas Ornaments, Set of 12”; various wreaths, garland, and wall hangings; “Twinkle Gold 10’ Outdoor String Lights”; “Sage and Silver Bottle Brush Christmas Trees, Set of 8”);¹¹

World Market, worldmarket.com (“Wreaths and Garlands,” “Paper Covered Globe Ornaments Set of 4,” “String Lights,” glass Christmas angel);¹²

Ballard Designs, ballarddesigns.com (“Ballard Classic Prelit Garland,” “St. Nick Décor,” “Mixed Metals Glass Ornaments-Set of 12,” “Compact Twinkle Lights”);¹³

Balsam Hill, balsamhill.com (“Classic Nativity Set,” “Christmas Cheer Ornament Set,” “Christmas Tree Lights,” “Vintage Beaded

⁹ See Sept. 24, 2021 Office Action at pp. 10-21; Nov. 30, 2021 Final Office Action at pp. 44-74.

¹⁰ Sept. 24, 2021 Office Action at pp. 10-13.

¹¹ *Id.* at 14-17.

¹² *Id.* at 18-21.

¹³ Nov. 30, 2021 Final Office Action at pp. 44-48.

Garlands,” “Gold Nativity Scene,” “Christmas Moments Musical Snow Globe”);¹⁴

Frontgate, frontgate.com (“Christmas Cheer Corded Garland,” “Frosted Nights 60-piece Ornament Collection,” “Woodland Santa,” “T5 50L Light Set,” “Metallic Moving Sleigh Music Nutcracker”);¹⁵

Grandinroad, grandinroad.com (“Amaryllis Cordless Garland,” “Holiday season deer statutes,” “Christmas Ornament Sets,” “Christmas Collectibles & Figurines,” “Oh What Fun Light Strand,” “Deluxe Animated Musical Dog”);¹⁶

Pottery Barn, potterybarn.com (pages from “The Christmas Shop”: “Pre-Lit LED Faux Arctic Spruce Wreath & Garland,” “Etched Mercury Glass Ornament Sets-Silver,” “Standard String Lights”);¹⁷

and

The Christmas Palace, thechristmaspalace.com (“6 Ft. Iced Lighted Garland Warm White,” “8’ Pure White LED Green Wire M5 Icicle Lights,” “30’ Gold Glitter Deer,” “18’ Red Animated & Musical Santa,” “5’ Pink Sugar Ball Ornament Set of 9”).¹⁸

This third-party website evidence, which we find highly probative of relatedness, plainly shows that the same entity can offer, under the same mark, online retail store services featuring bags, holiday and seasonal decorations and ornaments, holiday lights, and toys, as well as Christmas tree ornaments and decorations, Christmas garlands, figurines, and electric Christmas tree lights.

We note that although some relatedness inquiries require “something more” than use of the goods and services together, *see, e.g., In re Coors Brewing Co.*, 343 F.3d

¹⁴ *Id.* at 49-54.

¹⁵ *Id.* at 55-59.

¹⁶ *Id.* at 60-65.

¹⁷ *Id.* at 66-69.

¹⁸ Nov. 30, 2021 Final Office Action, pp. 70-74.

1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003), because of the inherent relationship of the retail services and goods they feature in this case, no such higher bar applies. *Id.* at 1064 (stating that a mark for a brewpub “would clearly be related” to a mark for beer, avoiding the need for “something more”); *see also In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1087 (Fed. Cir. 2014) (explaining the need to show “‘something more’ than the mere fact that the goods and services are ‘used together’” in situations where the relatedness of the goods and services is obscure or not generally recognized). As discussed above, inherent relatedness often exists when the services in question include or focus on the sale of the particular goods in question. Regardless, substantial evidence proffered by the Examining Attorney demonstrating an overlap in or close relationship between the goods and services, the identity of the trade channels and prospective purchasers (discussed below in Section II.B.), and the similarities among the marks (discussed below in Section II.D.), distinguish this case from those in which the record lacked “something more” than mere use together to establish a likelihood of confusion between goods and services.

Overall, considering the close relationship between the goods and services, the third-party registrations, as well as the third-party website evidence, we conclude that the second *DuPont* factor strongly supports a finding of a likelihood of confusion.

B. Established, Likely-to-Continue Channels of Trade and Classes of Purchasers

Next, we consider the similarity or dissimilarity of established, likely-to-continue channels of trade and the classes of purchasers. *See generally In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1750-51 (Fed. Cir. 2017) (discussing relatedness of

the services, trade channels, and purchaser sophistication). Applicant contends the marketing channels for its HOLIDAY ROAD marks and Registrant's HOLIDAY LANE marks are "substantially different". (6 TTABVUE 7). Specifically, Applicant argues that its services are "immersive entertainment services," which include brick-and-mortar and online souvenir shops, but that none of the merchandise offered under Applicant's Marks are found at Macy's or other department stores. (6 TTABVUE 7-8). Applicant further argues that its event website, holidayroadusa.com, is not used specifically for the sale of retail goods; the goods sold on Applicant's website are ancillary to the "holiday drive through experience" and entertainment events listed on the website. (6 TTABVUE 7-8). Allegedly, only consumers accessing Applicant's website for the entertainment events will encounter the retail sale of the souvenir merchandise. (Applicant's Reply Brief, 11 TTABVUE 6). Finally, Applicant argues, without any supporting evidence,¹⁹ that Registrant's Goods are offered under the HOLIDAY LANE mark exclusively at Macy's retail stores and Macy's website, and not at any other third-party or e-commerce website. (6 TTABVUE 8).

As discussed in Section II.A., above, the third-party website evidence of record in this appeal demonstrates that the services identified in the applications and the goods identified in the cited registrations may derive from the same source under the same mark. There are no limitations as to trade channels or classes of purchasers in

¹⁹ Applicant's evidence from the macys.com website does not support its "exclusive" trade channel argument. *See* Aug. 18, 2021 Response to Office Action at pp. 28-32.

the applications or cited registrations, so despite Applicant's contentions discussed above, we must presume that the applications and registrations encompass all goods and services of the type described, that the goods and services move in all normal trade channels for them, and that the goods and services are available to all classes of purchasers. *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

As a result, we find the third-party website evidence demonstrating the same goods and services offered on the same webpages is probative of the similarity of the channels of trade and classes of purchasers, as well as the relatedness of the goods and services. *See, e.g., In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018) (while legal identity of goods identified as "cosmetics" was sufficient to establish that goods were related, the examining attorney's evidence also established that other goods identified in the application were related to "cosmetics"). This *DuPont* factor supports a finding of a likelihood of confusion.

C. The Number and Nature of Similar Marks in Use on, or Registered for, Similar Goods

Applicant contends that Registrant's HOLIDAY LANE mark is weak and only entitled to a narrow scope of protection, not only because of third-party use, but also because the register allegedly is crowded with HOLIDAY-formative marks for similar goods. (6 TTABVUE 13-14).

Under the sixth *DuPont* factor, "[t]he purpose of introducing evidence of third-party use is 'to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between

different marks on the bases of minute distinctions.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *Palm Bay Imps.*, 73 USPQ2d at 1694 (internal quotation omitted)). Third-party uses in the actual marketplace may be “relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Id.* This type of evidence pertains to the commercial strength of the mark.

Furthermore, as to commercial strength, evidence of actual third-party use of similar marks can be “powerful on its face” and can “show that customers ... have been educated to distinguish between different ... marks on the basis of minute distinctions,” *Juice Generation, Inc. v. GS Enters., LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (citation omitted), particularly if such evidence is “extensive.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (citing *Juice Generation*, 115 USPQ2d at 1674). Applicant points generally to the “attached records, along with the Cited Record.” (6 TTABVUE 13). Evidence of actual third-party use of HOLIDAY-formative marks for goods and services would be directly relevant to the commercial weakness of the Cited Marks, but Applicant has failed to specifically identify in its brief which, if any, third-party use evidence supports its weakness argument.²⁰

²⁰ Applicant attached to its brief a number of documents from the prosecution record for Applicant’s Marks. See 6 TTABVUE 27-131. We remind Applicant that “the record in the application should be complete prior to the filing of an appeal. See TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1207.01 (2022). It is not necessary to attach as exhibits to a brief evidence that is already in the application because the appeal

Without evidence of actual third-party use, Applicant's third-party registration evidence is not probative of commercial, or marketplace, weakness, inasmuch as it tells us nothing about the extent to which the third-party marks may have been used, or the amount of exposure relevant customers may have had to those marks. *Primrose Ret. Cmtys., LLC v. Edward Rose Sr. Living, LLC*, 122 USPQ2d 1030, 1036 (TTAB 2016). Since we do not have any evidence of the extent of their actual use, none of Applicant's third-party registrations "show that customers ... have been educated to distinguish between different ... [HOLIDAY-formative] marks on the basis of minute distinctions." *Juice Generation*, 115 USPQ2d at 1674; *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016) (third-party registrations "standing alone, are not evidence that the registered marks are in use on a commercial scale, let alone that consumers have become so accustomed to seeing them in the marketplace that they have learned to distinguish among them by minor differences."). Thus, we do not find the cited mark commercially weak.

Turning to the conceptual strength of the mark in the cited registrations, Applicant did proffer twenty-four third-party registrations²¹ for HOLIDAY-formative

brief is associated with the application. Such evidence should not, as a matter of course, be resubmitted as exhibits to the brief. *See* TBMP § 1203.01."

²¹ Aug. 18, 2021 Response to Office Action at Ex. A, pp. 33-130. The registrations are: HOLIDAY JOY, Reg. No. 5065890 ("holiday" disclaimed); FANTASY HOLIDAY and design, Reg. No. 5081131 ("holiday" disclaimed); HOLIDAY IN A BOX SHOP, Reg. No. 5224637 ("shop" disclaimed); HOLIDAY BRILLIANT, Supp. Reg. No. 4366160; HOLIDAY ILLUMINATIONS and design, Reg. No. 4739735 ("holiday illuminations" disclaimed); HELLO HOLIDAYS, Reg. No. 6231555 ("holidays" disclaimed); HOLIDAY ESSENCE, Reg. No. 4530677 ("holiday" disclaimed); HOLIDAY BRIGHTS, Reg. No. 2368936 ("holiday" disclaimed); HOLIDAY HOME, Reg. No. 2484917 ("holiday" disclaimed); HOLIDAY HOME, Reg. No. 2640116 ("holiday" disclaimed); HOLIDAY BRIGHT LIGHTS and design, Reg. No. 3479632 ("holiday bright lights" disclaimed); HOLIDAY CHARMERS, Reg. No. 3565888

marks for goods similar to those identified in the cited registrations. The Examining Attorney concedes that “holiday,” the common element in all of the marks, is weak, but that the refusals of Applicant’s HOLIDAY ROAD marks are based on both of the elements “holiday” and “road,” and the overall commercial impression they create as HOLIDAY ROAD when used in conjunction with Applicant’s Services. (10 TTABVUE 8).

Third-party registrations “may bear on conceptual weakness if a term is commonly registered for similar goods or services.” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017); *see also In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). Applicant’s weakness evidence does support its argument that “holiday” is conceptually weak for the goods and services identified in the cited registrations, particularly since “holiday” is disclaimed in nearly all of the registrations Applicant submitted for the record. But Applicant’s

(“holiday” disclaimed); HOLIDAY HOME, Reg. No. 2253726 (“holiday” disclaimed); HOLIDAY HOEDOWN, Reg. No. 5082806 (“holiday” disclaimed); HOLIDAY LED MAGIC, Reg. No. 5272329 (“holiday LED” disclaimed); HOLIDAY HORSES (stylized), Reg. No. 5754022 (“horses” disclaimed); HOLIDAY HAILEY, Reg. No. 4625457; HOLIDAY CIRCLE, Reg. No. 6196664; HOLIDAY HOME, Reg. No. 2977853; HOLIDAY HOME, Reg. No. 2998817; HOLIDAY CONCEPTS, Reg. No. 3108880 (“holiday” disclaimed); HOLIDAY HOME, Reg. No. 3175466; HOLIDAY ESSENTIALS, Reg. No. 3835814 (“holiday” disclaimed); and HOLIDAY CLASSICS, Reg. No. 2421750 (“holiday” disclaimed). Applicant also cited in its brief the registration for HOLIDAY HOME, Reg. No. 4849538, but failed to enter the TSDR record for that mark into evidence.

Applicant attempted to introduce four pending applications into the record. However, pending applications are evidence only that the applications were filed on a certain date; they are not evidence of use of the marks. *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1270 n.8 (TTAB 2009); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366 n.7 (TTAB 2007); *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1193 n.8 (TTAB 2007).

evidence does not support a finding that HOLIDAY LANE as a whole is weak, either conceptually or commercially.

D. The Similarity or Dissimilarity of the Marks

Finally, we consider the *DuPont* factor relating to the similarity or dissimilarity of the respective marks. In comparing the marks we must consider their appearance, sound, meaning, and overall commercial impression when assessing them in their entirety. *Palm Bay Imps.*, 73 USPQ2d at 1692. Similarity as to any one of these elements may be sufficient to support a finding that the marks are similar for likelihood of confusion purposes. *See Krim- Ko Corp. v. Coca- Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”); *see also In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. Sept. 13, 2019). In comparing the marks, we are mindful that where, as here, the goods and services are closely related, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods and services. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Century 21 Real Est. Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

“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.” *In re i.am.symbolic*, 123 USPQ2d at 1748 (quoting *Coach Servs.*,

101 USPQ2d at 1721); *see also In re St. Helena Hosp.*, 113 USPQ2d at 1085 (“[M]arks must be considered in light of the fallibility of memory and not on the basis of side-by-side comparison.”).

Our analysis must focus on the recollection of the average purchaser — here, an ordinary consumer of online retail store services; Christmas tree ornaments, electric lights, decorations, garland, and figurines; and musical figurines — who normally retains a general, rather than specific, impression of marks. *See Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014) (“The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks.”) (citations omitted).

When marks consist of words and a design, we normally accord the words greater weight because the words are likely to make more of an impression upon purchasers and purchasers will remember the words and use them to request the products. *See Jack Wolfskin*, 116 USPQ2d at 1134; *In re Viterro*, 101 USPQ2d 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)); *Herbko Int’l v. Kappa Books*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (“Because the impact of the design in the overall commercial impression is minor when compared with the words, a consumer viewing Herbko’s mark would attach greater significance to the words CROSSWORD COMPANION than to the crossword puzzle design.”). “[I]f the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences.” *In re Denisi*, 225 USPQ 624, 624 (TTAB 1985).

Overall, “our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on a comparison of the entire marks, not just part of the marks.” *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *4 (TTAB 2020) (citing *Stone Lion*, 110 USPQ2d at 1161). In making such a determination, “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 a consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant contends its HOLIDAY ROAD standard character and composite marks are dissimilar from Registrant’s HOLIDAY LANE mark in sound, appearance, meaning, and overall commercial impression. Specifically, as to meaning and overall commercial impression, Applicant argues that despite the shared element HOLIDAY, its marks are distinguishable because ROAD and LANE create distinct commercial impressions, and because HOLIDAY ROAD is synonymous with the song “Holiday Road” from the films “National Lampoon’s Vacation,” “National Lampoon’s European Vacation,” “Vegas Vacation,” and “Vacation” (2015).²² (6 TTABVUE 9-13).

The marks share the same first word, HOLIDAY, which is followed by one-syllable words that have essentially the same meaning. The prosecution record includes several definitions of “lane” and “road” proffered by Applicant and the Examining

²² See Aug. 18, 2021 Response to Office Action at pp. 22-23 (Wikipedia page for “Holiday Road,” (https://en.wikipedia.org/wiki/Holiday_Road)).

Attorney. “Lane” is defined as “a narrow country road”;²³ “a narrow passage, course, or track, *especially*: a strip delineated on a street or highway to accommodate a single line of vehicles: *a breakdown lane, an express lane*”;²⁴ “a narrow road, especially in a rural area”;²⁵ and “a street in an urban area.”²⁶ “Road” is defined as “an open, generally public way for the passage of vehicles, people, and animals”;²⁷ “the surface of a road; a roadbed”;²⁸ and “an open way for vehicles, persons, and animals, *especially*: one lying outside of an urban district: HIGHWAY.”²⁹ Based on these definitions – and contrary to Applicant’s assertions – we find that “road” and “lane” are highly similar in meaning, in that a lane is a type of road.

In our view, the record does not support Applicant’s argument that consumers would perceive its HOLIDAY ROAD marks as a reference to the song of the same name featured in National Lampoon’s “Vacation” films. We are unpersuaded by the minimally-probative Wikipedia page proffered by Applicant for the nearly forty-year old song — which peaked only at Number 82 on the *Billboard* Hot 100 Chart in 1983 — because the page does not contain any information demonstrating that consumers necessarily would associate Applicant’s Marks with the song. Furthermore, the

²³ Mar. 31, 2021 Office Action at p. 23 (THE AMERICAN HERITAGE DICTIONARY definition).

²⁴ *Id.*

²⁵ May 3, 2022 Request For Reconsideration after Final Action at p. 9 (definition from LEXICO POWERED BY OXFORD).

²⁶ *Id.*

²⁷ Mar. 31, 2021 Office Action at p. 24 (THE AMERICAN HERITAGE DICTIONARY definition).

²⁸ *Id.*


²⁹ May 3, 2022 Request For Reconsideration after Final Action at p. 10 (MERRIAM-WEBSTER DICTIONARY definition).

holidayroadusa.com website³⁰ lacks any indicia linking Applicant's Marks to the song. So despite the differences in the appearance and sound of the words "road" and "lane," we find that Applicant's HOLIDAY ROAD standard character mark and Registrant's HOLIDAY LANE standard character mark are similar in meaning and overall commercial impression due to the shared identical element HOLIDAY, which, along with the other essentially synonymous wording, contributes to a similar meaning, and thus, a similar overall commercial impression. *Cf. Hancock v. Am. Steel & Wire Co.*, 203 F.2d 737, 40 CCPA 931, 935 (CCPA 1953) (TORNADO and CYCLONE, both used for wire fencing, found "so similar in meaning that confusion as to origin is deemed likely"); *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630-35 (TTAB 2018) (extensive discussion of the commercial impressions created by the involved marks and the goods offered under them).



As to Applicant's composite mark, , we find that its design elements only




reinforce the similarities between  and the cited HOLIDAY LANE mark. As noted above, greater weight is often given to the wording because it is the wording that purchasers use to refer to or request the goods or services. *See In re Viterra*, 101 USPQ2d at 1911. In addition, the festive font embellished with garland, the evergreen trees on the top of the semi-circle ornament, and the silhouette of the front of an automobile serving as the ornament's cap only serve to reinforce the literal

³⁰ *Id.* at 19-22.

element “holiday road,” which as previously discussed, is similar in overall commercial impression to “holiday lane.”

Overall, we find that Applicant’s Marks and Registrant’s Mark appear and sound more similar than different, and their similarity in meaning and overall commercial impression outweigh the few dissimilarities among them. Considering the marks in their entireties, on this record, they are sufficiently similar in meaning and overall commercial impression as to be likely to cause confusion when concurrently used in the sale or offer for sale of the identified goods and services. Therefore, the first *DuPont* factor also weighs in favor of a finding of likelihood of confusion.

III. Conclusion

Having considered all of the arguments and evidence relating to the relevant likelihood of confusion factors, on balance we find that on this record, confusion is likely between Applicant’s Marks, HOLIDAY ROAD and , for “Online retail store services featuring bags, backpacks, blankets, holiday and seasonal decorations and ornaments, holiday lights, toys, baskets, cups,” in International Class 35, and Registrant’s Mark, HOLIDAY LANE, given their related goods and services, similar trade channels and classes of purchasers, and similar overall meanings and commercial impressions.

Serial Nos. 90274429 and 90350840

Decision: The refusals to register Applicant's Marks, HOLIDAY ROAD and



, of Application Serial Nos. 90274429 and 90350840, under Trademark Act Section 2(d), are affirmed.