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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 75/667475

APPLICANT: BLUE GROTTO MEDIA, INC.

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MARK: BLISS!

CORRESPONDENT'S REFERENCE/DOCKET NO: 1928-99

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Blue Grotto Media, Inc. 175 Fairhaven Boulevard Woodbury, NY 11797	:	BEFORE THE
Trademark:	BLISS!	:	TRADEMARK TRIAL
Serial No:	75/667475	:	AND
Attorney:	Robert S. Stoll	:	APPEAL BOARD
Address:	6110 Empire State Building New York, NY 10118	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the Trademark Examining Attorney's final refusal to register the mark BLISS! for use in connection with an on-line website in the field of weddings, wedding preparation, engagement and wedding parties and engagement and wedding gifts. The examining attorney refused registration on the Principal Register pursuant to Section 2(d) of the

Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark is likely to be confused with the mark in U.S. Registration No. 2,140,872, BLISS GIFT & BRIDAL REGISTRY, used in connection with gift and bridal register service, and distributorship in the field of bridal gifts.

ISSUE

The sole issue on appeal is whether or not the applicant's mark, BLISS!, is confusingly similar to the mark in U.S. Registration No. 2,140,872, BLISS GIFT & BRIDAL REGISTRY, when used on the services, namely, on-line websites in the field of weddings, wedding preparation, engagement and wedding parties and engagement and wedding gifts, and gift and bridal register services, and distributorship in the field of bridal gifts, respectively, thus causing a likelihood of confusion between the respective marks.

ARGUMENT

I. THE APPLICANT'S AND THE REGISTRANT'S MARKS ARE HIGHLY SIMILAR AND HAVE THE SAME OVERALL COMMERCIAL IMPRESSION.

Section 2(d) of the Trademark Act bars registration where a mark so resembles a registered mark that it is likely, when applied to the services, to cause confusion or to cause mistake or to deceive. TMEP section 1207.01. The Court in *In re E.I. Dupont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d). Any one of the factors listed may be dominant in any given case, depending on the evidence of record. In this case, the following factors are most relevant: similarity of the mark, similarity of the services, and the identical nature of the channels of trade. TMEP sections 1207.01 *et seq.*

The marks are virtually identical. The applicant's mark is "BLISS!" and the registrant's mark is "BLISS GIFT & BRIDAL REGISTRY." The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally

retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b).

The applicant argues that the marks do not present the same overall commercial impression. While agreeing that the disclaimed portion of the registrant's mark (i.e., "GIFT & BRIDAL REGISTRY") places "some amount of de-emphasis" on that portion of the mark, applicant asserts that "clearly there is a difference between the cited but unregistered form "BLISS!" and the registered "BLISS & BRIDAL REGISTRY."

The examining attorney disagrees. Disclaimed matter is typically less significant or less dominant when comparing marks. Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997) (holding that DELTA is the dominant portion of the mark THE DELTA CAFÉ where the disclaimed word "café" is descriptive of applicant's services); *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ 2d 1001 (Fed. Cir. 2002); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988); *In re Equitable Bancorporation,* 229 USPQ 709 (TTAB 1986).

In the instant case, the registrant's disclaimed portion of the mark is highly descriptive. The examining attorney provided ample evidence from the LEXIS/NEXIS database, indicating that the term "Gift and Bridal Registry" was, at least, highly descriptive for the subject services. The dominant feature of the registrant's mark, then, is the term "BLISS." When compared to the applicant's mark "BLISS!," the overall commercial impression of both marks is virtually identical.

The applicant further asserts "that no confusion between applicant's mark and the mark of the cited reference is known in over six years contemporaneous use." Applicant's argument is not dispositive on the issue of likelihood of confusion. The test under Trademark Act Section 2(d) is

whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. *See Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990), and cases cited therein. *See also In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984), wherein the Board stated as follows:

> [A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and registrant has no chance to be heard (at least in the absence of a consent agreement, which applicant has not submitted in this case). *Id.* at 1026-1027.

II. THE APPLICANT'S AND REGISTRANT'S SERVICES ARE HIGHLY RELATED AND WOULD BE SOLD IN THE SAME CHANNELS OF TRADE AND TO THE SAME PROSPECTIVE PURCHASERS

The applicant, in its Appeal Brief, did not contest the similarity of the services. The goods/services of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods/services come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). TMEP §1207.01(a)(i).

The examining attorney provided in his Final Office Action copies of U.S. Trademark registrations, where retail store owners provide both retail store services and magazines for their retail services. This evidence clearly indicates that the services are related. Moreover, If the goods or services of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *Century 21 Real Estate Corp. v. Century Life of America,* 23 USPQ2d 1698 (Fed. Cir. 1992); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); *ECI Division of E-Systems, Inc. v.*

Environmental Communications Inc., 207 USPQ 443 (TTAB 1980); TMEP §1207.01 (b).

III. CONCLUSION

The applicant's mark, BLISS!, is confusingly similar to the mark in U.S. Registration No. 2,140,872, BLISS GIFT & BRIDAL REGISTRY, because it presents the same overall commercial impression, and because both applicant's and registrant's marks will be used in the same or highly similar channels of trade. Consumers, confronted with the respective marks on online websites in the field of weddings, wedding preparation, engagement and wedding parties and engagement and wedding gifts, and, gift and bridal register services and distributorships in the field of bridal gifts, are likely to be confused as to their source. Moreover, consumers are likely to have a mistaken belief that the services provided under the respective marks come from the same source. Accordingly, the examining attorney respectfully requests that the Board affirm the refusal to register the applicant's mark under Trademark Act Section 2(d).

Respectfully Submitted,

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