

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
January 11, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Hallmark Licensing, LLC

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Serial No. 86198536

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Clinton G. Newton of Shook, Hardy & Bacon L.L.P. for Hallmark Licensing, LLC.

Toby E. Bulloff, Trademark Examining Attorney, Law Office 119 (Brett Golden, Managing Attorney).

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Before Taylor, Ritchie, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Hallmark Licensing, LLC (“Applicant”) has filed an application to register on the Principal Register the mark MAGIC SNOWBALL in standard characters for “plush toy which looks like a snowball and contains a motion-activated LED,” in International Class 28.¹

The Trademark Examining Attorney refused registration under § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as used

¹ Application Serial No. 86198536, filed February 20, 2014 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), on the basis of Applicant’s stated *bona fide* intention to use the mark in commerce.

in connection with Applicant's goods, so resembles the registered mark SNOWBALL in standard characters as to be likely to cause confusion, or to cause mistake, or to deceive. The cited mark is registered for "plush toys."² When the refusal was made final, Applicant filed a notice of appeal and a request for reconsideration. The Examining Attorney denied the request for reconsideration and this appeal proceeded. Applicant and the Examining Attorney have filed briefs.

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 as set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods at issue. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In this case, Applicant and the Examining Attorney have also submitted evidence and arguments regarding the strength and weakness of components of the marks, trade channels, and classes of customers.

1. The goods; trade channels; customers.

We will first consider the similarity or dissimilarity of the goods as identified in the application and the cited registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-1162 (Fed. Cir. 2014); *Octocom Syst. Inc. v. Houston Computers Svcs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783,

² Reg. No. 3908842 issued January 18, 2011.

1787 (Fed. Cir. 1990). The goods are legally identical, inasmuch as Registrant’s “plush toys” are identified with sufficient breadth to encompass Applicant’s more specifically identified plush toy resembling a snowball and containing a motion-activated LED. Applicant’s contention that “[o]nly the Applicant’s goods relate to toys with motion-activated LEDS”³ is incorrect. We must presume that Registrant’s goods encompass all goods of the nature and type identified in the registration (*i.e.*, plush toys), including plush toys that resemble snowballs and contain LEDs. *See In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006). Accordingly, the *du Pont* factor regarding the similarity or dissimilarity of the goods favors a finding of likelihood of confusion.

As Applicant’s goods are legally identical to those of Registrant, we must presume that the goods of Applicant and Registrant move in the same channels of trade and are offered to the same classes of consumers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). Accordingly, the *du Pont* factors relating to the similarity or dissimilarity of trade channels and classes of customers favor a finding of likelihood of confusion.

³ Applicant’s brief at 12, 7 TTABVUE 14.

2. The marks.

Next we consider the similarity or dissimilarity of the marks at issue in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). While we consider each mark in its entirety, 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 that our ultimate conclusion rests upon a comparison of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The marks at issue are similar in appearance, sound and meaning to the extent that each includes the term SNOWBALL. However, they differ by virtue of the word MAGIC in Applicant's mark, which is absent from Registrant's mark, and therefore are somewhat different in sound, appearance and meaning.

Applicant contends that MAGIC, the first word of its mark, should be considered the dominant portion of the mark.⁴ The Examining Attorney seeks to refute this contention, saying that "The wording 'MAGIC' (or the related 'MAGICAL') is so commonly used within the toy industry, and specifically with respect to plush or stuffed toys, and 'SNOWBALL' is so rarely used, that applicant's argument is

⁴ Applicant's brief at 8-9, 7 TTABVUE 10-11.

unpersuasive.”⁵ The Examining Attorney has submitted Internet evidence showing seven plush toys offered under marks that include the term MAGIC,⁶ as follows:



Magic Fortune Monkey



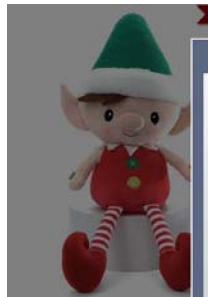
Magic Unicorn



Magic Dog



Magic Lavender Teddy Bear



Magic Messenger Elf



Magic Pink Poodle



My Little Pony Friendship is Magic Derpy Hooves

⁵ Examining Attorney’s brief, 9 TTABVUE 5. With respect to this contention of the Examining Attorney, we note that there is no evidence of record to show whether SNOWBALL is used commonly or rarely in the relevant field.

⁶ Office Action of November 13, 2014 at 7-27.

The Examining Attorney has also made of record six third-party registrations, owned by different entities, of plush toy trademarks that include the term MAGIC or MAGICAL.⁷ The Federal Circuit has stated that evidence of third-party registrations is relevant to show that a segment of a mark “may have a ‘normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak,’ ...” *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), quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015).

We find the Examining Attorney’s Internet evidence and third-party registrations sufficient to show that the term MAGIC has suggestive significance in the field of plush toys, thereby weakening the source-indicating power of that term. Thus, even though MAGIC may be the dominant portion of the mark, it does not sufficiently distinguish Applicant’s mark so as to dispel likely confusion.

We note that Applicant has disclaimed the exclusive right to use the term SNOWBALL, essentially acknowledging that the term, as used on a plush toy that looks like a snowball, is not inherently distinctive. However, when we consider the use of Registrant’s mark SNOWBALL on such goods, we do not attribute such lack of distinctiveness to it because, pursuant to Section 7 of the Trademark Act, 15 U.S.C. § 1057(b), the registration is *prima facie* evidence of the validity of the mark.

⁷ Office Action of June 8, 2015 at 3-14. The registered marks are MAGIC MUFFE, THE MAGIC SCHOOLBUS (and design), THE MAGICAL PET, MAGIC TWISTY, MAGIC GLOW, and MY MAGIC MUFFIN.

Applicant has offered no evidence or argument to rebut this *prima facie* evidence, and on this record there is no reason to suggest that Registrant could not use its mark on goods like those of Applicant in a manner that is distinctive.

Applicant argues that MAGIC SNOWBALL and SNOWBALL have very different meanings:

To a consumer, the likely connotation of SNOWBALL is an actual, physical snowball, made by anyone who packs snow into a ball. On the other hand, the likely connotation of MAGIC SNOWBALL is not a traditional snowball. ... The connotation of MAGIC SNOWBALL in a consumer's mind is something imaginary or fantastical.⁸

We are not persuaded that the addition of the word MAGIC so thoroughly transforms the meaning of SNOWBALL, especially in the context of plush toys.

Comparing the marks in their entirety, we find that their similarities outweigh their differences, such that they create similar commercial impressions overall. We are mindful that “[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007). Accordingly, we find that the *du Pont* factor of the similarity or dissimilarity of the marks weighs in favor of a finding of likelihood of confusion.

⁸ Applicant's brief at 10, 7 TTABVUE 12.

3. Conclusion.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. In view of the similarities between the marks, the identity of the goods, and the presumption that the goods will travel through the same trade channels to the same classes of customers, we find that Applicant's mark so resembles the cited registered mark as to be likely to cause confusion, mistake or deception as to the source of Applicant's goods.

Decision: The refusal to register is affirmed.