

**This Opinion is Not a
Precedent of the TTAB**

Mailed: January 13, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Comfort Revolution, LLC
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Serial No. 86564232
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Michael J. Doherty of Doherty IP Law Group LLC
for Comfort Revolution, LLC.

Brian P. Callaghan, Trademark Examining Attorney, Law Office 108,
Andrew Lawrence, Managing Attorney.

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Before Kuhlke, Ritchie and Shaw, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Comfort Revolution LLC (Applicant) seeks registration on the Principal Register of the standard character mark BEACH HUGGY for “pillows,” in International Class 20.¹

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, when used in connection with the identified goods, so

¹ Application Serial No. 86564232, filed on March 14, 2015, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

resembles the mark HUGGY PETS in standard characters registered on the Principal Register for “decorative pillowcases for children,” in International Class 24,² as to be likely to cause confusion, mistake or deception.

In addition, the Examining Attorney refused registration under Trademark Act Section (6), 15 U.S.C. § 1056, based on Applicant’s failure to comply with a requirement to disclaim the word BEACH, which the Examining Attorney maintains is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), when used in connection with Applicant’s goods, and therefore must be disclaimed apart from the mark as shown.

When the refusals were made final, Applicant appealed. The Examining Attorney and Applicant filed briefs. We affirm the refusals to register.

Disclaimer Requirement

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. 15 U.S.C. § 1056. This section of the statute was amended in 1962 to allow the exercise of greater discretion by examining attorneys in determining whether a disclaimer is necessary. *See* TMEP § 1213.01(a) (Oct. 2016). *See also In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262 (Fed. Cir. 2015). Merely descriptive or generic terms are unregistrable under Section 2(e)(1), and therefore are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. *La. Fish Fry*, 116 USPQ2d at 1264 (citing *In re*

² Registration No. 4355265, issued on June 18, 2013.

Stereotaxis, Inc., 429 F.3d 1039, 77 USPQ2d 1087 (Fed. Cir. 2005)) (“The PTO can condition the registration of a larger mark on an applicant’s disclaimer of an ‘unregistrable component of a mark otherwise registrable.’ 15 U.S.C. § 1056(a)”). See also *In re Omaha Nat’l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it immediately conveys information of a quality, feature, function, or characteristic of the goods or services in connection with which it is used, or intended to be used. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). See also *In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015). The determination of whether a term is merely descriptive must be made “in relation to the goods [or services] for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use.” *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)). It is not necessary, in order to find a term merely descriptive, that the term describe each feature of the goods or services, only that it describe a “single feature or attribute” of the goods or services. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987).

The Examining Attorney contends that BEACH “merely describes an intended use of Applicant’s goods, namely, that Applicant’s pillows are suitable for use at the

beach.” Ex. Att. brief, 6 TTABVUE 13. In support of his position that the term BEACH is merely descriptive of the applied-for goods, the Examining Attorney relies on the dictionary definition of “beach” as being “an area covered with sand or small rocks that is next to an ocean or lake.”³ In addition, the Examining Attorney submitted evidence in the form of third-party webpages showing a Beach Huggy foam pillow for sale described as being “great for the beach” and “us[e] it at the beach.”⁴ Ex. Att. brief, 6 TTABVUE 13.

In response, Applicant argues that the word BEACH is not merely descriptive of its pillows because they “can be used anywhere.” App. brief, 4 TTABVUE 5. Rather, Applicant contends it “uses the word BEACH as part of the mark to convey the level of comfort and relaxation that may be attained when using the BEACH HUGGY pillows, i.e., similar to the comfort and relaxation that may be attained when spending time at the beach.” *Id.*

This record clearly shows that BEACH when used in connection with the applied-for goods immediately, without doubt, describes a feature of the goods, namely, that they are pillows for use at the beach. That the pillows may be used in other locations, does not obviate the refusal because it is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a “single feature or attribute” of the goods or services. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219. Applicant’s argument that consumers, rather than understanding the simple and immediate connotation of

³ MERRIAM-WEBSTER (<http://merriam-webster.com>), December 29, 2015 Office action at 95.

⁴ Ebay, Amazon (www.amazon.com) December 29, 2015 Office action at 4-7.

beach in this context, would reach for a more nebulous suggestion about how it feels to be at a beach is unsupported and unconvincing.

As is well established, the fact that “a term may have other meanings in different contexts is not controlling.” *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1087 (TTAB 2012). Applicant’s argument does not take into account the perception of the consumer as to meaning in the context of Applicant’s goods, *i.e.*, what meaning is relevant to pillows. *In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012); *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984). The record contains examples of pillows sold under the BEACH HUGGY mark being described as for use at the beach. As noted above, in our analysis of the proposed term BEACH we must consider “the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use.” *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219. Applicant’s broad identification encompasses pillows for use at the beach. *See Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219. *See also In re Bayer Aktiengesellschaft*, 82 USPQ2d at 1832 (Internet evidence may be considered for purposes of evaluating a trademark).

Finally, Applicant argues that the USPTO “has granted many federal trademark registrations that use the word BEACH where no disclaimer of the wording BEACH was required.” However, Applicant only submitted a list of three registrations which does not make them of record. *In re Promo Ink*, 78 USPQ2d 1301, 1304 (TTAB 2006). In the December 29, 2015 Office action, the Examining Attorney advised

Applicant of this issue and the Applicant did not seek either by way of a request for reconsideration or remand to submit these registrations into the record. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372-73 (TTAB 2006). Without the registrations of record we cannot know, for example, if they reside on the Principal or Supplemental Register. *In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002) (Board does not take judicial notice of third-party registrations); *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974); *see also In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1767 (TTAB 2016). Merely descriptive terms are registered without disclaimer on the Supplemental Register and would support the opposite conclusion, *i.e.*, that the term is merely descriptive. In view thereof, we have not given this list any consideration.

In view of our finding that BEACH is merely descriptive of Applicant's goods, the disclaimer requirement is appropriate.

Likelihood of Confusion

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Similarity of the Goods/Channels of Trade/Consumers

With regard to the goods, channels of trade and classes of consumers, we must make our determinations under these factors based on the goods as they are identified in the application and registration. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). “This factor considers whether ‘the consuming public may perceive [the respective goods and services of the parties] as related enough to cause confusion about the source or origin of the goods and services.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett Packard*, 62 USPQ2d at 1004).

Applicant’s argument that there is no “likelihood of confusion because the registered mark is assigned to International Class 024 and the applied for mark is assigned to International Class 020” (App. brief, 4 TTABVUE 4) has no legal basis. The classification of goods and services has no bearing on the question of likelihood of confusion; it is merely an administrative determination that impacts the fees to be paid and is unrelated to the issue of likelihood of confusion. *See Jean Patou, Inc. v. Theon Inc.*, 9 F.3d 971, 975, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993). It is the identification of goods or services that is controlling. *See Nat’l Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 & n.5 (TTAB 1990).

Pillows and decorative pillowcases for children are related on their face as complementary products and the record overwhelmingly confirms the obvious. The Examining Attorney submitted a multitude of third-party registrations that include both “pillows” and “pillowcases,” (a broad identification that encompasses “decorative pillowcases for children”). *See, e.g.*, Reg. No. 4731986 for the mark METROPOLITAN HOME for pillows and decorative pillows, and pillow cases; Reg. No. 4503225 for the mark MALOUF for pillows and pillow cases; Reg. No. 4683757 for the mark SLUMBERCOOL for pillows and pillowcases;⁵ Reg. No. 4768937 for the mark COVER GIRL for accent pillows, pillows, and pillow cases; Reg. No. 4832920 for the mark AMBROSE COLLECTION for accent pillows, decorative 3D pillows, novelty pillows, pillows, and pillow cases; and Reg. No. 4836000 for the mark LASTING IMPRESSIONS for accent pillows, novelty pillows, pillows, pillow cases and children’s pillow cases.⁶ Third-party registrations that cover a number of different goods or services may have some probative value to the extent that they may serve to suggest that goods or services are of a type that may emanate from a single source, if the registrations are based on use in commerce. *Hewlett-Packard*, 62 USPQ2d at 1004 (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to the relatedness analysis”); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB), *aff’d per curiam*, 864 F.2d 149 (Fed. Cir. 1988).

⁵ May 21, 2015 Office action at 4-30

⁶ December 29, 2015 Office action at 8-46.

In addition, the Examining Attorney submitted printouts from the websites of several third-parties wherein pillows and pillowcases are offered for sale under the same trademark. *See, e.g.*, Wyndam At Home Collection (pillows and pillowcases);⁷ United Pillow Manufacturing (custom pillows and pillowcases);⁸ Wamsutta (pillows and pillowcases);⁹ Jaclyn Smith (decorative pillows and pillowcases).¹⁰ In one example, decorative pillowcases and pillows directed to appeal to children and the general public are advertised on the same web page:¹¹



Applicant’s argument that there is a “vast difference[] between the goods [inasmuch as] [d]ecorative pillowcases for children’ are very different than ‘pillows”

⁷ (www.wyndhamathome.com) December 29, 2015 Office action at 60-62.

⁸ (www.unitedpillow.com) December 29, 2015 Office action at 63.

⁹ (www.bedbathandbeyond.com) December 29, 2015 Office action at 65-72.

¹⁰ (www.kmart.com) December 29, 2015 Office action at 78-85.

¹¹ (www.hopscotchlane.com) December 29, 2015 Office action at 86.

(App. brief, 4 TTABVUE 4) misses the point. In a Section 2(d) determination, the goods and/or services do not have to be identical or even competitive in order to find that there is a likelihood of confusion. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1368 (TTAB 2009). We must consider not whether the actual goods are literally the same, but rather whether the public will be confused as to their source. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1403–04, 186 USPQ 476, 480 (C.C.P.A. 1975); *In re Ass’n of the U.S. Army*, 85 USPQ2d 1264, 1270 (TTAB 2007). *See also In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984) (holding MARTIN’S for wheat bran and honey bread, and MARTIN’S for cheese, likely to cause confusion).

With regard to the channels of trade, the ordinary channels of trade for pillows and decorative pillowcases for children include the same stores, both online, and brick and mortar. As shown above, pillows and pillowcases appear under the same mark on the same website, including those directed to both the general public and specifically to children.

Applicant argues that Registrant’s goods “are marketed and sold to appeal to children. The pillows to be sold under the BEACH HUGGY mark are not marketed and sold to appeal to children, but to the public at large. This indicates that the goods will be sold in different channels of trade.” App. brief, 4 TTABVUE 4. As

noted above, we must consider the goods as they are identified, and Applicant's broad identification "pillows" encompasses "pillows" for children. In addition, marketing to the public at large includes marketing to appeal to children. We further observe that adults are typically the ultimate consumers for both the pillows marketed to the general public and pillowcases marketed to appeal to children.

In view thereof, the *du Pont* factors of the relatedness of goods, channels of trade and consumers weigh in favor of likelihood of confusion.

Similarity/Dissimilarity of the Marks

We consider Applicant's mark BEACH HUGGY and Registrant's mark HUGGY PETS and compare them "in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). The marks "must be considered ... in light of the fallibility of memory" *St. Helena Hosp.*, 113 USPQ2d at 1085 (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). "[S]imilarity is not a binary factor but is a matter of degree." *St. Helena Hosp.*, 113 USPQ2d at 1085 (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003)).

The marks share the term HUGGY and differ in the additional words BEACH and PETS, and in the arrangement of the words. The additional words are conceptually weaker than the common term HUGGY in that both describe or suggest the purpose or feature of the goods. In the case of Applicant's pillows, as discussed above they are designed for use at the beach. Registrant's pillowcases are designed to look like an animal or pet as shown below in the online advertisement:¹²



“[I]n articulating reasons for reaching a conclusion on the issue of confusion, 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.” *In re Nat’l Data Corp.*, 753

¹² December 1, 2015 Response at 1-3.

F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985); *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). Although there is no mechanical test to select a “dominant” element of a compound word mark, consumers would be more likely to perceive a fanciful or arbitrary term, rather than a descriptive or generic term, as the source-indicating feature of the mark. *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (affirming TTAB’s finding that “DELTA,” not the disclaimed generic term “CAFE,” is the dominant portion of the mark THE DELTA CAFE); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (finding that “BINION’S,” not the disclaimed descriptive wording “ROADHOUSE,” is the dominant portion of the mark BINION’S ROADHOUSE). Accordingly, if two marks for related goods or services share identical or similar dominant features and the marks, when viewed in their entirety, create similar overall commercial impressions, then confusion is likely. *See, e.g., In re Cynosure, Inc.*, 90 USPQ2d 1644 (TTAB 2009) (holding CYNERGY for medical lasers for, *inter alia*, treatment of the face and skin, and SYNERGIE PEEL for medical devices for microdermabrasion, likely to cause confusion, noting that “SYNERGIE” is the dominant portion of the cited mark and “PEEL” is insufficient to distinguish the marks).

Applicant argues that the differences engendered by the additional wording and the different placement of the wording are sufficient to distinguish the marks. We are not persuaded by this argument in view of the dominance of the common

element HUGGY. As noted, Applicant's mark gives the commercial impression of a pillow that is useful for hugging at the beach, while the mark in the cited registration conveys a huggable pet in the form of a stuffed pillowcase. Consumers are thus drawn to the "huggable" element of the respective pillows/pillowcases.

In addition, because Applicant's and Registrant's marks are in standard characters they are not limited to any particular depiction. The rights associated with a mark in standard characters reside in the wording and not in any particular display. *In re RSI Sys., LLC*, 88 USPQ2d 1445 (TTAB 2008); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988); TMEP § 1207.01(c)(iii) (Oct. 2015). We must consider Applicant's and Registrant's marks "regardless of font style, size, or color," *Citigroup Inc. v. Capital City Bank Group Inc.*, 98 USPQ2d 1253, 1258-59 (Fed. Cir. 2011), including iterations that emphasize the common element HUGGY as shown on one example offered for sale online:¹³

¹³ Ebay (www.ebay.com) May 21, 2015 Office Action at 61. While this may be Applicant's product it is not clear from the record or briefing that it is.



The dominant HUGGY element could lead consumers to believe that HUGGY has expanded its “huggable” product line to include different themes and uses. We find that, viewed as a whole, the similarities between the marks in appearance, sound, connotation and commercial impression, due to the common and dominant element HUGGY, outweigh the dissimilarities. *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). In view thereof, the *du Pont* factor of the similarity of the marks also favors a finding of likelihood of confusion.

Balancing the Factors

In conclusion, because the marks are similar, the goods are related, and the channels of trade and consumers overlap, we find that confusion is likely between

Applicant's mark BEACH HUGGY and the mark HUGGY PETS in the cited registration.

Decision: The refusal to register based on likelihood of confusion under Section 2(d) of the Trademark Act is affirmed.

The refusal to register absent a disclaimer for BEACH under Section 6 of the Trademark Act is affirmed. However, if Applicant submits the required disclaimer within 30 days of the mailing date of this decision, the decision as to the disclaimer requirement will be set aside, but the application will not be passed to publication in view of the decision under Section 2(d). If the disclaimer is submitted, the wording will read as follows: No claim is made to the exclusive right to use "BEACH" apart from the mark as shown. *See* TMEP § 1213.08(a)(i) (Oct. 2016).