

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: June 2, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

—
In re Jeanette Conrad-Ellis

—
Serial No. 90002764

—
Edward W. Gray, Jr. and Shoko Naruo of Thompson Coburn LLP,
for Jeanette Conrad-Ellis.

Sanjeev K. Vohra, Trademark Examining Attorney, Law Office 110,
Chris A. F. Pedersen, Managing Attorney.

—
Before Taylor, Larkin and Lebow,
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

Applicant, Jeanette Conrad-Ellis, filed an application to register the mark THE BLACK DIAMOND SERIES (in standard characters, “SERIES” disclaimed) on the Principal Register for “a series of fiction books for teen girls, excluding cartoon science fiction books and comic books” in International Class 16.¹

¹ Application Serial No. 90002764 (“the Application”) was filed on June 15, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use anywhere of December 1, 2008, and first use in commerce of March 1, 2009.

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that THE BLACK DIAMOND SERIES, as used in connection with the aforementioned goods, is likely to cause confusion with the mark THE BLACK DIAMOND EFFECT, registered in typed format on the Principal Register for “cartoon science fiction books and comic books” in International Class 16.²

When the refusal was made final, Applicant filed an appeal and several requests for reconsideration, which were denied. The appeal is briefed, and an oral hearing was held. We affirm the refusal.

I. Evidentiary Issues

In his brief, the Examining Attorney noted “that the applicant [] submitted new evidence with its appeal brief. Specifically, applicant [] submitted a list of third-party registrations appended to its appeal and identified as Exhibit 1.”³

In response to that objection, Applicant filed a motion to suspend the appeal and remand the application to the Examining Attorney “for the **sole** purpose of supplementing the record by the addition of [those] federal trademark registrations.”⁴

Additionally, in her reply brief, which was filed contemporaneously with the motion,

The TTABVUE and Trademark Status & Document Retrieval (“TSDR”) citations refer to the docket and electronic file database for the involved application. All citations to the TSDR database are to the downloadable .pdf version of the documents.

² Registration No. 1752451 (“the Registration”), issued February 16, 1993; renewed. A typed mark is the legal equivalent of a standard character mark. *See In re Vittera Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2014).

³ 8 TTABVUE 4 (Examining Attorney’s Brief).

⁴ 9 TTABVUE 2 (Motion to Suspend the Appeal and Remand).

Applicant asserted that “[t]he examiner did not object to any other ... evidence submitted in applicant’s Appeal Brief; therefore, applicant respectfully submits that all evidence submitted in applicant’s Appeal Brief, [sic] subject to the Board’s determination with respect to Exhibit 1.”⁵ Applicant also requested in her reply brief that the Board take judicial notice of the definitions for “black, black book, brown, red, red book, green, green book, white, white book, yellow, yellow book, comic, [and] comic book” that she attached from a hard copy of WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY.⁶

Thereafter, the Board granted Applicant’s motion for remand,⁷ which was treated as a request for reconsideration, and the Examining Attorney determined that the request did not “provide any new or compelling evidence with regard to the outstanding issue(s),” and maintained and continued the final refusal.⁸ The appeal then resumed.⁹

Applicant’s request for remand “for the **sole** purpose of supplementing the record by the addition of [those] federal trademark registrations” is moot in light of the remand, which made those third-party registrations of record. Accordingly, the additional evidence attached to Applicant’s brief was not addressed in Applicant’s limited motion for remand, was not discussed by the Examining Attorney, and is not

⁵ 10 TTABVUE 3 n. 1 (Applicant’s Reply Brief).

⁶ *Id.* at 3.

⁷ 11 TTABVUE (Board Order of October 25, 2021).

⁸ 13 TTABVUE (November 19, 2021 Reconsideration Letter).

⁹ 14 TTABVUE (Board Order of November 29, 2021).

part of the record. We therefore do not consider it. *Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (new evidence submitted with reply brief is “untimely and therefore not part of the record for this case”); *In re Wada*, 48 USPQ2d 1689 n.2 (TTAB 1998) (evidence submitted with reply brief not considered), *aff'd*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999).

As to Applicant’s request that we take judicial notice of the definitions for “black, black book, brown, red, red book, green, green book, white, white book, yellow, yellow book, comic, [and] comic book,” it is well-established that the Board may take judicial notice of dictionary definitions, and we do so here. *See, e.g., In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006) (“The Board has a long history of taking judicial notice of definitions excerpted from print dictionaries and submitted after appeal.”).

II. Likelihood of Confusion

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as “*DuPont* factors”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and *DuPont*, 177 USPQ at 567). “Not all *DuPont* factors are

relevant in each case, 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) (citing *Dixie Rests.*, 41 USPQ2d at 1533).

“Two key factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because the ‘fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.’” *In re Embiid*, 2021 USPQ2d 577, at *10 (TTAB 2021) (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004). *See also In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. Comparison of the Goods and Channels of Trade

We begin with the second *DuPont* factor, which concerns the “similarity or dissimilarity and nature of the goods ... as described in an application or registration...,” and the third *DuPont* factor, which concerns the “similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). We make our determination based on the goods

as they are identified in the applications and cited registrations. *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017).

The Registration identifies “cartoon science fiction books and comic books,” and the Application identifies “a series of fiction books for teen girls, excluding cartoon science fiction books and comic books.”

“The Examining Attorney contends that the goods at issue are “highly related” because “applicant and registrant are both providing fiction books.”¹⁰ Additionally, she made of record various third-party use-based registrations of marks that identify both fiction books and comic books.¹¹ For example:

- Registration No. 4272871 includes a “series of fiction works, namely, novels and books” and “comic books”;¹²
- Registration No. 4905707 includes a “series of fiction books” and “comic books”;¹³
- Registration No. 5065275 includes a “series of fiction books,” “story books” and “comic books”;¹⁴
- Registration No. 5638274 includes “fiction books” and “comic books”;¹⁵
and

¹⁰ 8 TTABVUE 9 (Examining Attorney’s Brief).

¹¹ October 28, 2020 Final Office Action, TSDR at pp. 8-61).

¹² *Id.* at pgs. 11-13.

¹³ *Id.* at pgs. 25-27.

¹⁴ *Id.* at pgs. 28-30.

¹⁵ *Id.* at pgs. 31-33.

- Registration No. 5590881 includes “non-fiction books on a variety of topics” and “comic books.”¹⁶

“While not evidence of use of the marks therein, third-party registrations may serve to suggest that the parties’ goods are of a type which may emanate from a single source.” *DeVivo v. Ortiz*, 2020 USPQ2d 10153, *13 (TTAB 2020); *see also Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis”); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1467 n.6 (TTAB 1988); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

Applicant asserts that “none” of the third-party registrations made of record by the Examining Attorney “contain such specific limitations as ‘science fiction’ and ‘fiction for teen girls’ that are present in this case.”¹⁷ “To the contrary,” she contends, “the references cited by the examiner use more general identifications than those used in the application or the cited registrations.”¹⁸ Specifically, “only one of the cited registrations included science fiction-related books (Reg. No. 6142305 ...), but even that registration did not also cover *cartoon science fiction books*.”¹⁹

Applicant’s argument is unavailing because “a registration that describes goods broadly is presumed to encompass all goods or services of the type described,” *In re*

¹⁶ *Id.* at 37-40.

¹⁷ 10 TTABVUE 7 (Applicant’s Reply Brief).

¹⁸ *Id.*

¹⁹ *Id.* (emphasis in original).

Country Oven, Inc., 2019 USPQ2d 443903, at *9 (TTAB 2019), and “[j]ust as we must consider the full scope of the goods and services as set forth in the application and registration under consideration, we must consider the full scope of the goods and services described in a third-party registration.” *Id.* Hence, the term “fiction books” in the third-party registrations must be read to include “fiction books for teen girls,” and the term “fiction books” in the third-party registrations must be read to include “cartoon science fiction books.”

Applicant also argues that “Registrant’s mark and Applicant’s mark are used with different types of goods” because “girls’ fiction and comic books are widely different genres. They are not likely to be confused by the public nor is an overlapping segment of the public likely to encounter or be interested in girls’ [sic] oriented fiction and science fiction comic books.”²⁰ According to Applicant, “[r]eaders well understand that publications vary significantly by genre. And readers are well able to distinguish genres when searching publications.”²¹

Applicant, however, did not provide any evidence to support her contention that girls’ fiction is a genre that is “widely different” from comics, particularly fictional comics, and “attorney argument is no substitute for evidence.” *In re OEP Enters., Inc.*, 2019 USPQ2d 309323, at *15 (TTAB 2019) (quoting *Cai v. Diamond Hong., Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (internal quotation omitted)). Naturally, consumers will be able to distinguish Applicant’s goods from those in the

²⁰ 6 TTABVUE 10-11 (Applicant’s Brief).

²¹ *Id.* at 7.

cited registration; however, that is not the test. Rather, and as noted, the test is whether consumers will be able to distinguish the source of Applicant's goods from those of Registrant. *See, e.g., Hydra Mac, Inc. v. Mack Trucks, Inc.*, 507 F.2d 1399, 184 USPQ 351 (CCPA 1975) (“[T]he confusion found to be likely is not as to the products but as to their source.”) (citation omitted); *In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012) (same).

Applicant asserts that “[m]eaningful differences between the products and services are often cited as a factor tending to negate...confusion, even when the products are superficially within the same category,” quoting *Matrix Motor Co., Inc. v. Toyota Jidosha Kabushiki*, 290 F. Supp. 2d 1083, 1092 (C.D. Cal. 2003).²² However, the record does not support Applicant's contention that there are meaningful differences between its goods as identified in the Application and those in the Registration. Instead, we find the similar nature of the goods, on their face, buttressed by the third-party registration evidence, sufficient to show the relatedness of Applicant's and Registrant's goods.

Applicant also argues, citing *In re St. Helena Hosp.*, 774 F.3d 747, 754, 113 USPQ2d 1082, 1087 (Fed. Cir. 2014) and *In re Princeton Tectonics, Inc.*, 95 USPQ2d 1509 (TTAB 2010), that “[w]here as here, the types of goods in question are not generally recognized as having a common source of origin, the examiner is required to show ‘something more’ than the mere fact that the goods are sometimes offered

²² *Id.* at 13.

together by the same source.”²³ Applicant’s reliance on *In re St. Helena Hosp.* is misplaced. “Something more” is only required in the context of comparing goods versus services, not goods versus goods, and then only where the relationship between such goods and services is obscure or less evident. *See In re St. Helena Hosp., supra; see also In re Country Oven, Inc.*, 2019 USPQ2d 443903, *13 (TTAB 2019). Applicant’s reliance on *In re Princeton Tectonics* also is misplaced. Unlike in that case where there was insufficient evidence showing that the respective goods, i.e., “personal headlamps” vis-à-vis “electric lighting fixtures,” emanate from a common source. To the contrary, the third-party registration evidence shows that it is common for fiction books, regardless of type, as well as comic books, to emanate from a single source under the same mark.

Finally, Applicant asserts that “even assuming *arguendo* that the goods were sufficiently related and it was common place for such goods to emanate from the same source, the law requires that it be plausible that the same source would publish the very different publications here under a such a similar name as BLACK DIAMOND.”²⁴ Applicant does not cite any authority for its publication plausibility argument, nor are we are aware of any such authority. In fact, the goods 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).

²³ 10 TTABVUE 6 (Applicant’s Reply Brief).

²⁴ *Id.* at 8-9.

Regarding trade channels, the Examining Attorney points out that “in the absence of trade channel limitations in the goods under the registered mark, as in the case here, it may be presumed that the goods under the registered mark are offered in all customary trade channels and are available to the same class of customers of fiction books.”²⁵ See *Citigroup v. Capital City Bank Grp.*, 98 USPQ2d at 1261; *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006).

Applicant does not disagree, but asserts that “the channels of trade ... dictate that such different genres are sold in different locations in physical or electronic stores.”²⁶ Applicant thus concedes that Applicant’s and Registrant’s goods may be sold in the typical trade channels of physical or electronic stores. The contention that the respective goods “are sold in different locations” of such stores, however, is, once again, unsupported. See *OEP Enters.*, 2019 USPQ2d 309323, at *15.

Applicant, citing *Bd. of Regents of Univ. of Wisc. Sys. v. Phoenix Int’l. Software, Inc.*, 653 F.3d 448, 99 USPQ2d 1571 (7th Cir. 2011), further asserts that “[i]t is error for the Examining Attorney to ignore easily assessible evidence of the actual use of the marks as irrelevant.”²⁷ Applicant contends that “it is clear from the public Internet record that the goods in the Cited Registration are distinctly different from Applicant’s respective goods, ... that the parties’ goods are in entirely separate and unique market segment,” and that “looking at the parties’ actual goods and their

²⁵ 8 TTABVUE 11 (Examining Attorney’s Brief).

²⁶ 10 TTABVUE 9 (Applicant’s Reply Brief).

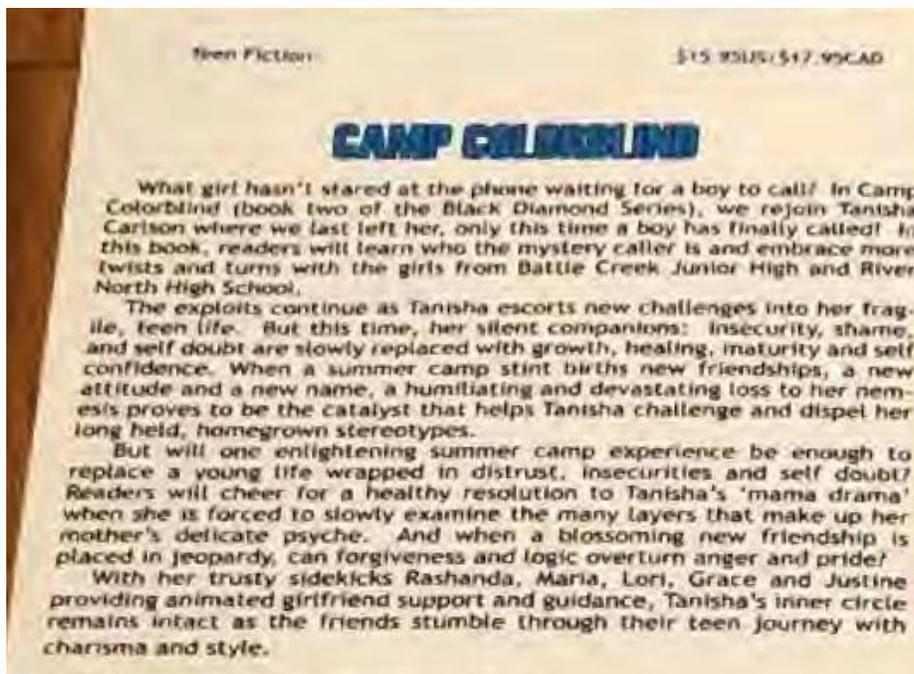
²⁷ *Id.* at 19.

marketing techniques as shown by the parties' websites, helps further confirm that confusion is unlikely to occur."²⁸ Applicant elaborates:²⁹

[T]he public Internet evidence of Applicant's actual use (partially reproduced below) further emphasizes the fact that the market and purchasers of the applied-for goods are different from those of Registrant. Applicant's website, blog, and the books' cover pages contain logos and narratives that appeal to a narrow group of consumers, namely, teen girls. Applicant's website, blog, and books celebrate girls of color through the characters in the books, as Black Diamonds or precious gems in a world that does not value the worth of black girls or girls of color. Applicant uses "black diamond" as a metaphor for the challenges teen girls must navigate in life the way a skier navigates a black diamond ski slope. In fact, Applicant owns and uses the following



design logo in connection with the applied-for goods in the marketplace (U.S. Reg. No. 6,205,557; 2/4/2021 Request for Reconsideration, TSDR Pgs. 27-28). The unique design logo, which depicts a girl navigating a black diamond ski slope further engages and appeals to young girls.



²⁸ *Id.* at 15, 19-20.

²⁹ *Id.* at 16-19.

[First Image Continued]



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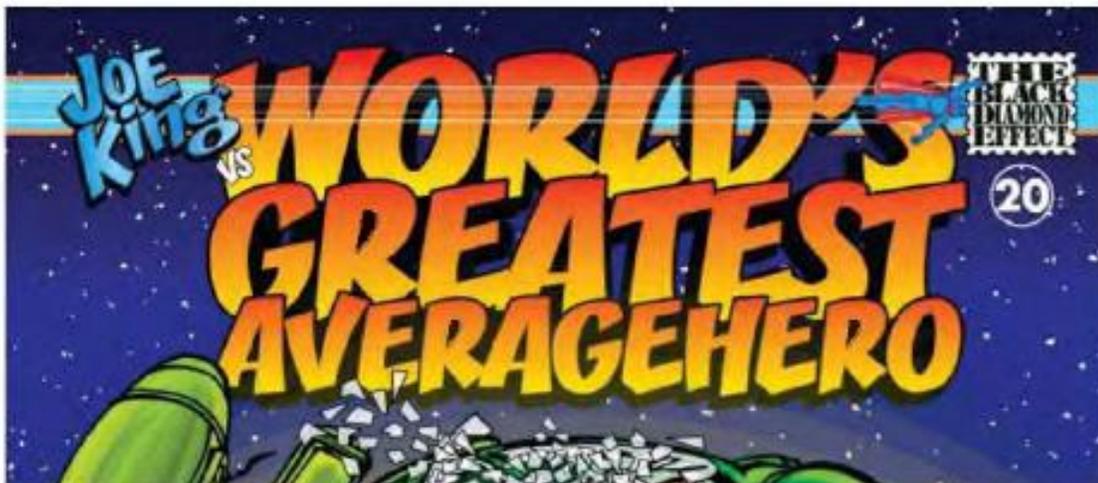
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ABOUT

The Series

The Black Diamond Series chronicles the friendship bond of six teenage girls trying to "get in where they fit in." In book I, the 14-year-old girls are hoping that their designer clothes can help them take their way to fabulous and survive the adolescent roller coaster ride. A six book series, in books II-IV,

On the other hand, Registrant's actual use (4/28/2021 Request for Reconsideration, TSDR Pg. 16; 10/6/2020 Office Action Response, TSDR Pgs. 49-61) ... confirms that the goods are directed to a group of consumers unlikely to overlap with devotees of girls oriented fiction, namely, those interested in science fiction comic and graphic books. Registrant uses comic book covers that highlight extraterrestrial creatures and space atmosphere that further highlights that the goods are science fiction comic and graphic books:



Applicant's reliance on *Bd. of Regents of Univ. of Wisc. Sys. v. Phoenix Int'l. Software, Inc.*, *supra*, a Seventh Circuit case, for its contention that "[i]t is error for the Examining Attorney to ignore easily assessible evidence of the actual use of the marks as irrelevant,"³⁰ is misplaced. While other circuits may follow a different rule, the Federal Circuit has explained that "[t]he authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application **regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.**" *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (emphasis added) (citing *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1042, 216 USPQ 937, 940 (Fed. Cir. 1983), *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1337, 209 USPQ 986, 988 (CCPA 1981), and eight other cases).

Applicant argues that its goods are limited to "fiction for teen girls," and that it is an error for the examiner to broaden such clear limitations in the effort to find a sufficient relatedness of the goods."³¹ This argument is also misplaced because the identification of goods in the Application has no limitations as to classes of consumers. Although Applicant intended audience is teen girls, and its identification of goods reflects that intention, the identification does not limit purchasers to non-teen girls. Applicant's goods may therefore be purchased by anyone interested in the topics or

³⁰ 10 TTABVUE 19 (Applicant's Reply Brief).

³¹ *Id.* at 7.

stories in Applicant's books. Registrant's consumers at least overlap with those of Applicant.

In view of the foregoing, we find that the second and third *DuPont* factors weigh in favor of finding a likelihood of confusion.

B. Comparison of the Marks

The first *DuPont* factor considers the "similarities or dissimilarities of the marks in their entireties as to appearance, sound, connotation and commercial impression." *DuPont*, 177 USPQ at 567; *Stone Lion*, 110 USPQ2d at 1160; *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019).

Our focus is on the recollection of the average purchaser, who normally retains a general, rather than specific, impression of trademarks. *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *In re Assoc. of the U.S. Army*, 85 USPQ2d 1264, 1268 (TTAB 2007). The average purchaser of Applicant's goods are consumers interested in "fiction books for teen girls," and the average purchaser of Registrant's goods are consumers interested in "cartoon science fiction books and comic books."

Consumers may not necessarily encounter the marks in close proximity and must rely upon their recollections of them over time. *In re Mucky Duck Mustard*, 6 USPQ2d 1467, 1468 (TTAB 1988). As such, "marks must be considered in light of the fallibility of memory and not on the basis of side-by-side comparison." *St. Helena Hosp.*, 113

USPQ2d at 1085.

The Examining Attorney asserts that Applicant's mark THE BLACK DIAMOND SERIES is similar to Registrant's THE BLACK DIAMOND EFFECT mark "because they both contain the identical phrase BLACK DIAMOND," thus creating a similar overall commercial impression.³² She also asserts that the final word in Applicant's mark, "SERIES," is descriptive or generic of Applicant's goods and has been disclaimed, and that "disclaimed matter that is descriptive of or generic for a party's goods is typically less significant or less dominant when comparing marks."³³ *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPE) § 1207.01(b)(viii).

Applicant, on the other hand, argues that the respective marks "are different in sight, sound, connotation and overall commercial impression owing to the differences in the third word of each mark...."³⁴ She elaborates:

"EFFECT" means, among other things, "a distinctive impression" or "power to bring about a result." Here, THE BLACK DIAMOND EFFECT has a sci-fi connotation, namely, an unknown "effect" from the black diamond. The inclusion of EFFECT in the Cited Mark fundamentally changes the sight, sound, and meaning of the mark as a whole. THE BLACK DIAMOND SERIES, on the other hand, contains the term SERIES, which sounds, means, and looks different from EFFECT. "SERIES" has different meanings than "EFFECT," such as "a number of things or events of the same class coming one after another in spatial

³² 8 TTABVUE 7 (Examining Attorney's Brief).

³³ *Id.* at 8.

³⁴ 6 TTABVUE 6 (Applicant's Brief).

or temporal succession.”³⁵

For some reason, Applicant relies on definitions that are not as appropriate as other definitions shown in the listings it provided. For example, a more relevant definition of “effect” in this context is “an event, condition, or state of affairs that is produced by a cause,” and the more relevant definition for “series” in the context of Applicant’s series of books is “a succession of volumes or issues published with related subjects or authors, similar format and price, or continuous numbering.”³⁶

Applicant’s argument pertains to the fourth word in the mark (SERIES), not the third (DIAMOND). Both marks include the same first three words “THE BLACK DIAMOND.” In any event, we disagree that the inclusion of “EFFECT” in Registrant’s mark THE BLACK DIAMOND EFFECT “fundamentally changes its sight, sound, and meaning ... as a whole,” even when the apt definitions are used. Instead, we find that while there are some differences in these characteristics, the marks are, overall, more similar than dissimilar, and their respective connotations are complementary. “SERIES” in Applicant’s mark simply describes Applicant’s goods, a “series of fiction books”; it is not source identifying. And “EFFECT” in Registrant’s mark connotes an event or condition caused by THE BLACK DIAMOND. Consumers, therefore, are likely to perceive Registrant’s mark THE BLACK DIAMOND EFFECT as being similar in meaning.

³⁵ *Id.* (citing MERRIAM-WEBSTER DICTIONARY definitions provided with her April 28, 2021 Request for Reconsideration, TSDR at pgs. 6 and 11).

³⁶ April 28, 2021 Request for Reconsideration, TSDR at pgs. 9 and 11.

Applicant contends that “Series’ is a widely known identifier in the Young Girls Fiction Genre that serves as a signal to readers that the novels are sequential in plot, theme, and characters.” While it may be common knowledge that a book designated as a “series” “serves as a signal to readers that the novels are sequential,” Applicant did not present any evidence showing the term to be a “widely known identifier in the Young Girls Fiction Genre.” Applicant’s contention, therefore, is simply attorney argument. *See OEP Enters.*, 2019 USPQ2d 309323, at *15.

Applicant also argues that the word BLACK has a different meaning in the respective marks. According to Applicant:

[T]he word, [sic] “black” does not always reference things that are “black” in color or hue. ... “[B]lack” also is well-known to refer to race or ethnicity. It is also well-known that many persons who are ethnically “black” are not “black” in their color. The public is readily able to distinguish when the word, “black” is used to refer to color or ethnicity or both. Thus, when the commercial impression of THE BLACK DIAMOND SERIES for girls’ literature is considered in its entirety with the identified goods, there is no likelihood of confusion with THE BLACK DIAMOND EFFECT for comic books with a science fiction theme. In the former the word “black” has a clear racial or ethnic connotation that is not present when the word “black” is used in the cited mark.³⁷

We have no doubt that “the public is readily able to distinguish” whether or not the term “black” is used to refer to color or ethnicity, or both. Applicant, however, has failed to produce even a scintilla of evidence demonstrating that “BLACK” in THE BLACK DIAMOND SERIES connotes anything having to do with race. Both marks use the word “BLACK” as an adjective to modify the word “DIAMOND,” and the

³⁷ 6 TTABVUE 7 (Applicant’s Brief).

similarity or dissimilarity of the term (THE) BLACK DIAMOND is what is relevant. “[T]here is no evidence here, or other reason to find, that the [term THE BLACK DIAMOND] has one meaning when used with [a series of fiction books for teen girls] and a second and different meaning when used with [cartoon science fiction books and comic books], based on the nature of the respective goods.” *Embiid*, 2021 USPQ2d 577, at *21.

Applicant argues that it “uses ‘black diamond’ as a metaphor for the challenges teen girls must navigate in life the way a skier navigates a black diamond ski slope.”³⁸ Again, this is simply attorney argument, since Applicant did not introduce evidence to show that she promotes the term “black diamond” as an allegory for such challenges in her marketing materials or otherwise, such that the perception would be readily apparent to consumers. *See OEP Enters.*, 2019 USPQ2d 309323.

Applicant also asserts that it “owns and uses the following design logo  in connection with the applied-for goods in the marketplace (U.S. Reg. No. 6,205,557; 2/4/2021 Request for Reconsideration, TSDR Pgs. 27-28)” and that “[t]he unique design logo, which depicts a girl navigating a black diamond ski slope further engages and appeals to young girls.” However, the purported fact that Applicant uses another mark in connection with the same goods is irrelevant because our analysis is based on the marks as depicted in the Application and Registration, without regard to whether the marks will appear with other marks, such as house marks, or other

³⁸ *Id.* at 16.

elements when used. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993) (indicating that applicant’s assertions that the applied-for mark would appear with applicant’s house mark were not considered in the likelihood of confusion determination); *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016) (rejecting applicant’s argument that, because its mark would appear along with its house mark and other distinguishing matter, the marks at issue were not confusingly similar). Inasmuch as Applicant’s house mark is not part of her THE BLACK DIAMOND SERIES mark at issue here, Applicant’s house mark argument is without merit.

Finally, Applicant argues that “readers are accustomed to seeing color-formative marks in the publication marketplace and can easily distinguish THE BLACK DIAMOND SERIES from THE BLACK DIAMOND EFFECT for publications, especially considering the differences in the marks. Color names are popular in the publishing industry.”³⁹ However, Applicant did not provide evidence demonstrating that consumers are so accustomed. Although she made of record various third-party registrations for color marks, the registrations are not evidence that such registered marks are in use or that the public is familiar with them. *See, e.g., In re I-Coat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018) (citing *In re Infinity Broad. Corp.*, 60 USPQ2d

³⁹ Applicant also argued that “the Trademark Office has granted registrations for a substantial number of publication name marks with colors (e.g., “BLUE”, “RED”, and “PURPLE”) within the mark despite having nearly identical descriptions” and that “[t]here are numerous active registrations for marks comprising color-formatives for printed materials,” to support her contention that “consumers will look to other elements besides the color reference to distinguish source.” *Id.* at 8. However, that argument relies on new evidence that Applicant attached for the first time with her brief that is not of record and which we therefore give no consideration.

1214, 1217-18 (TTAB 2001)); *In re Aquamar*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

The first *DuPont* factor weighs in favor of finding a likelihood of confusion.

C. Absence of Actual Confusion

The eighth *DuPont* factor considers “[t]he length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *Guild Mortg.*, 129 USPQ2d at 1162 (quoting, *DuPont*, 177 USPQ at 567). Therefore, we “look at actual market conditions, to the extent that there is evidence of such conditions of record,” to make this determination.” *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at *19 (TTAB 2020). There is no such evidence of record here.

Applicant argues that “THE BLACK DIAMOND SERIES and THE BLACK DIAMOND EFFECT have been used in commerce for over twelve years, apparently without any consumer confusion” and “evidence of harmonious coexistence creates a strong inference against a finding of likelihood of confusion.”⁴⁰

This argument, like virtually all of Applicant’s arguments, is unsupported. While we have the unsworn statement of Applicant’s counsel that Applicant has used her mark “for over twelve years,” we have no information as to her sales or advertising expenditures, or the geographic areas served by Applicant. *Cf. Guild Mortg.*, 2020 USPQ2d 10279, at *18-19 (finding a “lack of evidence that in the actual marketplace, the same consumers have been exposed to both marks for the respective services,” notwithstanding the applicant’s CEO’s statement in his declaration that the

⁴⁰ 6 TTABVUE 14 (Applicant’s Brief).

respective marks were in use for more than 40 years in the same geographic areas).

Moreover, apart from a blog review of one of Registrant's THE BLACK DIAMOND EFFECT publications, which appears to be number 20 of a series,⁴¹ and a picture of another publication in the series from a different website,⁴² there is no evidence of any use of the registered mark, let alone information relating to the extent of such use. *Cf. In re Gen. Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992) (evidence on eighth *DuPont* factor found persuasive that confusion was unlikely where "during a nearly thirty-year interval of sustained success in the marketing of what, for the average consumer, is typically a major and expensive purchase," the applicant "experienced no reported instances of actual confusion between its use of 'GRAND PRIX' in connection with almost 2.7 million automobiles and registrant's use of its 'GRAND PRIX' marks for related automotive replacement parts.").

Because the record does not demonstrate "appreciable and continuous use by [A]pplicant of [its] mark for a significant period of time in the same markets as those served by [Registrant] under its mark[]," *Embiid*, 2021 USPQ2d 577, at *56 (quoting *Gillette Can. Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992)), we are unable to "assess the length of time and degree to which the applicant's and registrant's commercial activities would have provided an opportunity for confusion to have manifested itself if it were likely." *Id.*

The eight *DuPont* factor is neutral.

⁴¹ October 6, 2020 Response to Office Actions, TSDR at pgs. 49-61.

⁴² *Id.* at pg. 16.

III. Conclusion

Having considered all of the evidence and arguments bearing on the relevant *DuPont* factors, including the similarity of the marks, goods, and trade channels, we conclude that Applicant's mark THE BLACK DIAMOND SERIES, when used on or in connection with "a series of fiction books for teen girls, excluding cartoon science fiction books and comic books," is likely to cause confusion with the mark THE BLACK DIAMOND EFFECT used in connection with "cartoon science fiction books and comic books."

Decision: The refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), is affirmed.