

**THIS OPINION IS NOT A
PRECEDENT OF
THE TTAB**

Mailed: May 22, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jason Jenkins

Serial No. 76682440

Michael J. Bradford of Luedeka, Neely & Graham, P.C. for
Jason Jenkins

Michael Litzau, Trademark Examining Attorney, Law Office
104 (Chris Donninger, Managing Attorney).

Before Quinn, Hairston and Wellington,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Jason Jenkins has filed an application to register the
mark shown below for the following goods, as amended,
"clothing and apparel for outdoorsmen, namely, shirts,
sweatshirts, hats, socks, and jackets" in International
Class 25:¹

¹ Application Serial No. 76682440 was filed on October 1, 2007,
based upon applicant's assertion of his bona fide intent to use
the mark in commerce.



Registration has been finally refused pursuant to Trademark Act §2(d), 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the following mark:



in Registration No. 2119347² for "T-shirts, jackets, [and] hats" in International Class 25, as to be likely, if used on or in connection with the identified goods, to cause confusion, to cause mistake, or to deceive. Applicant and the examining attorney have filed briefs on the issue under appeal. We affirm the refusal.

Our determination under Trademark Act §2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood

² Issued on December 9, 1997, renewed. The word WEAR is disclaimed.

Serial No. 76682440

of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999), and cases cited therein.

We review the relevant *du Pont* factors as they apply to this case.

We begin by comparing applicant's goods with those of registrant. In making our determination under the second *du Pont* factor, we look to the goods as identified in the involved application and cited registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d

Serial No. 76682440

937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); see also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.")

In this case, the registrant's goods are identified as "T-shirts, jackets, and hats," which encompasses some of applicant's more narrowly identified goods, "clothing and apparel for outdoorsmen, namely, shirts, sweatshirts, hats, socks, and jackets." Put another way, the goods are legally identical to the extent that registrant's goods are construed to include T-shirts, jackets and hats for outdoorsmen. The legal identity, in part, of the goods is a factor that weighs heavily against applicant.

Although applicant's goods are restricted to items of apparel "for outdoorsmen," those of registrant do not contain any restrictions as to the channels of trade in which they are distributed or the class of purchasers to whom they are marketed. It is settled that in making our determination regarding the channels of trade, we must look to the goods as identified in the involved application and cited registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, *supra*; and *Paula Payne Products v. Johnson Publishing Co.*, *supra*. Because as noted above the

goods are legally identical in part and otherwise related, and there are no restrictions in the registration, registrant's goods may be presumed to move in the same "outdoorsmen" channels of trade as those of applicant and be available to the same classes of potential consumers, namely, outdoorsmen. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). In this regard, we note that the examining attorney submitted printouts from several third-party websites showing retailers offering hats and jackets for a variety of purposes, including hiking and other outdoor activities.³ This indicates that even if registrant's hats and jackets are not designed for outdoorsmen, they may very well share some of the same trade channels and be offered to the same purchasers. Accordingly, these *du Pont* factors further favor a finding of likelihood of confusion.

We turn now to the first *du Pont* factor, i.e., whether the respective marks are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall 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). We note initially that the test under the first *du Pont*

³ Attached to August 11, 2008 Office Action.

Serial No. 76682440

factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

In this case, the marks are similar because the first literal element in each mark is the term OUCH, with applicant's addition of an exclamation point afterwards. As noted by the examining attorney, the fact that the word which the marks share in common is also the first word in the marks is significant. *Presto Products, Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("...[it is] a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered."). See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, *supra*. The connotation created by this term, OUCH, is clearly that of the cry or interjection "used to

express sudden pain."⁴ There is no indication that this term is anything other than arbitrary or just slightly suggestive (of clothing that will keep you comfortable when doing rigorous outdoor activities) in connection with the identified goods.

As to registrant's mark in particular, we find the term OUCH is the dominant element of the mark. It is significantly larger in size than the other wording in the mark, including the disclaimed, generic term WEAR. The secondary phrase, SO GOOD IT HURTS, appears in even smaller cursive font.

Likewise, we find that the term OUCH! plays a dominant role in applicant's mark. It is significant in the connotation created by the mark and the exclamation point helps emphasize that role and bring attention to the term. Yet, we cannot and do not ignore the other features of applicant's mark, namely, the design of a hiker climbing a stylized mountain and the literal portion, MOUNTAIN, with the letter "t" forming the base of a tree within the mountain design. Taken together in connection with the

⁴ Copy of definition of "ouch" attached to examining attorney's brief. *Merriam-Webster's Collegiate Dictionary*, Tenth Edition (1999). It is well settled that the Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Serial No. 76682440

identified goods, the additional wording and design portions may connote a wilderness theme or create a commercial impression of hiking wear or apparel for outdoors activities.

Ultimately in this case, however, we are persuaded by the factor that it is usually the literal portion in marks that is accorded greater weight than the design element because it is the word portion of the mark that consumers use to request and to identify an entity's products. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 2001); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985). In other words, although applicant's mark has creative design elements not found in the registered mark, consumers will likely describe, refer and/or recall applicant's mark by verbalizing the literal portion, OUCH or OUCH MOUNTAIN. Likewise, consumers will likely reference the registered mark as OUCH or OUCH WEAR. And, as a result, there may be confusion as to which of the two marks is being referenced when the goods in question are legally identical.

Thus, acknowledging that there may be differences in the connotation or commercial impressions of the marks, we

Serial No. 76682440

find that the marks are overall more similar than not. This *du Pont* factor weighs against applicant.

Applicant argues that the term OUCH is "weak in relation to clothing and apparel goods." Brief, (unnumbered) p. 3. In support, applicant points to the cited registration as well as another registered mark, OUCH, for swimwear⁵ that was cited (and later withdrawn) by the examining attorney in the first Office action as a bar to registration based on a likelihood of confusion. Applicant contends that there are "at least six other federal registrations or allowed applications for marks containing the words (sic) "OUCH" for clothing or apparel goods." Applicant provided printout copies of three registrations and three applications.⁶ A review of the referenced applications reveals that all of them have been abandoned prior to any assertion of use in commerce; thus, they have no probative value other than to show applications for those marks were filed and abandoned without any claim that the marks were being used in commerce. As to the referenced registrations of record, other than the cited registration, they are:

OUCH for swimwear;

⁵ Registration No. 3082697.

⁶ Attached to applicant's response (filed July 22, 2008).

OUCH POUCH and OUCH POUCH, JR. for "footwear, namely, elastic fabric and polymer gel products designed to protect areas of a dancer's foot" in International Class 25;⁷ and

OUCHLESS for "hair accessories, namely, elastic hair bands and ponytail holders" in International Class 26.

Applicant argues that "[t]hese multiple third party registrations...are highly probative in this case to show that otherwise distinguishable marks containing this terminology can co-exist in the marketplace without a likelihood of confusion as to the source of goods." Brief, (unnumbered) p. 4.

We find applicant's reliance on the few third-party registrations to be misplaced. First, only one of the registrations identifies an article of clothing. Second, and more importantly, in terms of demonstrating the strength of a mark, absent evidence of actual use, third-party registrations have little probative value because they are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S.

⁷ Registrations Nos. 2597196 and 2597192, respectively, are owned by the same entity. The word POUCH is disclaimed in both registrations.

Serial No. 76682440

Patent and Trademark Office). Simply put, there is no way an assessment can be made as to what, if any, impact those marks may have made in the marketplace. However, even if marks which consist of or contain the term OUCH in connection with clothing are considered to be weak, they are entitled to protection where confusion is likely. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974).

In light of the foregoing, we conclude that consumers familiar with registrant's clothing goods sold under its above-referenced mark would be likely to believe, upon encountering applicant's identical goods sold under his mark that the goods originated with or are associated with or sponsored by the same entity.

Lastly, to the extent that there is any doubt as to whether the overall degree of similarity of the parties' marks is sufficient for purposes of creating a likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. See *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.