

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: August 26, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Darryl F. White

Serial No. 77201896

E. Leonard Rubin of Querrey & Harrow Ltd for Darryl F. White.

Barbara Rutland, Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).

Before Cataldo, Wellington and Shaw,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Darryl F. White filed an application on the Principal Register for the mark shown below for "caps; shirts; pants; footwear; suits; jackets" in International Class 25.¹

¹ Application Serial No. 77201896 was filed on June 8, 2007 based upon applicant's assertion of a bona fide intent to use the mark in commerce on the goods. "The color(s) black, white, silver, light and dark gray is/are claimed as a feature of the mark. The mark consists of the colors black, white, silver, light and dark gray highlights throughout the cube design with the wording "Blak Ice" below the cube design in black letters."



BLAK ICE

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 mark BLACK ICE (in typed or standard characters) in Registration No. 1216820² for "outdoor camping apparel - namely, parkas, vests, mittens, and pants" 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, including applicant's reply brief.

Likelihood of Confusion

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 November 16, 1982. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed. The registration originally included "booties" among the recited goods; however these goods subsequently were deleted from the identification thereof.

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 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.

The Goods

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

937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The 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 the sales of goods are directed.") 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, applicant's goods are identified as "caps; shirts; pants; footwear; suits; jackets" and registrant's goods are identified as "outdoor camping apparel - namely, parkas, vests, mittens, and pants." Thus, on the face of the goods as recited in the application at issue and the cited registration, applicant's pants encompass registrant's outdoor camping pants, which are more narrowly identified inasmuch as they recite a particular purpose, namely, outdoor camping. Put another way, registrant's outdoor camping pants are a subset of applicant's more generally identified pants. Furthermore, applicant's caps, shirts, footwear and jackets

are common clothing items that may be worn for outdoor camping use along with registrant's parkas, vests, mittens and pants. As a result, we are not persuaded by applicant's arguments that its goods do not include outdoor apparel because no such limitation is present in the goods recited in the application. See *Octocom Systems, supra*.

In addition, the examining attorney submitted with her final Office action copies of use-based, third-party registrations reciting goods of a similar type to those identified in the involved application and cited registration. The following examples are illustrative:

Registration No. 3600252 for goods including "dress pants, jackets, footwear, suits, and outdoor wear, namely, coats, raincoats, jackets, and boots";

Registration No. 3336446 for goods including "clothing, namely outdoor apparel, namely, rainwear, fleece jackets, winter jackets, snowboard pants and bibs, gloves; casual clothing, namely, shorts, shirts, pants, socks, thermal underwear"; and

Registration No. 3105363 for goods including "shirts, pants, jackets, caps, footwear, clothing for sports, namely, shirts, pants, and shoes for use in ... camping".

These registrations suggest, in general, that applicant's various items of clothing are related to registrant's various items of clothing for camping. See *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1217-18 (TTAB

2001). Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nevertheless have probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source. See, e.g., *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 at n. 6 (TTAB 1988).

The examining attorney further made of record evidence from commercial Internet websites showing various items of clothing worn for everyday use as well as clothing worn for active, outdoor uses including camping, offered for sale under the same marks. These websites include llbean.com, rei.com, exofficio.com, basspro.com, gandermountain.com, and sierratradingpost.com. Such evidence serves to demonstrate that third parties are using a single mark to identify applicant's goods as well as those of registrant.

Based upon the goods recited in the involved application and the cited registration, as well as the evidence made of record by the examining attorney, we find that applicant's goods encompass in part and otherwise are related to those provided by registrant.³ The legal

³ Applicant, on page one of its brief, indicates that it "would be willing to amend its description of its goods to confine those

identity in part of the goods is a factor that weighs heavily against applicant.

Channels of Trade

As discussed above, applicant's goods 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, supra*; and *Paula Payne, supra*. Because as discussed above the goods are legally identical in part and otherwise related, and there are no restrictions in the application, applicant's goods are presumed to move in all trade channels in which clothing items are typically encountered, and be available to all classes of potential consumers. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). These include the more narrowly

goods to indoor use" and suggests as an example that it is willing to delete "jackets" from its recited goods. We note, however, that applicant was afforded two opportunities to submit an amendment to its identification of goods during examination of its application, and a further opportunity to submit such an amendment with a request for remand. See TBMP §1205.01 (3d ed. 2011). However, applicant never filed a proposed amendment to its identification of goods or a request for remand, and will not now be heard to argue for the first time in its brief that it is willing to do so. See Trademark Rule 2.142(g). See also TBMP §1218 (3d ed. 2011). Accordingly, applicant's speculative offer to amend its identification of goods will be given no consideration.

defined trade channels in which registrant's camping clothing are encountered and the consumers to whom they are made available. Accordingly, this *du Pont* factor further favors a finding of likelihood of confusion.

The Marks

We turn then to the first *du Pont* factor, i.e., whether applicant's mark



BLAK ICE

and registrant's BLACK ICE mark are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, supra*. We note initially that the test under the first *du Pont* 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 comparing the marks, we find that the word portion of applicant's mark i.e., BLAK ICE is identical to the mark BLACK ICE in the cited registration in sound, and nearly identical in appearance. In addition, we note that registrant's BLACK ICE mark is registered in typed or standard character form, and thus is not limited to any special form or style as displayed on its goods. See *Phillips Petroleum Co. v. C.J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35, 26 (CCPA 1971). See also *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir. 2000). As a result, the protection to be accorded registrant's BLACK ICE mark includes the font in which the word portion of applied-for mark appears.

In terms of connotation, we find that the connotations of the marks are identical. To the extent that consumers would ascribe a meaning to BLACK ICE or BLAK ICE as applied to clothing, these essentially identical terms have the same meaning in both marks. And for those consumers who do not ascribe any significance to the term as applied to clothing, BLACK ICE or BLAK ICE will appear as nearly identical arbitrary terms. In addition, we find that the

design of what appears to be a black ice cube in applicant's mark is insufficient to distinguish it from registrant's mark. We find moreover that when a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). For this reason, we consider the word portion, i.e., "BLAK ICE," to be the dominant feature of applicant's mark. We further find that, on the facts before us, and in the absence of any evidence to the contrary, BLACK ICE is a strong mark, and as such is entitled to a broad scope of protection.

In view of the foregoing, we find that, when applicant's mark and registrant's mark are compared in their entireties, they are sufficiently similar in appearance, sound, connotation and commercial impression that, if used in connection with related goods, confusion would be likely to occur. As such, this *du Pont* factor favors a finding of likelihood of confusion.

Actual Confusion

Applicant also argues that there is no evidence of any actual confusion. We do not accord significant weight to applicant's contention, particularly given that the

involved application was filed based upon applicant's assertion of a bona fide intent to use the mark and there is no evidence that applicant has commenced use. The Federal Circuit has addressed the question of the weight to be given to an assertion of no actual confusion by an applicant in an *ex parte* proceeding:

With regard to the seventh DuPont factor, we agree with the Board that Majestic's uncorroborated statements of no known instances of actual confusion are of little evidentiary value. See *In re Bissett-Berman Corp.*, 476 F.2d 640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, [citation omitted], especially in an *ex parte* context.

In re Majestic Distilling, 65 USPQ2d at 1205.

Accordingly, while examples of actual confusion may point toward a finding of a likelihood of confusion, an absence of such evidence is not as compelling in support of a finding of no likelihood of confusion. Thus, we cannot conclude from the lack of instances of actual confusion that confusion is not likely to occur.

Applicant's Assertions Re. the Cited Registration

One final point requires our attention. Applicant asserts in his reply brief that the registered mark is invalid because the combined Section 8 and Section 9 affidavit (1) was untimely filed; and (2) was accompanied by an improper specimen of use. To the extent that applicant's allegations constitute a collateral attack on registrant's registration, they are impermissible. Section 7(b) of the Trademark Act provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in connection with the goods or services identified in the certificate. During *ex parte* prosecution, including an *ex parte* appeal, an applicant will not be heard on matters that constitute a collateral attack on the cited registration (e.g., a registrant's nonuse of the mark). *In re Dixie Restaurants*, 41 USPQ2d at 1534, *supra*; and *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992). See TMEP § 1207.01(d)(iv) (5th ed. 2007). Accordingly, the validity of the cited registration is not before us in this *ex parte* proceeding, and no consideration has been given to applicant's arguments in this regard.⁴

⁴ In the event that applicant sought to challenge the validity of

Summary

Neither applicant nor the examining attorney has discussed any of the remaining *du Pont* factors. We note, nonetheless, that none seems to be applicable, inasmuch as we have no evidence with respect to them.

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

Lastly, to the extent that any of the points raised by applicant raise a doubt about 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.

the cited registration, his remedy would lie in a cancellation proceeding. See generally Trademark Act Section 14, 15 U.S.C. § 1064.