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Mailed: December 4, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re DRHORSEPOWER, INC.

Serial No. 77505597

Andrew D. Skale and Ben L. Wagner of Mintz Levin Cohn Ferris Glovsky and Popeo
for DrHorsepower, Inc.

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Before Zervas, Adlin and Lynch,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

DrHorsepower, Inc. (“Applicant”) seeks registration on the Principal Register of
the mark shown below that contains DRHORSEPOWER YOUR PRESCRIPTION
FOR WINNING!



for energy drinks in International Class 32 (Application).¹ The description of the mark characterizes the design element in the mark as “a whiskered man riding on a cartoon dragster with smoke coming from the wheels.” The Examining Attorney refused registration of Applicant’s mark under § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), as likely to cause confusion with the registered mark HORSEPOWER ENERGY DRINKS (standard characters) for identical goods (the “Registration”).² After the Examining Attorney made the refusal final, Applicant appealed to this Board and filed a request for reconsideration which was denied. We affirm the refusal to register.

I. Applicable Law

The determination under § 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de*

¹ Application Serial No. 77505597 was filed June 23, 2008 based on Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

² Registration No. 3690631 issued October 13, 2010.

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, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods. *See In re Chatam Int'l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“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.”).

With respect to the marks, we must compare them “in their entirety 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 test assesses not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *see also Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012).

As to the goods, we must determine whether their degree of relatedness rises to such a level that consumers would mistakenly believe the goods emanate from the same source. The comparison must be based on the identifications in the Application and Registration. *See Stone Lion Capital Partners, LP v. Lion Capital*

LLP, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

II. Analysis

Turning first in the likelihood of confusion analysis to the relatedness of Applicant's and Registrant's goods, we find that this *du Pont* factor weighs heavily in favor of likely confusion because the goods are identical. Applicant makes no argument alleging differences between the goods themselves.

We also presume, as we must, that Applicant's and Registrant's identical goods, for which both identifications are unrestricted, travel through the same channels of trade to the same class of purchasers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *see also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (affirming Board finding that where the identification is unrestricted, "we must deem the goods to travel in all appropriate trade channels to all potential purchasers of such goods"). The consumers of the energy drinks at issue include members of the general public. Applicant improperly seeks to narrow the channels of trade for the Registration based on its review of Registrant's website, though neither the webpages nor other supporting evidence is of record. *See In re Consolidated Specialty Restaurants Inc.*, 71 USPQ2d 1921, 1929 (TTAB 2004) ("[A]ttorney argument without support in the record ... does not overcome the prima facie case."). Even if Registrant's energy drinks actually travel only in trade channels associated with golf, the identification

of goods in the Registration, energy drinks without limitation, controls, not the goods as sold in the marketplace. *See Cunningham*, 55 USPQ2d at 1848. Attempts in an ex parte proceeding to argue limitations outside the identified goods in the cited registration effectively constitute improper collateral attacks on the validity of the registration. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 105 F.3d 1405, 1408 (Fed. Cir. 1997). Accordingly, given the identical goods and lack of trade channel restrictions in the identifications of goods, we find that the trade channels are identical, and this *du Pont* factor also heavily favors likely confusion.

Turning to the similarity of the marks themselves, we compare them in their entireties. When the goods are identical, the appearance of a mark of similar sound, appearance, or connotation is more likely to cause confusion than if the goods are significantly different. *See Century 21 Real Estate v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir.1992) (“When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.”).

We remain mindful that Registrant may display its HORSEPOWER ENERGY DRINKS standard character mark in any lettering style, including that in which Applicant displays the wording encompassed in its mark. *See Viterra.*, 101 USPQ2d at 1909; *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348 (Fed. Cir. 2010). Both the mark in the Application and the mark in the Registration contain the identical wording HORSEPOWER, though Applicant’s mark includes the additional wording DR and YOUR PRESCRIPTION FOR WINNING!, as well as a design element that the

description of the mark characterizes as “a whiskered man riding on a cartoon dragster with smoke coming from the wheels.” The mark in the Registration contains the obviously generic additional wording ENERGY DRINKS, which Registrant disclaimed.

Applicant contends that its mark differs from that in the Registration because of its prominent design and because it also contains “the unique name DR. HORSEPOWER and the slogan YOUR PRESCRIPTION FOR WINNING!”³ Applicant further argues that the larger number of words and syllables in its mark makes it sound different, and that the doctor and prescription references create a distinct commercial impression that its energy drinks are “just what the doctor ordered.”⁴ Also, Applicant maintains that the slogan brings about a consumer sense that the energy drinks will help them “perform their absolute best and win races in life.”⁵ According to Applicant, the mark in the Registration, by contrast, conveys the impression “that the registrant’s product is a powerful energy drink.”⁶

We find that Applicant’s mark and the mark in the Registration share the dominant element HORSEPOWER and that Applicant’s mark as a whole looks, sounds, and gives an impression that a consumer likely would view as a variation of the mark in the Registration. We agree with Applicant that the design in its mark is large and fairly prominent, but not that it suffices to distinguish Applicant’s

³ 16 TTABVUE at 8-9.

⁴ *Id.* at 10.

⁵ *Id.*

⁶ *Id.* at 11.

mark. The design depicts a doctor character wearing an old-fashioned medical head mirror, who presumably must be “Dr. Horsepower.” Thus, the design emphasizes the DR HORSEPOWER wording that appears first and at the top of the mark. While Applicant’s mark comprises both words and a design, “the verbal portion of the mark is the one most likely to indicate the origin of the goods [services] to which it is affixed.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGaA v. New Millennium Sports, S.L.U.*, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015), *citing CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983). If a mark comprises both wording and a design, greater weight is often given to the wording, because it is the wording that purchasers would use to refer to or request the goods or services. See, e.g., *Viterra*, 671 F.3d at 1366, 101 USPQ2d at 1911; *see also In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010) (holding applicant’s mark, MAX with pillar design, and registrant’s mark, MAX, likely to cause confusion, noting that the “addition of a column design to the cited mark ... is not sufficient to convey that [the] marks ... identify different sources for legally identical insurance services”).

The marks share the term HORSEPOWER as the dominant element or part of the dominant element. Overall, DR HORSEPOWER dominates Applicant’s mark. We find that the other wording, YOUR PRESCRIPTION FOR WINNING!, gives the impression of a tagline or slogan accompanying the DR HORSEPOWER and design brand reference. In the Registration, HORSEPOWER clearly dominates the mark, as the other wording, ENERGY DRINKS, is generic for the goods and has been

disclaimed. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) (“Because ALE has nominal commercial significance, the Board properly accorded the term less weight in assessing the similarity of the marks under DuPont. As a generic term, ALE simply delineates a class of goods.”); *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824 (TTAB 2015) (“And it is beyond dispute that descriptive or generic terms (such as WINE when used in connection with "wines") serve little source-identifying function.”). We remain mindful that “[a]lthough the court may place more weight on a dominant portion of a mark, for example if another feature of the mark is descriptive or generic standing alone, the ultimate conclusion nonetheless must rest on consideration of the marks in total.” *Viterra*, 101 USPQ2d at 1908 (citations omitted).

In considering the marks in their entireties, we find that Applicant’s mark uses the same dominant element, HORSEPOWER, in a way that creates an impression that consumers likely would perceive as a variation of Registrant’s mark for the identical goods. Consumers likely would mistakenly believe that Registrant established a character, “Dr. Horsepower,” to represent the goods sold under its HORSEPOWER ENERGY DRINKS mark, and added a slogan that the drinks are “YOUR PRESCRIPTION FOR WINNING!” Also, where, as here, the goods are identical, the degree of similarity necessary to find likelihood of confusion need not be as great. *See Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004). Accordingly, this factor favors likely confusion.

Applicant next contends that the *du Pont* factor of the number and nature of similar marks in use on similar goods weighs against likely confusion. Citing *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559 (TTAB 1996), Applicant argues that “widespread” third-party use of marks containing the term HORSEPOWER render confusion unlikely.⁷ Applicant attempts to rely on a third-party application containing the term HORSEPOWER for energy drinks. However, “[a]n application is not evidence of anything except that the application was filed on a certain date.” *Wet Seal, Inc. v. FD Management*, 82 USPQ2d 1629, 1634 (TTAB 2007). Thus, the pending application lacks probative value to support the proposition. Applicant also offers four instances of third-party use of the term HORSEPOWER in connection with energy drinks and contends that such use has conditioned consumers to “look to other elements in marks as a means of distinguishing the source of energy drinks.”⁸ In one such example, Applicant submits a Wikipedia entry for the Diesel Energy Drink that indicates that the beverages come with “6000 or 9000 horsepower,” which “refers to the amount (in milligrams) of energy components found in each can.”⁹ The Wikipedia entry does not show direct use by the third party, and regardless, seems to indicate that any use of horsepower is as a measurement of energy components rather than in the manner of a mark. Another example consists of an individual consumer comment about an energy drink, which is marked on the webpage as “no longer available.” The consumer states that the

⁷ 16 TTABVUE at 12-15.

⁸ *Id.* at 14.

⁹ April 13, 2011 Response to Office Action at 3.

drink has “way more horsepower” than another type of energy drink.¹⁰ Again, this evidence does not reflect third party use in the manner of a mark, so as to suggest that consumers are accustomed to distinguishing among *marks* with this common element. The remaining two pieces of evidence show use of the terms “Liquid Horsepower” and “Human Horsepower” with energy drinks.¹¹ Unlike in *Broadway Chicken*, where the record contained hundreds of examples of third-party use, the evidence in this case essentially consists of two examples. Thus, we find that the record here does not show the type of widespread use of marks containing the term contemplated by the holding in *Broadway Chicken*. In this case, the evidence of third-party use of HORSEPOWER with energy drinks does not establish that consumers are accustomed to relying on small differences to distinguish among many marks containing the shared term HORSEPOWER. Thus, we consider this *du Pont* factor neutral.

Applicant also contends that other *du Pont* factors merit consideration, specifically, the extent to which Applicant has a right to exclude others from use of its mark on its goods, and the extent of potential confusion. According to Applicant, the alleged weakness of the mark in the Registration entitles it to relatively less protection and weighs against likely confusion. Even if the evidence of use of the term “horsepower” in connection with energy drinks demonstrates some degree of suggestiveness, we disagree that it rises to the level of proving weakness. Applicant also makes a conclusory argument that given the evidence under various *du Pont*

¹⁰ *Id.* at 5.

¹¹ *Id.* at 2, 4.

factors, any potential confusion is merely de minimis, and “does not rise to a sufficient probability of confusion so as to justify depriving Applicant of a registration under Section 2(d).”¹² As argued by Applicant, this essentially involves the balancing of all the relevant *du Pont* factors, rather than a separate consideration.

Based on the similarity of the marks, as well as the identical nature of the goods and trade channels, we find confusion likely. We treat the remaining relevant *du Pont* factors as neutral. Balancing the relevant factors, we consider the Application likely to result in consumer confusion.

Decision: The refusal to register Applicant’s mark under § 2(d) is affirmed.

¹² 16 TTABVUE at 15.