

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

Hearing:
January 31, 2012

Mailed:
June 22, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re John Shope

Serial No. 77671449

Andrew P. Lahser of Law Office of Andrew P. Lahser PLC for
John Shope.

Kaelie E. Kung, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).¹

Before Seeherman, Mermelstein and Lykos, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

John Shope, an individual, has appealed from the final
refusal of the trademark examining attorney to register
JOHN SHOPE'S SINISTER INDUSTRIES, in standard characters,
with INDUSTRIES disclaimed, for the following goods and
services:

¹ The application was initially examined by Allison E. Hall.
The application was reassigned to Ms. Kung after the issuance of
the final Office action.

Motorcycles, namely, choppers and baggers; Motorcycle structural parts, namely, choppers and custom baggers structural parts; Parts of motorcycles for choppers and custom baggers, namely, filler panels, floor boards, fenders, windshields, dash panels, fuel tanks, and stretch kits comprised of structural parts to expand motorcycle frames (Class 12); and

Motorcycle customization services, namely, customization of choppers and baggers; vehicle maintenance and repair services, namely, reconditioning of motorcycles in the nature of choppers and baggers (Class 37).²

JOHN SHOPE is a living individual whose consent is of record.

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark so resembles the mark SINISTER CYCLES, in standard characters and with CYLCES disclaimed, registered for "retail store services featuring motorcycle parts and accessories,"³ that, used on applicant's goods or in connection with applicant's services, it is likely to cause confusion or mistake or to deceive.

The appeal was fully briefed, and an oral argument was held.

² Application Serial No. 77671449, filed February 16, 2009. The application was initially based on Section 1(b) of the Trademark Act (intent-to-use); applicant subsequently filed an amendment to allege use asserting first use and first use in commerce on May 1, 2009.

³ Registration No. 2608668, issued August 20, 2002; Sections 8 and 15 affidavit accepted.

We affirm the refusal.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (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 and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first consider the du Pont factor of the similarity of the goods and services. As it has often been stated, it is not necessary that the goods or services be identical or even competitive in nature in order to support a finding of likelihood of confusion, it being sufficient that the goods or services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks employed thereon, to the mistaken belief that they

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originate from or are in some way associated with the same producer. In re Home Builders Association of Greenville, 18 USPQ2d 1313, 1317 (TTAB 1990).

The examining attorney has submitted a large number of third-party registrations showing that entities have registered a single mark for the goods and/or services identified in applicant's application and the cited registration. Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993). With respect to the relatedness between applicant's Class 12 goods and the registrant's services, see, for example, Registration No. 3403026 for, inter alia, motorcycles and structural parts therefor and retail store services ... featuring ... motorcycle parts; Registration No. 3243905 for, inter alia, motorcycles and structural parts therefor and retail store services featuring motorcycles and structural parts and accessories for motorcycles; Registration No. 3261030 for, inter alia, motorcycles, structural parts for motorcycles and retail stores in the field of motorcycles, motorcycle parts and accessories. With respect to the relatedness between

applicant's Class 37 services and the registrant's services, see, for example, Registration No. 3533314 for, inter alia, custom motorcycle parts, custom building of motorcycles and retail store services featuring motorcycle parts; Registration No. 3561135 for, inter alia, motorcycle customization services and retail store services featuring motor sports specialty goods in the nature of motorcycles and their parts and accessories; and Registration No. 3027835 for, inter alia, motorcycle customization and retail store services featuring motorcycle parts and motorcycle accessories.

In addition, the examining attorney has submitted evidence from third-party websites advertising that they sell motorcycle parts and accessories and will customize motorcycles. For example, the website of Life Style Cycles, <http://lifestylecycles.com>, shows a photograph of the interior of their retail store, and states that they have "one of the largest inventories of replacement parts and custom accessories" to "help customize your bike any way you want it," and that they "carry an extensive line of parts." They also state that they can "handle any repair or maintenance problem you may have," and can "[trick] out your bike with the latest custom accessories." The website for Demon's Cycle, www.demonscycle.com, states that it is a

custom motorcycle company that sells custom motorcycle parts at locations around the world.

We find that this evidence demonstrates the relatedness of applicant's goods and services and the registrant's services, and that this du Pont factor favors a finding of likelihood of confusion. In reaching this conclusion, we have considered, but are not persuaded by, applicant's argument that his goods and services are limited to custom choppers and custom baggers, and that by definition "customization" is different from the registrant's retail store services because "retail services does not include customization services because customization services is never a commodity." Brief, p. 9. First, applicant's goods, for example, motorcycle structural parts, and parts of motorcycles for choppers, are not limited to customized goods. Second, based on the evidence of record, the term "customized," as used in connection with motorcycle parts, include parts that are used to customize one's motorcycle, but are not necessarily parts that have been designed specifically for the buyer, in the way that a custom-made suit would be made directly to the customer's own measurements. Thus, customized motorcycle parts and accessories can be sold in retail stores, and the evidence shows that such parts are sold in

this manner, and that third parties have adopted a single mark for both the goods and the services. The Board has frequently found that goods and retail stores selling such goods are related. See, e.g., *In re Thomas*, 79 USPQ2d 1021, 1023 (TTAB 2006), in which applicant's goods were identified as "jewelry" and the registrant's services were identified as "retail jewelry and mineral store services." The Board stated that "these are competitive, inherently related goods and services," and quoted J. Thomas McCarthy, *Trademarks and Unfair Competition* § 24:25 (2006), "Where the services consist of retail sales services, likelihood of confusion is found when another mark is used on goods which are commonly sold through such a retail outlet." As for applicant's services and the registrant's services, the third-party registration evidence shows that companies have adopted a single mark for both retail stores selling motorcycle parts and accessories, and for customizing motorcycles.

This brings us to a consideration of the marks. It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood 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 a consideration of the marks in their entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). The registrant's mark is SINISTER CYCLES. Because CYCLES describes the goods sold in the registrant's stores, consumers will view SINISTER as the source-identifying part of the mark, and therefore it is appropriate that we accord much greater weight to this portion. SINISTER is also, based on this record, an arbitrary term for a retail store featuring motorcycle parts and accessories, and therefore we treat the registrant's mark as a strong mark. As for applicant's mark, the word INDUSTRIES in applicant's mark has little source-indicating significance. The effect of applicant's mark is that applicant has added his name, JOHN SHOPE, to the registrant's mark SINISTER. We recognize that the marks also differ because of the final words, CYCLES and INDUSTRIES, but because these terms have little or no source-indicating significance, consumers are not likely to distinguish the marks based on that difference.

Applicant has argued strenuously that the presence of JOHN SHOPE'S in his mark is sufficient to distinguish the marks because of his personal fame. Applicant, the individual John Shope, competed in a television show called "Chopper Challenge," and applicant contends that he is

well-known and consumers will recognize his name when they see the mark JOHN SHOPE'S SINISTER INDUSTRIES. However, whether or not consumers are aware of John Shope, and will understand that the goods and services offered under his mark are associated with him, does not avoid the likelihood of confusion with the registrant's mark and services. The examining attorney likens the instant situation to that of the cases in which the addition of a house mark to a registered mark was found not sufficient to avoid confusion with that registered mark, while applicant argues that his personal name is not a house mark. The key point is not whether or not JOHN SHOPE'S is technically a house mark, but the effect of the addition of this name. In that sense, the cases involving the addition of a house mark are instructive. Thus, in *In re Apparel Ventures, Inc.*, 229 USPQ 225, 226 (TTAB 1986), the Board found SPARKS BY SASSAFRAS for women's blouses, skirts and sweaters was likely to cause confusion with SPARKS for shoes because:

those already familiar with registrant's use of its mark in connection with its goods, upon encountering applicant's mark on applicant's goods, could easily assume that 'sassafras' is some sort of house mark that may be used with only some of the "SPARKS" goods. Conversely, those familiar with only applicant's mark would, upon encountering the registered mark on related goods, assume that all "SPARKS" products come from a single source, and that the source was in

some instances further identified with the words
"by sassafras."

See also, In re Christian Dior, S.A., 225 USPQ 533, 534
(TTAB 1985) (LE CHACHET DE DIOR for men's shirts likely to
cause confusion with CACHET for dresses, soap and cologne:
"In cases involving the addition of a housemark to one of
two otherwise confusingly similar marks, it has been held
that such does not serve to avoid likelihood of confusion.
Rather, such addition may actually be an aggravation of the
likelihood of confusion as opposed to an aid in
distinguishing the marks so as to avoid source
confusion.").

The same reasoning obtains here. Consumers familiar
with the registrant's SINISTER CYCLES mark for retail store
services featuring motorcycle parts and accessories are
likely to believe, upon encountering JOHN SHOPE'S SINISTER
INDUSTRIES mark for motorcycles and parts and for
customization of choppers and baggers, that these goods and
services emanate from or are associated with the
registrant, and that the registrant has chosen to further
identify his goods and services by the name JOHN SHOPE'S.
Or, conversely, there is the likelihood of reverse
confusion, with consumers who are familiar with JOHN
SHOPE'S SINISTER INDUSTRIES motorcycles and parts and his

motorcycle customizing services likely to believe, upon encountering SINISTER CYCLES motorcycle parts and accessories retail stores, that the registrant's services are associated with the applicant. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010) (ML for personal care and skin care products likely to cause confusion with ML MARK LEES for skin care products; quoting with approval the USPTO's argument that the presence of the additional term MARK LEES in registrant's mark does not necessarily eliminate the likelihood of confusion if some terms are identical).

Applicant has pointed out that there are a different number of syllables in the two marks, and that applicant's mark contains four words while the registrant's mark has only two. However, these differences in appearance and pronunciation are largely due to the addition of JOHN SHOPE'S in applicant's mark (as well as the words CYCLES and INDUSTRIES in the respective marks); for the reasons discussed above, the differences do not serve to distinguish the marks.

Applicant also argues that the marks have different meanings, basing this argument on the fact that "sinister" has several definitions. According to applicant, consumers would understand JOHN SHOPE'S SINISTER INDUSTRIES to mean

"the insidious labors of John Shope," while SINISTER CYCLES would be understood as "evil motorcycles." We do not find this argument persuasive. Rather, the possessive JOHN SHOPE'S in applicant's mark would be viewed as providing additional information as to the source of the goods and services, i.e., that they come from JOHN SHOPE. Further, consumers would ascribe the same meaning to SINISTER in both marks, whatever that meaning might be.

Accordingly, we find that the overall meaning and commercial impression of both marks is the same, and that the inclusion of the name JOHN SHOPE'S in applicant's mark merely provides additional information as to the source of the goods. The du Pont factor of the similarity of the marks favors a finding of likelihood of confusion.

Applicant has asserted that the goods and services are expensive, and customers would be careful and discriminating. Applicant bases this argument on the assumption that "vehicles are among the most expensive items purchased by consumers." However, applicant is not selling only motorcycles, but also parts for motorcycles, such as windshields, filler panels and fenders. The website for Kustom Baggers, www.kustombaggers.com, advertises a windshield for \$169.96, while the

Demon Cycle website features pipes exhaust for \$69.00; even applicant sells relatively inexpensive products. As shown in the specimen submitted with his amendment to allege use, he sells fender mounting blocks for \$95, and a saddle bag check strap tether for \$45. Although the latter items would not be included in the motorcycle parts listed in applicant's identification, they are the types of items that would be the subject of the registrant's retail store services featuring motorcycle parts and accessories.

Nonetheless, we accept that because of the nature of the goods and services, they would not necessarily be purchased on impulse or without some degree with care. However, even if we posit that purchasers would note the differences between the respective marks, for the reasons we have already discussed, consumers are not likely to view these differences as indicating different sources for the goods and services. Thus, although we find that the du Pont factor of the conditions of purchase favor's applicant's position, it is not sufficient to outweigh the other du Pont factors favoring a finding of likelihood of confusion.

The next point we consider is fame. Applicant's analysis of the du Pont factors begins with his comments about his fame, and it appears that he considers his fame a strong argument for our finding no likelihood of confusion.

It is important to note that applicant is not asserting that his mark is famous, but rather that he himself is famous as a result of his television appearances and articles about him in the press. Thus, applicant is not asserting that the fifth du Pont factor favors his position. Indeed, this factor refers to "the fame of the prior mark," not to the applicant's mark. And, obviously, applicant is attempting to register JOHN SHOPE'S SINISTER INDUSTRIES, not JOHN SHOPE per se. Applicant is asserting the fame of his name in connection with the 13th du Pont factor, "any other established fact probative of the effect of use." du Pont, 177 USPQ at 567. This is essentially the same argument that applicant has made with respect to the similarity of the marks, namely, that in applicant's mark his name will be recognized, and that this will distinguish his mark from the cited registration. For the reasons we have already discussed, we are not persuaded by this argument.

After considering all the relevant du Pont factors (and to the extent that any factors we have not discussed are relevant, we treat them as neutral), we find that the examining attorney has shown that applicant's use of his mark for his identified goods and services is likely to cause confusion with the cited registration.

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Decision: The refusal of registration is affirmed.