

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

Mailed:
July 27, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re de Ferran Motor Sports Holdings, LLC

Serial No. 77702401

Julia Spoor Gard and Hae Park-Suk of Barnes & Thornburg LLP, for
de Ferran Motor Sports Holdings, LLC.

Renee Servance, Trademark Examining Attorney, Law Office 116
(Michael W. Baird, Managing Attorney).

Before Walters, Ritchie, and Wolfson, Administrative Trademark
Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Applicant de Ferran Motor Sports Holdings, LLC
("applicant") filed an application to register the mark shown
below, for goods ultimately identified as "clothing sold as
merchandise, namely, shirts, sweaters, shorts, infant and
toddler one piece clothing, baby bibs not of paper," in

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International Class 25:¹



The Trademark Examining Attorney refused registration of applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the registered mark DF,² in typed drawing format, for "clothing, namely, tops, bottoms, shorts, pants, swimwear, socks, coats, sweat shirts, sweat pants, jackets, hats, belts and footwear," in International Class 25, that when used on or in connection with applicant's identified goods, it is likely to cause confusion or mistake or to deceive.

¹ Serial No. 77720401, filed March 30, 2009, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a *bona fide* intent to use the mark in commerce. The application includes the following description: "The mark consists of the letters df with a right angle with a line next to it above the d and a right angle with a line next to it below the f." The application initially included other classes, which applicant divided into a separate application. We note that buried in applicant's reply brief were offers to amend both the description of its mark and its identification of goods. These requests should have been made in a separate request for remand, not buried in a reply brief. See *In re Major League Umpires*, 60 USPQ2d 1059, 1060 (TTAB 2001). In any event, we do not find "good cause" for remand, and the requests are denied. 37 CFR § 2.142(d); TBMP § 1207.02 (3rd ed. 2011).

Upon final refusal of registration, applicant filed a timely appeal. Both applicant and the examining attorney filed briefs, and applicant filed a reply brief. For the reasons discussed herein, the Board affirms the refusal to register under Section 2(d).

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also, In re Majestic Distilling Company, 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 similarities between the goods or services. *See 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").

The Goods and Channels of Trade

Both the application and the cited registration identify "shorts." Furthermore, the "tops" identified in the cited registration would encompass the "shirts" and "sweaters"

² Registration No. 287030, issued March 30, 2004. Sections 8 and 15 affidavits accepted and acknowledged.

identified in the application. Accordingly, the goods are identical-in-part.³

Because the goods described in the application and the cited registration are identical-in-part, we must presume that the channels of trade and classes of purchasers of these goods are the same. See *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers"). Additionally, there is nothing in the recital of goods in either the cited registration or the application that limits either registrant's or applicant's channels of trade. See *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992) (because there are no limitations as to channels of trade or classes of purchasers in either the application or the cited registration, it is presumed that the registration and the application move in all channels of trade normal for those services, and that the services are available

³ We note that the "amendment" that applicant proposes with its reply brief, specifically adding the words "licensed promotional clothing supporting an auto racing team, . . ." would still not eliminate the fact that the ensuing named "shirts," "sweaters," and "shorts" are overlapping with the "tops" and "shorts" in the cited registration.

to all classes of purchasers for the listed services). In other words, there is nothing that prevents applicant's "shorts" and "shirts" or "sweaters" from being sold in the same stores and to the same classes of consumers that purchase registrant's "shorts" and "tops" (and vice-versa). Accordingly, we find that these *du Pont* factors weigh heavily in favor of finding a likelihood of consumer confusion.

The Marks

Preliminarily, we note that the more similar the goods at issue, the less similar the marks need to be for the Board to find a likelihood of confusion. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

In comparing the marks, we are mindful that the test 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 so that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5,

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1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

The mark in the cited registration consists solely of the letters "DF," in typed drawing format. Applicant's mark is as follows:



The literal portion of applicant's mark, i.e., the letter combination "df," is in sight and sound identical to the mark in the cited registration. Applicant argues that the registrant presents its mark in a particular manner with a "bright red color," "wings," and "horns." (appl's brief at unnumbered 6-7). With a registered mark in typed drawing format, however, the registrant is entitled to present its mark in any of a number of different formats, including ones resembling that presented by applicant's mark. See *Citigroup Inc. v. Capital City Bank Group Inc.*, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011) ("If the registrant . . . obtains a standard character mark without claim to 'any particular font style, size or color,' the registrant is entitled to depictions of the standard character mark regardless

of font, style, size, or color, not merely 'reasonable manners' of depicting its standard character mark.").

Finally, there is nothing to indicate that the "DF" in the cited registration would have a different commercial impression than the "df" with design element in the application. Generally, it is the words (in this case the letters) and not the design that will be used by consumers to call for or refer to the goods. *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82 (Fed. Cir. 1983); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 2001); *In re Appetito Provisions Co., Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987). Moreover, the design element in the mark consists essentially of lines surrounding the letters "df." As such the design focuses the viewer on the letters "df." We find that the marks are more similar than dissimilar. The cases that applicant cites are unavailing. In none of them was the mark cited against a registered mark in standard or typed format drawing, with an open-ended appearance and commercial impression.

Applicant argues that the cited registration is weak, and that the shared term "DF" has been included in eight third-party registrations for marks for similar goods. However, the examining attorney objected to this evidence as having been untimely submitted for the first time with applicant's appeal brief. The record in an *ex parte* proceeding must be complete prior to appeal. Trademark Rule 2.142(d); 37 CFR § 2.142(d). Exhibits that were attached to a brief but not made of record during examination are untimely, and will not be considered.

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See In re Fitch IBCA, Inc., 64 USP2d 1058, 1059 n.2 (TTAB 2002); *see also* TBMP §§1203.02(e) and 1207.01 (3d. ed. 2011).

Accordingly, the objection is sustained, and we have not considered the registrations submitted for the first time with applicant's appeal brief. We note, in any case, that even weak marks are entitled to protection against registration of a confusingly similar mark for in-part identical goods. *See Giant Food Inc. v. Rosso and Mastracco, Inc.*, 218 USPQ 521 (TTAB 1982).

On balance, we find that the marks are similar in appearance, pronunciation and meaning, and project very similar commercial impressions. Accordingly, we find this *du Pont* factor to also weigh in favor of finding a likelihood of consumer confusion.

Balancing the Factors

In summary, we have carefully considered all of the evidence and arguments of record relevant to the pertinent *du Pont* likelihood of confusion factors. We conclude that with in-part identical goods travelling in the same channels of trade, and similar marks with similar connotations, there is a likelihood of confusion between applicant's mark df and design, for which it seeks registration for "clothing sold as merchandise, namely, shirts, sweaters, shorts, infant and toddler one piece clothing, baby bibs not of paper," and the registered mark DF for "clothing, namely, tops, bottoms, shorts, pants, swimwear, socks, coats, swat shirts, sweat pants, jackets, hats, belts and footwear."

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Decision: The refusal to register is affirmed.