

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mike Tonche

Serial No. 77730883

Raman N. Dewan of Jackson Walker LLP for Mike Tonche.

David E. Tooley, Jr., Trademark Examining Attorney, Law
Office 112 (Angela Wilson, Managing Attorney).

Before Seeherman, Wellington and Lykos, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Mike Tonche, an individual, has appealed from the
final refusal of the trademark examining attorney to
register STREETLIGHT CLOTHING, in standard characters, and
with CLOTHING disclaimed, for "clothing, namely, T-shirts,
sweatshirts, shirts, hats, pants, shorts, jackets, and
caps."¹ Registration has been refused pursuant to Section

¹ Application Serial No. 77738003, filed May 6, 2009, based on
Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b) (intent-
to-use).

2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark so resembles the mark STREET LIGHTS, registered in standard character form and with LIGHTS disclaimed, for "footwear incorporating a light feature,"² that, if used on applicant's identified goods, it is likely to cause confusion or mistake or to deceive.

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).

Turning first to the goods, the examining attorney has made of record a number of third-party registrations showing that a single mark has been adopted for both the

² Registration No. 2191991, issued September 29, 1998; Section 8 & 15 affidavits accepted and acknowledged; renewed.

clothing items identified in applicant's application and for footwear. See, for example, Registration No. 3736401 for FOX, Registration No. 3760320 for LEONARD STUTZER and design, Registration No. 3739329 for VIRTUOUS TRUWEAR and Registration No. 3736835 for BOXING BEE, all of which include in their identifications footwear and the specific clothing items listed in applicant's identification.

We note that the goods identified in the cited registration are not "footwear" per se, but a very specialized type of footwear that incorporates a light feature. We must say that we are somewhat troubled about how to treat the third-party registration evidence. Although the third-party registrations do not specifically identify "footwear incorporating a light feature," we recognize that such specificity is not required in an identification of goods, and is normally not provided by a registrant. That is, the term "footwear" is an acceptable identification, whether the registrant uses its mark for one type or many types of footwear. If we were to require that third-party registrations reflect every detail of the goods as identified in an applicant's application or cited registration, this could result in applicants adding irrelevant details to nullify the probative value of third-party registrations. On the other hand, there is nothing

in the record to show that footwear normally can include a light feature, such that the term "footwear" in the third-party registrations should be assumed to include such a feature.

Bearing in mind these conflicting concerns, we have decided to give some probative value to these third-party registrations in showing that applicant's and the registrant's goods are related.³ At the same time, however, we recognize that, at most, third-party registrations *serve to suggest* that the listed goods and/or services are of a type which may emanate from a single source. In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993). As opposed to cases in which shoes and clothing have been found to be related because they are complementary items, that is, one might purchase shoes to go with a particular outfit, and therefore may buy both clothing and footwear during a single shopping trip, there is nothing in the record that would indicate that the registrant's particular type of footwear incorporating a light feature would be purchased to complement the type of clothing items

³ We note that the examining attorney also submitted some third-party registrations for what appear to be "merchandising" marks, e.g., marks which are registered for a wide variety of articles and have licensing value, such as registrations owned by Miami Heat Limited Partnership for MH and design and NBA Development League Limited for MAD ANTS FORT WAYNE. We have not considered these registrations.

identified in applicant's application, or that a consumer would purchase the identified clothing to complement his or her footwear. Compare *In re Melville Corp.* 18 USPQ 1386, 1388 (TTAB 1991), in which women's shoes were found to be related to women's pants, blouses, shorts and jackets:

A woman's ensemble, which may consist of a coordinated set of pants, a blouse and a jacket, is incomplete without a pair of shoes which match or contrast therewith. Such goods are frequently purchased in a single shopping expedition. When shopping for shoes, a purchaser is usually looking for a shoe style or color to wear with a particular outfit. The items sold by applicant and registrant are considered to be complementary goods.

Thus, although we find the third-party registrations sufficient to show that the goods are related, this du Pont factor does not strongly favor a finding of likelihood of confusion.

The examining attorney has asserted that the goods travel in the same channels of trade. In support of this position, he has submitted printouts from three on-line retail stores. The page from the Old Navy website, <http://oldnavy.gap.com>, lists, under "Shoes & Slippers," sandals, flats, skimmers, heels, wedges, boots, slippers and flip-flops, and also lists "Tees & Polos, Shirts & Tops, Pants, Shorts & Capris and Outerwear"; the page from the Eddie Bauer website, www.eddiebauer.com, advertises

denim jeans and also shows a photograph of a man and woman in an outdoor setting, urging viewers to "Be the first to shop our New! Fall 2009 Collection." This page lists at the top various categories, including "Swim," "Men," "Women" and "Shoes & Accessories"; the printout from the Kenneth Cole website, www.kennethcole.com, features shoes and boots and also lists at the top of the page the categories "Men," "Women," "Kids," "Shoes," "Accessories," "Clothing," "Sale."

None of these printouts shows shoes with a light feature, such as the shoes identified in the cited registration. Because shoes with a light feature may be a specialty item that is not sold in the same channels of trade as ordinary footwear, we cannot conclude from the examining attorney's evidence that simply because footwear in general and clothing are sold through the same websites, that the goods identified in applicant's application and the cited registration are sold in the same channels of trade.⁴ However, it is clear from the nature of the goods

⁴ In his brief the examining attorney refers to the printouts in support of his statement that "many apparel companies both produce and sell clothing and footwear." p. 8. We point out that while the websites show that these entities sell both clothing and footwear, we cannot ascertain from the evidence of record whether the goods are produced by the sellers or sold under the same brand; further, because the excerpts show only category titles, without showing actual product, we cannot

themselves, i.e., they are ordinary consumer items, that the customers for the goods are the general public. Thus, whether or not the goods are sold in the same channels of trade, they will be encountered and purchased by the same classes of customers.

With respect to the du Pont factor of the conditions of purchase, neither applicant nor the examining attorney submitted any evidence about the price range for the identified goods, or any argument about the discrimination or lack thereof by the purchasers. Although one of the internet printouts shows that Old Navy sells sandals for \$15.00, there is no indication that these sandals have a light feature, and therefore we cannot consider the registrant's footwear to be an inexpensive item. We can therefore conclude only that, since the goods are normal consumer items, they will be bought by customers exercising a normal degree of care. This du Pont factor is neutral.

This brings us to a consideration of the marks. Applicant's mark is STREETLIGHT CLOTHING, the cited mark is STREET LIGHTS. In comparing the marks, we begin with the well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of

determine, for two of the online retailers, the specific clothing items that they offer.

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). Because the word "clothing" is generic for applicant's goods, and therefore has no source-indicating value, the dominant portion of applicant's mark is STREETLIGHT. As for the cited mark, STREET LIGHTS, although the word LIGHTS has a suggestive or descriptive significance because the footwear has a light feature, the mark as a whole also has a double entendre as meaning streetlamps, and therefore we consider neither element of this mark dominant.⁵

Both applicant's mark and the cited mark are extremely similar in appearance and pronunciation. The fact that

⁵ Applicant and the examining attorney have referred to the fact that each mark contains disclaimed material. Applicant has complained that the examining attorney treats the fact of the disclaimers in the application and registration differently: "it is inequitable to infer that the term "CLOTHING" should be discounted in Applicant's mark when analyzing the marks since it is disclaimed, but the term "LIGHTS" should not be discounted in the Cited Mark even though it is disclaimed. We point out that it is not the presence or absence of a disclaimer that determines the weight to be accorded part of a mark, but the significance that the disclaimed matter will have to consumers of the goods. Thus, it is because CLOTHING is the generic term for applicant's goods that it has no source-indicating significance, not because it has been disclaimed.

applicant's mark contains the word CLOTHING and STREETLIGHT is depicted as one word and in the singular, while the cited mark has a space between STREET and LIGHTS and LIGHTS is in the plural, does not affect the appearance or pronunciation of the marks sufficiently to distinguish them. However, when it comes to the connotations of the marks, there is a significant difference. Because a light feature is a significant characteristic of the footwear identified in the cited registration, the word LIGHTS in the cited mark conveys a meaning separate and apart from the meaning of "streetlamp" in applicant's mark. (We take judicial notice of the dictionary definition of "streetlight" submitted as part of the examining attorney's brief: one of a series of lights that are usually attached to tall poles, are spaced at intervals along a public street or roadway, and are illuminated from dusk to dawn. *Also called streetlamp.*⁶) When combined with the word STREET, which applicant contends "is easily associated with footwear," brief, p. 3, the cited mark has a different connotation from applicant's mark, which is solely that of a "streetlamp."

⁶ The American Heritage Dictionary of the English Language © 2007. 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 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

We note the examining attorney's argument that the word "street" is associated with all types of clothing, not just footwear, because "street" is defined as "appropriate for wear or use in public: *street clothes*."⁷ However, because of the goods with which the word STREET is used, and the manner in which the term appears in both marks, including the fact that in applicant's mark STREET is not depicted as a separate word, but is merged with LIGHT so that the overall mark is perceived as having the meaning "streetlamp," we do not view the word STREET as having the same meaning in the two marks. Rather, we agree with applicant that in connection with footwear, it indicates that the footwear is used to walk on the street, while the meaning of "appropriate for wear in public" is not conveyed in the mark STREETLIGHT for clothing.⁸

The Board has previously found that even the use of an identical mark is not likely to cause confusion if, because of the goods or services involved, the marks convey

⁷ The American Heritage Dictionary of the English Language © 2007. We take judicial notice of this definition included in the examining attorney's brief.

⁸ On the contrary, if consumers recognized the meaning of STREET in applicant's mark as "appropriate for wear in public," the STREET element would have a descriptive significance. The word LIGHT might then be viewed as meaning "lightweight," and the mark as a whole would suggest lightweight clothing appropriate for wear in public. We hasten to add that we do not consider applicant's mark to convey such meaning.

different meanings. In particular, the Board has reached such a result when the goods at issue are types of clothing. See, for example, *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987) (no likelihood of confusion between CROSS-OVER for bras and CROSSOVER for ladies' sportswear, namely, tops, shorts and pants); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (no likelihood of confusion between PLAYERS for men's underwear and PLAYERS for shoes); and *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (no likelihood of confusion between BOTTOMS UP for ladies' and children's underwear and BOTTOMS UP for men's suits, coats and trousers).

In the present case, due to the specialized nature of the registrant's goods, i.e., the footwear incorporates a light feature, the cited mark STREET LIGHTS has a readily recognizable meaning relating to this light feature that is absent from applicant's mark STREETLIGHTS used for shirts, sweatshirts, t-shirts, pants and the like.⁹ Accordingly, we find that the marks are different in connotation and in

⁹ In his brief the examining attorney makes the statement "applicant has not limited its goods to exclude clothing incorporating a light feature." However, there is no evidence of record that clothing normally includes a light feature, such that we must treat applicant's identified clothing as encompassing clothing items with a light feature.

commercial impression. We also find that these differences are significant to the outcome of this appeal.

As has often been said, each case must be determined on the particular facts. Under the facts of this case, including the specialized nature of the goods identified in the cited registration; the lack of any evidence regarding any complementary nature of these specific goods and the clothing items identified in applicant's application or that the goods are sold in the same channels of trade; and the additional meaning of the registrant's mark that is absent from applicant's mark, we find that the Office has failed to meet its burden of proving that applicant's mark is likely to cause confusion with the cited registration.

Decision: The refusal of registration is reversed.