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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Melvin Calhoun, Jr.

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Serial No. 77946290

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for Melvin Calhoun, Jr.

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Before Seeherman, Bucher and Zervas, Administrative  
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Melvin Calhoun, Jr. ("applicant") filed an application  
to register the standard character mark **KUTT CALHOUN** on the  
Principal Register under Trademark Act Section 1(a), 15  
U.S.C. § 1051(a), for "Bottoms; Jackets; Jerseys; Tops;  
Wearable garments and clothing, namely, shirts," claiming  
first use and first use in commerce on September 26, 2008.  
Applicant asserts at p. 12 of his brief that he "is a very  
well[-]known recording artist signed to a successful record

label with a track record of extremely high volume of record sales and numerous successful albums under [his] belt"; and KUTT CALHOUN is his stage name.

Registration of applicant's mark has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark so resembles the mark **CALHOUN** (in standard character form) for "sports shirts" in International Class 25, registered on the Supplemental Register (Registration No. 1164255), that as used on applicant's goods, it is likely to cause confusion or mistake or to deceive.

Our determination under Trademark Act § 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood 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 Imp., 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 Rests. 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 [or services] 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 Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

We first consider the goods. The "sports shirts" identified in registrant's registration are encompassed by the "shirts" identified in applicant's application. Thus, for purposes of our analysis, we consider the goods to be in part identical. We need not make determinations regarding the similarity or dissimilarity of any of the other goods in the application. If there is likelihood of confusion based on use of the marks on any of the goods in applicant's application and the goods in the cited registration, the refusal of registration must be affirmed. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981).

In addition, applicant's and registrant's identifications of goods do not have any limitation to particular channels of trade or classes of consumers. When identical goods are recited in an application and registration with no limitations as to their channels of trade or classes of consumers, such channels of trade and classes of consumers must be considered to be legally

identical. *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.").

Accordingly, we must consider applicant's and registrant's goods to be offered in the same channels of trade to the same potential purchasers, and are not persuaded by applicant's argument that the trade channels are different because applicant sells his clothing to fans as promotional materials for applicant at concert venues and particular websites, while registrant's sport shirts are "presumably sold in traditional retail channels."

We next consider the similarity or dissimilarity of the marks, comparing the marks for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay*, 73 USPQ2d at 1692. "[T]he 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 [or services] offered under the respective marks is likely to result." *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1727 (TTAB 2008). "[I]n articulating reasons for reaching a conclusion on the issue

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 consideration of the marks in their entireties." *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Further, as is the case in this appeal with marks appearing on identical goods, "the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

Applicant argues that the dominant part of the mark is KUTT and that the common portion between the two marks, the "well known surname CALHOUN, ... is not likely to be perceived by purchasers as a distinguishing source because it is merely descriptive" and registered on the Supplemental Register. Brief at 9 - 10. On the other hand, at pp. 12 - 13 of his brief, applicant asserts that applicant is "very well known"; that "tens of thousands of dollars [have been] invested into promotion and advertising of the recording artist and his stage name"; that applicant's "debut album landed Applicant KUTT CALHOUN at #60 on the *Billboard* charts"; that "[c]onsumers who purchase the clothing from this artist, recognize the items

as coming from this recording artist"; and that "[w]ithin his genre of rap, the mark is ... famous among the relevant consuming public." Applicant concludes that as a result of the weakness of registrant's surname mark and the recognition of applicant, there cannot be any likelihood of confusion.<sup>1</sup>

If the public would associate applicant's mark with applicant, as applicant maintains, the association would exacerbate, rather than obviate, the likelihood of confusion between applicant's mark and the cited registered mark. That is, consumers who are aware of applicant's mark are likely to believe, upon seeing the registrant's mark CALHOUN on sport shirts, that the shirts emanate from the same source as KUTT CALHOUN shirts. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). In *Shell*, the Court made clear that "[t]he trademark law not only protects the consumer from likelihood of confusion as to commercial sources and relationships, but also protects the registrant and senior user from adverse commercial impact due to use of a similar mark by a newcomer," and further described the possible impact as "reverse confusion," explaining:

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<sup>1</sup> Applicant's argument is that applicant himself is famous, not that KUTT CALHOUN is a famous trademark for clothing.

The term "reverse confusion" has been used to describe the situation where a significantly larger or prominent newcomer "saturates the market" with a trademark that is confusingly similar to that of a smaller, senior registrant for related goods or services. The junior user does not seek to benefit from the goodwill of the senior user; however, the senior user may experience diminution or even loss of its mark's identity and goodwill due to extensive use of a confusingly similar mark by the junior user. The avoidance of confusion between users of disparate size is not a new concept; however, the weighing of the relevant factors must take into account the confusion that may flow from extensive promotion of a similar or identical mark by a junior user. In considering likelihood of confusion as to the source of services that are not identical, or likelihood of confusion as to whether there is a relation between the source of the services, the extent of the registrant's and the newcomer's activities relating to the mark must be given weight appropriate to the circumstances. (Citations omitted.)

Consumers who know that KUTT CALHOUN is the name of a musician would consider CALHOUN as an abbreviated reference to applicant when these marks are used on the same goods.

Applicant has asserted that CALHOUN is merely descriptive, registered on the Supplemental Register, and "not likely to be perceived by purchasers as a distinguishing source ...." Brief at 10. We acknowledge that CALHOUN is a surname, and assume that it was registered on the Supplemental Register for that reason. However, marks on the Supplemental Register may be cited as a bar to registration of a mark under Trademark Act § 2(d).

See, e.g., *In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337 (CCPA 1978). There are no "special rules regarding the registration of marks involving surnames in determining the issue of likelihood of confusion" under Section 2(d). *Hunt Foods & Indus., Inc. v. Gerson Stewart Corp.*, 367 F.2d 431, 151 USPQ 350, 352 (CCPA 1966); see also, *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, n.20 (TTAB 2007) ("The fact that ARDEN is a surname does not automatically render the mark weak or entitled to only a narrow scope of protection."). Additionally, even if a mark is "weak" or "descriptive," it does not mean that it is not entitled to protection:

The description of marks as "weak" or "strong," and references to the "breadth of protection" to be given a mark, have served as a convenient type of shorthand in the literature of opinions concerned with likelihood of confusion. ... Such expressions, however, should not obfuscate the basic issue. Confusion is confusion. The likelihood thereof is to be avoided, as much between "weak" marks as between "strong" marks, or as between a "weak" and a "strong" mark.

*King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974). The protection to be accorded registrant's mark certainly extends to prevent the registration, for legally identical goods, of the nearly identical mark, consisting of the identical surname and differing only in the addition of KUTT to CALHOUN. Further,



there is no evidence of third-party use of marks containing the name CALHOUN for similar goods. Thus, while the scope of protection accorded to registrant's mark may be limited, it is not so limited as to allow the registration of applicant's mark.

Applicant also argues that the consumers are sophisticated and that "purchasers of Applicant's clothing line will not be confused ... because they will be purchasing merchandise of a rap recording artist, usually at concert events they will attend where they have paid good money to see Applicant or on websites for the artist, and other similar venues." This argument is really one that concerns trade channels, which we discussed above, and not purchaser sophistication or, more accurately, the care with which the goods will be purchased. We must assume that the goods can be sold in all appropriate channels of trade, including in clothing stores where the registrant's goods are sold. Further, applicant's argument does not address the issue of reverse confusion.

In this situation, where the goods are identical in part, the trade channels and purchasers are identical, and the marks are very similar, we find that confusion is likely, whether it is that applicant's mark is likely to be confused with registrant's mark, or reverse confusion.

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**Decision:** The refusal to register applicant's mark under Trademark Act §2(d) is affirmed.