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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 Richard Starkey aka Ringo Starr

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Serial No. 78821116

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Stephen J. Strauss of Fulwider Patton LLP for Richard Starkey aka Ringo Starr.

Jeffrey S. DeFord, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

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Before Seeherman, Grendel and Wellington, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark **RINGO** (in standard character form) for Class 25 goods identified in the application as:

> clothing, namely sweatshirts and sweatpants, shorts, tops, t-shirts, sport shirts, shirts, wind resistant jackets, jackets, belts and socks; headgear, namely, headbands, hats, caps and beanies; and footwear, all depicting the name and image of a famous entertainer.

The application was filed on February 22, 2006, and is based on applicant's assertion of a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

The Trademark Examining Attorney has issued a final refusal to register applicant's mark on the ground that the mark, as applied to the goods identified in the application, so resembles the mark **RINGO**, previously registered on the Principal Register (in standard character form) for Class 25 goods identified in the registration as "men's, women's, and children's clothing; namely, shirts, blouses, pants, shorts, hosiery, jackets, and underwear,"[1] as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant has appealed the final refusal.

For the reasons discussed below, we affirm the refusal to register.

Initially, we sustain the Trademark Examining Attorney's objection to the evidence (pertaining to applicant's fame) which applicant submitted for the first time with his brief. That evidence is untimely and shall

[1] Registration No. 1889314, issued on April 11, 1995. Renewed.

be given no consideration. Trademark Rule 2.142(d), 37 C.F.R. §2.142(d).

However, we grant applicant's request (to which the Trademark Examining Attorney has stated that he has no objection) that we take judicial notice that applicant is a famous entertainer who performs under the stage name "Ringo Starr."

The Section 2(d) likelihood of confusion issue before us in this case is whether consumers encountering applicant's and registrant's goods in the marketplace are likely to be confused, based on the marks appearing on the respective goods, as to whether a source relationship exists between the respective goods. Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to the second *du Pont* factor, which requires us to determine the similarity or dissimilarity of the goods identified in applicant's application and the goods identified in the cited registration. We find that applicant's goods identified as shirts, shorts and jackets are legally identical to the shirts, shorts and jackets identified in the cited registration, and that the remaining clothing items identified in applicant's application are closely related to the goods identified in the cited registration.

We acknowledge that applicant's identification of goods expressly provides that applicant's clothing items will be limited to clothing "depicting the name and image of a famous entertainer."[2] However, the clothing items as set forth in the cited registration are identified broadly and are not limited or restricted in any way. Registrant's goods as identified therefore must be presumed to include any and all types of the identified goods. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). This would include clothing

[2] We note that on its face, applicant's identification of goods does not specifically identify applicant as the "famous entertainer" whose name and image are depicted on the clothing. As identified, the clothing could depict the name and image of any "famous entertainer." We keep this fact in mind for the remainder of this opinion, even in those instances in which we make reference to applicant's arguments and contentions in which applicant states that it is applicant's name and image that are depicted on applicant's goods.

items more specifically identified as "depicting the name and image of a famous entertainer."[3]

In short, because the goods identified in the cited registration encompass the goods identified in applicant's application, the respective goods are legally identical as to shirts, shorts and jackets, and are closely related as to the other clothing items. For these reasons, we find that the second *du Pont* factor (similarity of the goods) weighs in favor of a finding of likelihood of confusion.

The third *du Pont* factor requires us to determine the similarity or dissimilarity of the trade channels in which

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[3] Even if we were to assume, as applicant argues, that registrant's clothing, unlike applicant's clothing, would not be "adorned" with the name and image of a famous entertainer, and that applicant's "adorned" clothing is an inherently and qualitatively different type of clothing than registrant's "unadorned" clothing, such that registrant's "unadorned" clothing does not encompass and thus is not legally identical to applicant's "adorned" clothing, we still would find that applicant's and registrant's goods are similar and related for purposes of the second *du Pont* factor. It is settled that the respective goods need not be identical; they need only be sufficiently related that source confusion is likely to result if the goods were to be marketed under similar marks. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). Additionally, in cases such as this where the applicant's mark is identical to the cited registered mark (see *infra*), there need be only a viable relationship between the respective goods in order to find that a likelihood of confusion exists. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001); and *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983). Such a relationship between the goods exists in this case.

the respective goods are or would be marketed. Neither applicant's identification of goods nor the identification of goods in the cited registration includes any limitations or restrictions as to trade channels. The identified goods therefore must be presumed to be marketed in all normal trade channels for such goods. *In re Elbaum*, *supra*. Because applicant's shirts, shorts and jackets are legally identical to the shirts, shorts and jackets identified in the cited registration (as discussed above), we find that the trade channels for those goods likewise are legally identical. *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). We further find that the other clothing items identified in the application and registration, respectively, are goods which would be marketed in the same or similar trade channels.

As to trade channels, applicant argues that "[a]lthough not specifically limited in Applicant's application, the express limitation of Applicant's proposed RINGO clothing to those items bearing Applicant's famous likeness causes the goods, *de facto*, to travel in different channels of trade. Such goods would only be sold in places where rock music fans congregate and purchase special (not ordinary) clothing." (Applicant's brief at p. 8, footnote 3.) We are not persuaded. Applicant has presented no

evidence to support his mere contention that clothing items "depicting the name and image of a famous entertainer" are or would be sold "only in places where rock music fans congregate." Moreover, even if applicant's goods were deemed to be sold "only in places where rock music fans congregate," the identification of goods in the cited registration contains no trade channel limitations or restrictions, and the registrant's clothing items must be presumed to move in all normal trade channels for such goods. There is no evidence in the record to support a finding that the normal trade channels for such clothing items do not include "places where rock music fans congregate."

For these reasons, we find that the third *du Pont* factor (similarity of trade channels) weighs in favor of a finding of likelihood of confusion.

The fourth *du Pont* factor requires us to consider the conditions under which the identified goods are or would be purchased. We find that the clothing items identified in the application and in the registration are or can be inexpensive goods which are or could be purchased on impulse or without a great deal of care by ordinary consumers. This would include clothing items "depicting

the name and image of a famous entertainer"; there is no evidence in the record to the contrary.

Applicant argues that the purchasers of his goods are dedicated and therefore knowledgeable fans of applicant and his music ("Ringo-philes") who wish to collect or own merchandise (including clothing) "commemorating Applicant, his music career and concert tours." However, we cannot conclude on this record that "Ringo-philes" would be the only purchasers of the goods at issue here, and that the potential purchasers of the goods would not include ordinary consumers.

For these reasons, we find that the fourth *du Pont* factor weighs in favor of a finding of likelihood of confusion.

We turn next to the first *du Pont* factor, which requires us to determine the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imports, Inc., supra*. In this case, the mark applicant seeks to register is RINGO, in standard character form. The cited registered mark also is RINGO, in standard character form.

We find that the marks obviously are identical in terms of appearance and sound. We also find that they are

similar if not identical in terms of connotation and overall commercial impression, because both of the respective RINGO marks, not just applicant's, would be understood to identify and refer to applicant, the famous entertainer Ringo Starr. Applicant has not suggested any other connotation and commercial impression that registrant's RINGO mark would have.

For these reasons, we find that the marks are similar and indeed identical in terms of appearance, sound, connotation and overall commercial impression. The first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Applicant argues that his fame and renown must be taken into account in our likelihood of confusion analysis. He contends that, due to his fame, purchasers will automatically understand, prior to purchasing applicant's goods, that RINGO refers to applicant and that applicant, not registrant, is the source of applicant's goods.

This argument is unavailing. The fifth *du Pont* likelihood of confusion factor requires us to consider evidence of "the fame of the prior mark." In this case, it is registrant, not applicant, that must be deemed to be the owner of the "prior mark" as used on the goods for which applicant seeks to register his mark, i.e., clothing.

Applicant's fame as an entertainer does not entitle him to register RINGO for goods which are the same as or similar to the goods already covered in registrant's prior registration. Applicant's fame therefore is not a factor in our likelihood of confusion analysis in this case.[4]

Considering all of the evidence of record as it pertains to the relevant *du Pont* factors, we conclude that a likelihood of confusion exists in this case. Applicant's mark is identical to the cited registered mark.

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[4] Even if we were to consider applicant's fame in this case, and were to agree with applicant's contention that, due to his fame as an entertainer, purchasers will automatically understand, prior to purchasing applicant's goods, that RINGO refers to applicant and that applicant, not registrant, is the source of applicant's goods, we still would conclude that a likelihood of source confusion exists. That is, even if, due to applicant's fame, purchasers would not mistakenly assume upon encountering applicant's clothing that registrant is the source of applicant's clothing, the converse is not necessarily true. Applicant's fame is likely to lead purchasers to mistakenly assume, upon encountering registrant's clothing bearing the RINGO mark, that applicant is the source of those goods or that registrant's use of the RINGO mark necessarily is pursuant to license or other authorization by applicant. This too is source confusion, which precludes registration of applicant's mark under Section 2(d). *See In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977); *Cf. American Hygienic Laboratories Inc. v. Tiffany & Co.*, 12 USPQ2d 1979 (TTAB 1989).

Also with respect to applicant's fame, applicant, citing *The B.V.D. Licensing Corp. v. Body Action Design Inc.,* 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988), argues that his fame and renown mitigate any likelihood of confusion. However, the Federal Circuit in subsequent cases has expressly limited *B.V.D.* to its facts, and has made it clear that the fame of a mark can never weigh against a finding of likelihood of confusion. *See In re Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); *Kenner Parker Toys Inc. v. Rose Art Industries Inc.,* 963 F.2d 1992, 22 USPQ2d 1453 (Fed. Cir. 2000); *see also Time Warner Entertainment Co. v. Jones,* 65 USPQ2d 1650 (TTAB 2002). We see

Applicant's goods as identified in the application are encompassed by, and thus legally identical to, the goods identified in the cited registration. Applicant's goods must be deemed to move in the same trade channels as those in which registrant's goods move. The goods are inexpensive clothing items which could be purchased by ordinary consumers.

These facts suffice to establish that a likelihood of confusion exists. To the extent that any doubts might exist as to the correctness of our conclusion, we resolve such doubts against applicant. *See In re Shell Oil Co., supra*; *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc., supra.*

Decision: The refusal to register is affirmed.

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no reason not to apply this principle even where it is the later user's mark that allegedly is famous.