

This Opinion is Not a
Precedent of the TTAB

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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 Immobiliare M.V. S.R.L.
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Serial No. 79154979
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for Immobiliare M.V. S.R.L.

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Before Taylor, Adlin and Coggins,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Immobiliare M.V. S.R.L. (“Applicant”) seeks registration on the Principal Register of a mark containing the literal elements “THE ORIGINAL” and “HOOLI” and a dog head design, as shown below,

the original **hooli** 

for, as amended, “[c]lothing, footwear, and headgear, namely, tops, bottoms, jackets, suits, dresses, hats and footwear, except for t-shirts” in International Class 25.¹ The wording “THE ORIGINAL” has been disclaimed at the request of the Examining Attorney. The mark is described in the application as follows: “The trademark consists of the wording ‘HOOLI’ in special characters; laterally in relation to the wording there is a stylized head of a dog; beside the wording are the words ‘THE ORIGINAL’ arranged vertically.” Color is not claimed as a feature of the mark.

The Trademark Examining Attorney has refused registration of Applicant’s mark on the ground that it so resembles the mark in Registration No. 5045838, HOOLI (in standard characters), for “[c]lothing, namely, t-shirts,”² as to create a likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm.

I. Applicable Law

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C.

¹ Application Serial No. 79154979 was transmitted to the USPTO on June 27, 2014, pursuant to Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), based on International Registration No. 1222926, registered June 27, 2014, and claiming priority as of April 16, 2014. This application is parent to application Serial No. 79975454 for goods in International Classes 3 and 18 that are not subject to refusal.

² Issued September 20, 2016.


§ 1052(d). Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). We discuss below these and other relevant factors. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (even within *du Pont* list, only factors that are “relevant and of record” need be considered).

II. Similarity/Dissimilarity of the Marks

We first consider the *DuPont* likelihood of confusion factor of the similarity or dissimilarity of the marks in their entireties in terms of sound, appearance, meaning and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). In comparing the marks, we are mindful that “[t]he proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted); *see also San Fernando Electric Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*,

23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd mem.*, 972 F.2d 1353 (Fed. Cir. 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). In this case the average consumer is seeking clothing items.

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."). On the other hand, different features may be analyzed to determine whether the marks are similar. *Price Candy Co. v. Gold Medal Candy Corp.*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955). In fact, 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 Nat'l Data Corp.*, 224 USPQ at 751.

Applicant's mark is THE ORIGINAL HOOLI and design, , and the cited mark is HOOLI. Applicant argues that its mark is distinguishable from the

cited mark primarily due to the distinctive and allegedly dominant design feature of a dog head in its mark. We disagree and find the marks similar in appearance, sound and connotation in that they both include as the only or dominant element the word HOOLI. While we do not disregard the additional wording “The Original” in Applicant’s mark, not only does it appear in a very small font, it is laudatorily descriptive of the identified goods and has been disclaimed. The wording thus has little, if any, source-indicating significance. *See, e.g., In re Dixie Rests.*, 105 F.3d 1405, 41 USPQ2d 1531, 533-34 (Fed. Cir. 1997) (“DELTA,” not the disclaimed generic term “CAFE,” found the dominant portion of the mark THE DELTA CAFE). The font and style of the literal elements of Applicant’s mark are not sufficient to create a unique commercial impression apart from the words themselves, and thus, the stylization does not obviate the similarities between the marks. Furthermore, because the cited mark is a standard character mark, its display is not limited to any particular font, style, size, or color, and we therefore must consider that it might be used in any stylized display, including the same or similar bold, lowercase font of the lettering used by Applicant in the HOOLI portion of its mark. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909-10 (Fed. Cir. 2012); *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011).

Contrary to Applicant’s contention, the design element of Applicant’s composite mark, which is described in the application as “a stylized head of a dog,” also fails to distinguish Applicant’s mark from the cited mark.³ Where both words and a design

³ Applicant’s reliance on *In re Electrolyte Labs., Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) for its contention that visual impression is more important than auditory

comprise a mark, the words are normally accorded greater weight because they are more likely to make an impression upon purchasers, would be remembered by them, and would be used by them to call for the goods. *Viterra*, 101 USPQ2d at 1908, citing *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) (“in a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed”). Here, although the dog head design is clearly visible, it appears at the end of the mark. Further, while the design is of a similar height as the letter I in the HOOLI component, it is only slightly wider in breadth as that single letter. By contrast, the term HOOLI comprises the majority of Applicant’s mark and appears in a heavily bolded font. Given the relative size and bold lettering, the term HOOLI is the most visibly prominent component of Applicant’s mark, as well as the most distinctive element in terms of commercial impression, and is the part of the mark most likely to be used by purchasers to call for the goods, given the penchant of consumers to shorten marks. *See In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1188 (TTAB

impression is misplaced. Unlike in that case where the Court found that the respective “letter” marks, i.e., K+ and K+EFF, fall in a “gray region between pure design marks which cannot be vocalized and word marks which are clearly intended to be,” there is no such ambiguity in this case. In this case, Applicant’s composite mark is comprised of a distinct dog head design element coupled with distinct word elements one of which is identical to the cited mark. We find no reason on this record to deviate from the principle noted above that words are normally accorded greater weight than designs in a composite mark. *See Viterra*, 101 USPQ2d at 1908.

Moreover, it has been noted many times that each case must be decided on its own facts. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“Even if some prior registrations had some characteristics similar to [applicant’s] application, the PTO’s allowance of such prior registrations does not bind the Board or this court.”); and *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987)

2018) (“consumers often have a propensity to shorten marks” when ordering goods orally).

In addition, the record reflects the arbitrary nature of the term HOOLI⁴ and, given the related and complementary nature of the respective goods as discussed below, the term is likely to impart the same arbitrary connotation in each mark.

We recognize that in comparing the marks, we must consider Applicant’s and Registrant’s marks in their entirety, not merely the dominant portions. Thus, we have taken into account all of the differences in appearance, sound, and connotation between them. We nonetheless find that despite these differences, given the similarities between the marks in sound, appearance and meaning due to the shared term HOOLI, the marks engender very similar commercial impressions.

Accordingly, the similarity between the marks is a factor that weighs in favor of a finding of likelihood of confusion.

III. The Goods/Trade Channels/Classes of Purchasers

We next consider the similarity or dissimilarity of the goods as identified in the application and the cited registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-62 (Fed. Cir. 2014); *Octocom Sys. Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). It is well settled that the goods of Registrant and Applicant need not be identical or competitive, or even be offered through the same channels of trade, to support a

⁴ June 1, 2015 Office Action; TSDR 5. Citations to the examination record refer to the Trademark Status and Document Retrieval system (TSDR) in the downloadable .pdf format.

holding of likelihood of confusion. It is sufficient that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Coach Servs.*, 101 USPQ2d at 1723; *Hilson Research, Inc. v. Soc’y for Human Resource Mgmt.*, 27 USPQ2d 1423 (TTAB 1993). The issue here, of course, is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of these goods. *L’Oreal v. Marcon*, 102 USPQ2d at 1439; *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

In making our determination regarding the relatedness of the goods, we must look to the goods as identified in the application and the cited registration. *See Stone Lion v. Lion Capital* 110 USPQ2d at 1162 (quoting *Octocom v. Houston Comput.* 16 USPQ2d at 1787; *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011)). We need not find similarity as to each and every item listed in Applicant’s description of goods. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any item encompassed by the identification of goods in a particular class in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014).

Applicant’s goods are identified as “[c]lothing, footwear, and headgear, namely, tops, bottoms, jackets, suits, dresses, hats and footwear, except for t-shirts” and Registrant’s goods are identified as “[c]lothing, namely, t-shirts.” To establish the relatedness of the goods, the Examining Attorney made of record printouts of 23 use-based, third-party registrations for marks covering one or more of the clothing items identified in Applicant’s application, e.g., bottoms, jackets, footwear and hats, and “t-shirts,” the only goods identified in the cited registration.⁵ Third-party registrations that individually cover different goods and that are based on use in commerce serve to suggest that the listed goods are of a type that may emanate from a single source. *See Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations are “not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may nonetheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source”). *See also In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993). A sampling of the registrations, as excerpted below, follow:

Registration No.	Mark	Pertinent Goods ⁶
5258803	BMU BLACK MEN UNITED and design	T-shirts and tank tops, jackets, hats, shoes
5137559	BEARDED BROTHERS	T-shirts and hats and shirts
5304878	SPEEDQB	T-shirts and hats, jackets, pants and tops

⁵ October 24, 2017 Office Action; TSDR 5-39 and May 17, 2018 Office Action; TSDR 5-27.

⁶ The registrations may include additional goods and/or services.

Registration No.	Mark	Pertinent Goods
5241454	FREE AND LIBERATED STATE	T-shirts and footwear
5313553	SHIMUKO	T-shirts and shirts, jackets, and headwear
5309568	HEADFREAKS and design	t-shirts and tops, hats, jackets, headwear and bottoms
5309569	TOMILEE	T-shirts and dresses, jackets shirts and shoes
5309580	KIKI LARUE	Short-sleeved, long-sleeved, and graphic t-shirts and dresses, jackets and pants
5469193	RESPECT THE CORNERS	T-shirts and hats and jackets

We find this evidence sufficient to show that, at a minimum, Applicant's identified "hats, jackets and pants" are commercially related to Registrant's "t-shirts," such goods all being clothing items that may emanate from the same source under the same mark. We further find Applicant's identified pants, jackets and footwear complementary to Registrant's t-shirts in that all of these pieces of clothing can be worn together in a single outfit. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *Gen. Mills, Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1597-98 (TTAB 2011), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272 (TTAB 2009).

Further, because there are no limitations as to channels of trade or classes of purchasers in Applicant's or Registrant's identifications of goods, we must presume that Applicant's and Registrant's goods move in all channels of trade usual for these types of clothing. *See In re Detroit Athletic*, 128 USPQ2d 1047, 1052 (TTAB 2018)

(citing *i.am.symbolic*, 866 F.3d at 1327 (“In the absence of meaningful limitations in either the application or the cited registrations, the Board properly presumed that the goods travel through all usual channels of trade and are offered to all normal potential purchasers.”)). Normal channels of trade for both Applicant’s and Registrant’s goods include online and brick and mortar clothing stores, where they are purchased by the usual classes of purchasers, which include ordinary consumers. We accordingly find the channels of trade and the classes of consumers of Applicant’s and Registrant’s goods to overlap.

These *DuPont* factors thus favor a finding of likelihood of confusion.

IV. Consumer Sophistication

Applicant argues that its goods are of a nature and quality that would be purchased with care by discriminating purchasers. However, Applicant’s identification contains no such limitations. We must make our determination based on the degree of care that would be exercised by the least sophisticated consumer, and assume that Applicant’s clothing items are offered at varying qualities and prices. *See Stone Lion v. Lion Capital* 110 USPQ2d at 1163 (affirming that the Board properly considered all potential purchasers for the recited services, including both sophisticated and unsophisticated investors, but that precedent requires consumer care for likelihood-of-confusion decision to be based “on the least sophisticated potential purchasers”). We thus find this *DuPont* factor neutral in our likelihood of confusion analysis.

V. Conclusion

We have carefully considered all of the arguments and evidence pertaining to the relevant *DuPont* factors. In view of the similarity of the marks, the related and complementary nature of the goods and the overlapping trade channels and classes of consumers, we conclude that confusion is likely between Applicant's mark THE ORIGINAL HOOLI and design for tops, bottoms, jackets, suits, dresses, hats and footwear, except for t-shirts, and Registrant's mark HOOLI for t-shirts.

Decision: The refusal to register Applicant's mark  is affirmed.