

This Opinion is Not a  
Precedent of the TTAB

Mailed: September 18, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Mystic B.V.*

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Serial No. 79195133

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Michele S. Katz of Advitam IP LLC  
for Mystic B.V.

Edward Fennessy, Trademark Examining Attorney, Law Office 114,  
Laurie Kaufman, Acting Managing Attorney.

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Before Mermelstein, Wellington, and Lynch,  
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Mystic B.V. (“Applicant”) seeks registration on the Principal Register of the mark:



for “clothing for watersports namely swimsuits, rash guards, long johns; sporting shoes for watersports, rains shoes, neoprene boots, neoprene shoes, watersport

helmets; rain coats, thermal underwear, windsurf jackets, kite pants, spray tops clothing and wetsuits” in International Class 25.<sup>1</sup>

The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the registered mark MYSTIC in standard characters for “clothing, namely, shirts” in International Class 25.<sup>2</sup>

After the Examining Attorney made the refusal final, Applicant filed a request for reconsideration and appealed. The Examining Attorney denied the reconsideration request, and the appeal proceeded. The appeal has been briefed.

For the reasons set forth below, we affirm the refusal to register.

#### I. Evidentiary Objection

Applicant submitted, as exhibits to its appeal brief, an internet printout and copies of third-party registrations. In his brief, the Examining Attorney objects to these exhibits because they were not submitted during prosecution of the involved application. Applicant filed a reply brief, but did not address this objection.

The evidentiary record in an application should be complete prior to the filing of an appeal. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); Trademark Trial and Appeal Board Manual of Procedure (TBMP) §§ 1203.02(e), 1207.01 (June 2018); Trademark Manual of Examining Procedure (TMEP) § 710.01(c) (Oct. 2017). The

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<sup>1</sup> Application Serial No. 79195133 was filed under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), based on a request for extension of protection of International Registration No. 1316704.

<sup>2</sup> Registration No. 2658677 issued December 10, 2002; renewed.

proper procedure for an applicant or examining attorney to introduce evidence after an appeal has been filed is to submit a written request with the Board to suspend the appeal and remand the application for further examination. *See* Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). *See also* TBMP § 1207.02 and authorities cited therein.


As a result, the Examining Attorney's evidentiary objection is sustained, and the evidence Applicant submitted for the first time with its appeal brief is untimely and will not be considered.

We turn now to the merits of this appeal.

## II. Likelihood of Confusion

The determination under Section 2(d) involves 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) (setting forth factors to be considered, hereinafter referred to as “*du Pont* factors”); *see also In re Majestic Distilling Co.*, 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 relatedness of the goods. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *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.”).

A. Similarity of the Marks

We compare the marks  and MYSTIC “in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). The test assesses not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods and services offered under the respective marks is likely to result. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *see also Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012).

Applicant’s mark comprises a design element and the word MYSTIC. Although there is no *per se* rule, it is often the case that the word portion of a word-and-design mark is dominant because consumers will use the word, rather than the design, to refer to and call for the goods. *See In re Viterra*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987) (if a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services). *See also 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 position of the mark is the one most likely to indicate the origin of the goods to which it is affixed.”). We find that to be the case here. Although it appears first in Applicant’s mark, the

design element is physically smaller than the word MYSTIC, and cannot be vocalized or easily described. There is no argument or evidence that the design portion of Applicant's mark would have any significance to consumers; thus, this design will likely be viewed as a fanciful image preceding MYSTIC. Applicant asserts that its mark should not be dissected; we agree that we must consider the marks in their entirety, but as it has been frequently noted, "in 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 entirety." *In re Detroit Athletic Co.*, --- F.3d ---, 2018 WL 4288981 \*4 (Fed. Cir. Sept. 10, 2018) (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)); see also *Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014).

Applicant's mark is similar in appearance to the mark in the cited registration. Because the cited mark is registered in standard characters, it is not limited "to any particular font style, size, or color." Trademark Rule 2.52(a). As such, we must consider it to cover the Registrant's use of MYSTIC in any stylization, including stylization identical to that in Applicant's drawing. See *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1258–59 (Fed. Cir. 2011). Applicant's mark includes a design element absent from the cited mark. But as noted, MYSTIC is the dominant element of Applicant's mark. Considering Applicant's mark

in its entirety, we find it similar in appearance to Registrant's mark, notwithstanding the presence of a design element.

As to the meaning or connotation of the marks, the term MYSTIC is arbitrary with respect to goods identified in the involved application and cited registration.<sup>3</sup> Thus, any meaning or connotation that consumers may attribute to the term would likely be the same in either mark.

Accordingly, we find the involved marks are very similar in appearance, identical in sound and would likely be understood in the same manner. This *du Pont* factor weighs in favor of likely confusion.

#### B. Alleged Weakness of the Term Mystic

Applicant argues that its mark is “distinguishable from the cited mark due in part to the common use of MYSTIC in third party marks.”<sup>4</sup> However, there is no evidence of record to support the contention that Registrant's mark is commercially weak. Therefore, the factor involving any weakness of the cited mark, or a common element of the marks, based on the number and nature of similar marks in use on similar goods (the sixth *du Pont* factor) is neutral. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1845 (“the obligation to consider a factor does not arise in a vacuum and only arises if there is evidence of record relating to that factor”).

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<sup>3</sup> The term “mystic” is defined as either “a person who practices or believes in religious mysticism” or, as an adjective, “of mysteries, or esoteric rites or doctrines.” *Webster's New World College Dictionary* (4th ed. 2010). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

<sup>4</sup> 11 TTABVUE 13.

Further, as noted, the word MYSTIC has no apparent meaning relevant to the goods at issue. We therefore consider the Registrant's mark inherently strong as a source indicator. *See In re FCA US LLC*, 126 USPQ2d 1214, 1224 (TTAB 2018).

### C. The Goods

Applicant's and Registrant's goods need not be "competitive or intrinsically related" to find a likelihood of confusion. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1737 (Fed. Cir. 2017). "Instead, likelihood of confusion can be found 'if the respective products are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.'" *Coach Servs.*, 101 USPQ2d at 1722 (internal citations omitted). In analyzing the second *du Pont* factor, we look to the identifications in the application and cited registration. *See Stone Lion Capital Partners*, 110 USPQ2d at 1162; *Octocom Sys., Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The Examining Attorney notes that Registrant's goods are shirts and then goes on to argue that:<sup>5</sup>

Applicant's goods are thus similar in nature to the registrant's goods in that they consist of clothing and, in particular, "tops," both of which broadly encompass the registrant's goods, namely, shirts.

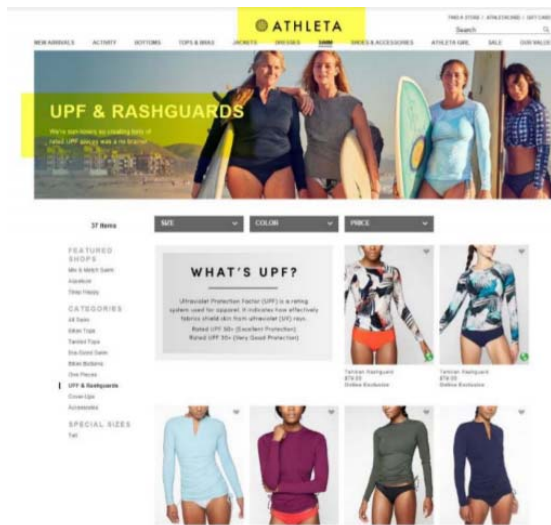
We find the record somewhat unclear as to the above reasoning because Applicant's goods are not described simply as "clothing" or "tops." Rather, the application's identification of goods includes, in pertinent part, "clothing for

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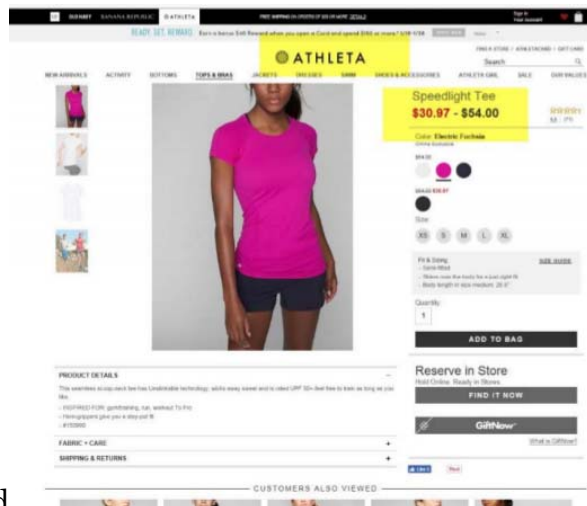
<sup>5</sup> 13 TTABVUE 9.

watersports namely ...” “spray tops.” It cannot be said that, on their face, Applicant’s goods explicitly encompass Registrant’s goods, or vice-versa. The Examining Attorney has not pointed to evidence showing that a “spray top” necessarily is a shirt, as opposed to, for example, a jacket. Thus, the record does not support a finding that “shirts” include (or are encompassed by) “clothing for watersports” or “spray tops.”

The Examining Attorney, however, submitted evidence showing the relatedness of Registrant’s shirts and Applicant’s watersport-related clothing.<sup>6</sup> Specifically, the Examining Attorney attached printouts from third-party websites showing use of six different marks (Athleta, Body Glove, Lululemon, Ripcurl, Ron Jon, and Roxy) on or in connection with both shirts and watersport apparel, such as swimwear, wetsuits, rash guards, etc. For example, the following are some excerpts from the submitted printouts:



7 and



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<sup>6</sup> 5-9 TTABVUE (attached to Office Action denying request for consideration issued on February 21, 2018).

<sup>7</sup> 7 TTABVUE 9.

<sup>8</sup> Id. at 12.





9 and 10

This third-party use evidence is probative because it shows that consumers are accustomed to encountering goods such as Applicant’s watersport-related goods and Registrant’s shirts being sold under the same marks.

The also record includes numerous (over one hundred) use-based third-party registrations that include both Applicant’s watersport-related goods, e.g., swimsuits, wetsuits, and sun-protective clothing, as well as Registrant’s shirts.<sup>11</sup> These third-party registrations, based on use in commerce suggest that the listed goods may emanate from the same source. *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993);

<sup>9</sup> 9 TTABVUE 6.

<sup>10</sup> *Id.* at 4.

<sup>11</sup> 5-7 TTABVUE. Several of the registrations are less probative of the relatedness of the goods because their identifications are extensive and cover other unrelated goods; nevertheless, the sheer number of registrations, including many that have shorter identifications that include Applicant’s and Registrant’s goods, is impressive and persuasive.

*In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd*, 864 F.2d 149 (Fed. Cir. 1988) (mem.).

The established relatedness of the involved goods weighs in favor of finding a likelihood of confusion.

#### D. Trade Channels and Classes of Consumers

Turning to the trade channels and consumers, the relatedness evidence discussed above also demonstrates that the involved goods are featured together on the same websites, and would be encountered by the same consumers. For example, the same consumer seeking to buy an Athleta-brand women's rash guard shirt may also purchase an Athleta-brand tee shirt for women on the same website. Applicant's arguments that its goods and Registrant's goods are, in fact, offered in different and particular marketplaces, even if supported by evidence, is misplaced because, as our primary reviewing court has pointed out:

[t]he authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

*Octocom Syst.*, 16 USPQ2d at 1787; *see also Detroit Athletic Co.*, at \*6("[t]he relevant inquiry in an ex parte proceeding focuses on the goods and services *described in the application and registration*, and *not* on real-world conditions") (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325 (Fed. Cir. 2017)).

Applicant's contentions that its goods are "specialty items that are going to be sold in specialty stores"<sup>12</sup> and that Registrant's shirts are sold "in around the casinos of Mystic Lake, Minnesota" are trade channel limitations that are not reflected in either the application or the cited registration. Without such trade channel restrictions, we must presume the goods will be offered in all normal trade channels for such goods, such as websites that feature watersport apparel and tee shirts. *See i.am.symbolic*, 123 USPQ2d at 1750 ("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.").

Accordingly, the *du Pont* factors involving the channels of trade through which the goods may be found and the classes of customers weigh in favor of finding a likelihood of confusion.

### III. Conclusion

We find confusion is likely in light of our findings that Applicant's and Registrant's marks are overall very similar and will be used on related goods that travel in the same channels of trade to the same classes of customers.

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

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<sup>12</sup> 11 TTABVUE 12.