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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sam Farha, Inc.

Serial No. 85061371

Gordon G. Waggett of Gordon G Waggett PC for Sam Farha, Inc.

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Before Cataldo, Lykos, and Gorowitz, Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Sam Farha, Inc. (applicant) seeks registration on the Principal Register for



the mark **CHIPS HAPPEN** for “shirts” in International Class 25.¹ The application includes the following description of the mark: “The mark consists of a round-faced caricature depicting the poker face of world famous poker player Ihsan Sam Farha,

¹ Serial No. 85061371, filed June 14, 2010, pursuant to Section 1(a) of the Trademark Act. Color was not claimed as a feature of the mark.

including his trademarked use of an unlit cigarette dangling from his mouth, with the literal component, ‘CHIPS HAPPEN’ appearing proximate thereto in block lettering employing shadowing.” Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark so resembles the registered mark CHIP HAPPENS in standard character format for “short sleeve and long sleeve t-shirts, sweatshirts, and hats” in International Class 25² that, as used in connection with applicant's identified goods, it is likely to cause confusion or mistake or to deceive. The examining attorney issued a final refusal of registration, which applicant has appealed.

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).

We start our analysis with the second *du Pont* factor, the nature and similarity or dissimilarity of the involved goods. Applicant’s goods are “shirts,” and registrant’s goods include “short sleeve and long sleeve t-shirts, and sweatshirts.”

² Reg. No. 3170224, issued on the Supplemental Register on July 5, 2006, § 8 accepted.

Since “short sleeve and long sleeve t-shirts” are encompassed by “shirts,” these goods are legally identical. There were no arguments submitted to the contrary.³

The absence of any restrictions of the goods in either the application or the cited registration also governs our analysis of the third and fourth *du Pont* factors, the channels of trade in which the goods travel and the class of customer to whom the goods are sold.

Applicant argues that the channels of trade are different because “[r]egistrant currently markets numerous clothing products for motorcycle enthusiasts online via a link from its webpage, buffalohip.com through a link to a joint effort with hotleathers.com” (Appeal Brief, pages 20-21) and [a]pplicant markets its CHIPS HAPPEN merchandise from The Sam Farha website ...to those persons following the poker playing of Sam Farha and visiting his website (Appeal Brief, 22). However, the identifications of goods in the cited registration and the application do not include restrictions of either the channels of trade or the classes of purchasers.

“It is well established that absent restrictions in the application and registration, [identical or related] goods and services are presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 101 USPQ2d at 1908. Thus, since neither the identification of goods in the application

³ Neither the applicant nor the examining attorney addressed the presence of “hats” in the identification of goods in the cited registration. This is appropriate since likelihood of confusion must be found as to the entire class if there is likely to be confusion with respect to any item in the identification of goods for that class. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). Moreover, registrant’s sweatshirts and hats are clothing items closely related to shirts.

nor the identification of goods in the cited registration is restricted and the goods as identified are legally identical, in part, the goods are presumed to travel in the same trade channels and to be purchased by the same purchasers.⁴

Next, we turn to the first *du Pont* factor, the similarity of the marks. In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In evaluating the similarities between marks, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *In re Cynosure, Inc.*, 90 USPQ2d 1644, 1645 (TTAB 2009), citing *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Applicant's mark consists of a primitive design of a face with something stick-like protruding out of its mouth, and the term "CHIPS HAPPEN" thereunder. Applicant claims that the design element constitutes a "recognizable caricature of Sam Farha, a world famous poker player" (Appeal Brief, pages 5-6); that the mark is associated with Sam Farha (Appeal Brief, page 9); that the design connotes poker

⁴ In her appeal brief, the examining attorney addressed and dismissed the issue of the sophistication of the customers. The goods as identified in the application and the cited registration are "shirts." We determine whether the goods are sold to sophisticated customers on the basis of the goods as identified in the application and cited registration. "Shirts" are common clothing items that are sold to all classes of classes of customers. As such, the examining attorney correctly dismissed this issue.

chips (Appeal Brief, page 8) and that said design is the dominant feature of the mark.⁵ There is no evidence supporting any of these assertions.

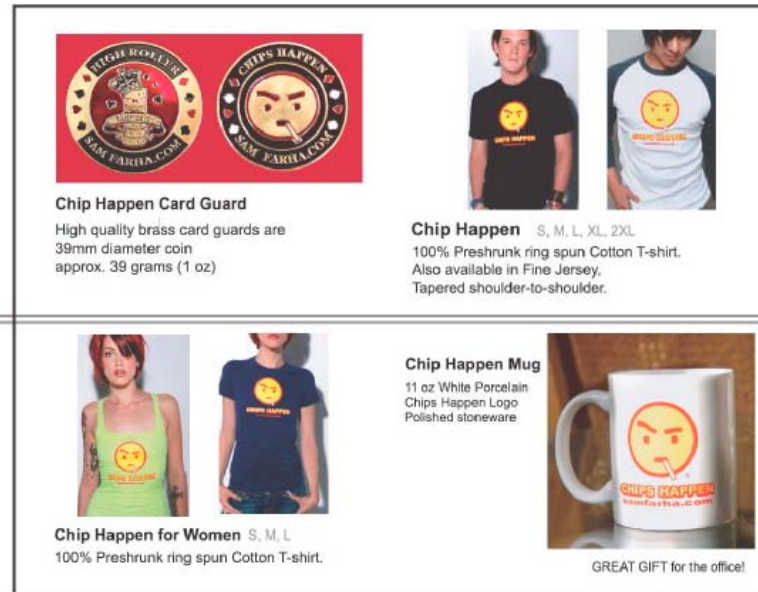
Neither is there any evidence that the “stick-like” matter protruding from the mouth of the “caricature” is an unlit cigarette (Appeal Brief, page 5) nor that the “caricature has been widely used and promoted for over 5 years by applicant in connection with Sam Farha” (Appeal Brief, page 7). Applicant’s description of the design element in its mark as “a round-faced caricature depicting the poker face of world famous poker player Ihsan Sam Farha, including his trademarked use of an unlit cigarette dangling from his mouth,” is not binding upon our determination of likelihood of confusion since “[a] mark’s meaning is based on the impression actually created by the mark in the minds of consumers, not on the impression that the applicant states the mark is intended to convey.” TMEP § 808.02.

Moreover, while applicant has submitted approximately 200 pages of documents for the purpose of establishing the notoriety of Mr. Farha,⁶ there is no evidence establishing the notoriety of the mark nor is there evidence that the design portion is the dominant element in the mark. To the contrary, the evidence offered to show use of the mark is the specimen submitted with the application, which is

⁵ Applicant asserted the dominance of the design portion throughout its Brief. The first assertion was on page 3.

⁶ Mr. Farha’s notoriety is not at issue in the case. The evidence is not probative of either the use or notoriety of the mark and thus is irrelevant to this appeal. *Cf. In re Franklin County Historical Society*, 104 USPQ2d 1085, 1093 (TTAB 2012) (“Generally, marks with different commercial impressions do not share goodwill.”).

identified as a hang tag.⁷ The bottom half of the specimen consists of the following photographs with product descriptions thereunder:



The mark used in connection with each photographed item is “CHIP HAPPEN.” This use of the literal portion of the mark, albeit with the word “Chips” in singular form (Chip), supports the examining attorney’s assertion that words dominate over designs.⁸

“In the case of a composite mark containing both words and a design, the verbal portion of the mark is the one

⁷ The specimen is a single page with several images thereon. Photographs of what is assumed to be the front and back of the hang tag are at the top of the page. The mark CHIPS HAPPEN & design is depicted on what is believed to be to be the front of the hangtag. To the left thereof is an advertisement for a “Sam Farha Professional Poker Set” and washing instructions. We assume this information appears on the back of the hangtag. Two additional copies of the specimen were attached to the response dated March 30, 2011 at pages 22 and 30.

⁸ The only other evidence reflecting the offer for sale of applicant’s shirts is on page 73 of applicant’s March 30, 2011 response to the first Office action. The exhibit includes photographs of two t-shirts and one jacket, which are identified as: “Chips Happen,” “Raisy Daisy Track Jacket” and “Unpredictable.”

most likely to indicate the origin of the goods to which it is affixed.”

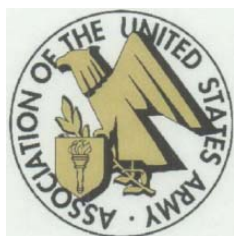
In re Viterra Inc., 671 F.3d 1358, 101 USPQ2d 1905 (Fed. Cir. 2012) *citing* *CBS Inc. v. Morrow*, 708 F.2d. 1579, 128 USPQ 198 (Fed. Cir. 1983) (internal quotations omitted).⁹

In this case, applicant’s own use of CHIP HAPPEN, not only establishes that the literal portion of its mark CHIPS HAPPEN dominates, but also the likelihood that CHIPS HAPPEN will be confused with the mark in the cited registration, CHIP HAPPENS.

The general impression of the dominant literal portion of applicant’s mark and the mark in the cited registration is the same since the marks are virtually identical in both appearance and sound.

Applicant argues that the connotations of the marks are different and that this factor necessitates a finding that the marks are not confusingly similar.

⁹ See also: *In re Association of the United States Army*, 85 USPQ2d 1264 (TTAB 2007), (holding the mark



confusingly similar to the marks  and ).

Applicant bases its argument on extrinsic evidence from the file history of the cited registration¹⁰ and from its own webpages.

Since none of these perceived differences are reflected in the identification of goods in either the application or the cited registration, the evidence is accorded no weight in our decision. In short, even assuming *arguendo* that the term “CHIP” or “CHIPS” may possess different connotations in different contexts, there is nothing in the record to support a finding that, as applied to the goods identified in the involved application and cited registration, the term “CHIP(S)” will have a different connotation in applicant’s mark from that of registrant’s mark.

It is well settled that the question of likelihood of confusion must be determined based on an analysis of the goods recited in applicant's application vis-à-vis the goods identified in the cited registration. *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1646 (TTAB 2008); *In re Shell Oil Co.*, 992 F.2d 1204 (Fed. Cir. 1993); and *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992). Since the goods in both the application and the cited

¹⁰ Applicant refers to an argument submitted by registrant (owner of the cited registration), in the application registrant filed to obtain its registration, to overcome a refusal based on ornamentation, wherein registrant argued that its mark is associated with the “Legendary Buffalo Chip Campground.” This argument was not accepted by the examining attorney. Nor does a prior, contrary statement of opinion, made on a legal issue in an unrelated proceeding, effect any sort of estoppel, and is only considered to the extent it may be “illuminative of the shade and tone in the total picture confronting the decision maker.” *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978).

Applicant further argues that the word “CHIP,” in the cited registration refers to “buffalo chips,” which are buffalo feces.

Neither the mark as depicted in the registration nor the goods in the registration reflect any association with the “Legendary Buffalo Chip Campground,” nor is there any evidence that the consuming public would perceive the mark as referring to “buffalo chips.”

registration are legally identical and there is no restriction of the goods in either, there is no evidence that consumers would perceive the marks as having different connotations. Accordingly, we find the applicant's mark to be confusingly similar to the mark in the cited registration.

We turn now to the seventh and eighth *du Pont* factors, which are “the nature and extent of actual confusion” and “the length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” Applicant states there has been an absence of confusion “throughout over five years of use in commerce.” Appeal Brief, page 23. This statement implies that there is no likelihood of confusion because the parties have been peacefully coexisting, which is contrary to applicant's prior assertion that the mark in the cited registration has been abandoned.¹¹ Appeal Brief, page 21. The case of *In re Big Pig Inc.*, 81 USPQ2d 1436, 1439-1440 (TTAB 2006) provides guidance on this issue:

“Insofar as the absence of actual confusion is concerned, there is nothing in the record regarding the extent of use of either applicant's or registrant's marks. Thus, we are unable to determine if there has been any meaningful opportunity for confusion to occur in the marketplace. In any event, the test is likelihood of confusion, not actual confusion, and, as often stated, it is unnecessary to show actual confusion in establishing likelihood of confusion.”

See also Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990). The facts here are the same as those in the *In re Big Pig* case. There is no evidence in the record regarding the extent of use of either

¹¹ Applicant acknowledges that “such argument more properly belongs in a cancellation proceeding. Appeal Brief, page 21. Applicant is correct. This argument does not influence our analysis in this proceeding.

applicant's or registrant's marks and we are not able to determine if there has been any opportunity for confusion to occur in the marketplace. It is unnecessary to show actual confusion to establish likelihood of confusion, and these *du Pont* factors are neutral in our analysis.

Applicant also points out, presumably under the thirteenth factor of the *du Pont* case - any other established fact probative of the effect of use - the PTO's allowance of Reg. No. 3949745 for the mark BUFFALO CHIPS for t-shirts over Reg.



No. 3346565 for the mark _____, also for t-shirts.

It asserts that the co-existence of these two marks on the register proves that there is no confusion between its mark and the mark in the cited registration. This assertion is not correct. "[I]t has long been held that while the PTO is encouraged to achieve a uniform standard for assessing registrability of marks, the Board and the Federal Circuit "must assess each mark on the record of public perception submitted with the application." *In re Nett Designs Inc.*, 57 USPQ2d 1564 (Fed. Cir. 2001). Thus, whatever the reasons that were relied on by the examining attorney who approved registration of the mark BUFFALO CHIPS, over the prior



registration for _____, they are not relevant to our decision. We must reach our decision in this case based on the record before us.

Having considered all of the evidence and the arguments on the relevant *du Pont* factors, we find that applicant's mark is likely to cause confusion with the cited registration.

Decision: The refusal to register is affirmed.