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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Orange 21 North America Inc.

Serial No. 85281102

Kit M. Stetina of Stetina Brunda Garred & Brucker for Orange 21 North America Inc.

Jennifer D. Richardson, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Cataldo, Ritchie and Wolfson, Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Orange 21 North America Inc. (“applicant”) seeks registration on the Principal Register of the mark DIRK (in standard characters) for “sunglasses,” in International Class 9.¹

The Trademark Examining Attorney has refused registration of applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), having determined that registration would lead to a likelihood of confusion in view of

¹ Application Serial No. 85281102 was filed on March 30, 2011, based on applicant’s assertion of a bona fide intent to use the mark in commerce.

Registration No. 3302722 for the mark DIRK BIKKEMBERGS (in standard character format) for, *inter alia*, “spectacles” in International Class 9.²

After the examining attorney made the refusal final, applicant appealed to this Board. We affirm the refusal to register.

Evidentiary Issue

Before proceeding to the merits of the refusal, we address an evidentiary matter. Applicant submitted printouts from Internet searches for the terms “Dirk” and “Bikkembergs” as attachments to its brief. The examining attorney has objected to admission of this evidence as untimely. We agree. The record in an application should be complete prior to the filing of the Notice of Appeal, and this tribunal ordinarily will not consider evidence filed thereafter. Trademark Rule 2.142 (d). Accordingly, the additional evidence submitted with applicant’s brief has not been considered.

Applicant further referred in its brief to three registrations of “DIRK-derivative” marks purporting to show the weakness of the cited registration. The reference to these three prior marks, while it has not been disregarded, carries little weight because information regarding the registrations, such as the goods or services involved and whether they are currently valid, has not been provided. The Board does not take judicial notice of registrations that reside in the USPTO. *In re Jonathan Drew, Inc. d/b/a Drew Estate*, 97 USPQ2d 1640, 1646 n.11 (TTAB 2011). Also in its brief, applicant commented on the contents of registrant’s website,

² Registered Oct. 02, 2007 on the basis of a request for extension of protection, under Trademark Act § 66(a), of International Registration No. 0845256, registered January 6, 2006.

www.bikkembergs.com, purportedly to show that registrant uses BIKKEMBERGS alone to refer to its goods. However, applicant did not timely introduce into the record screenshots or printed copies of pages from registrant's website. We do not take judicial notice of the contents of websites and do not independently access websites that have merely been referred to in a brief or otherwise. Accordingly, we have considered applicant's statement merely as unsupported argumentation.

Applicable Law

Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. See *In re E.I. du Pont de Nemours & 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 and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); see also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

A. Comparison of the Goods; Trade Channels and Purchasers

We first examine the relatedness of the goods, basing our evaluation on the goods as they are identified in the registration and application. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed.

Cir. 1990). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). It is settled that it is not necessary that the respective goods be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. *See In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). The goods need only be sufficiently related that consumers would be likely to assume, upon encountering the goods under similar marks, that the goods originate from, are sponsored or authorized by, or are otherwise connected to the same source. *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).

The goods identified in applicant's application for the mark DIRK are "sunglasses." The goods identified in the registration are "spectacles." To show that the goods are related, the examining attorney submitted a dictionary definition of "spectacles," copies of third-party registrations for marks covering both "sunglasses" and "spectacles," and copies of web pages from the Internet showing companies advertising both sunglasses and eyeglasses under the same mark.

The dictionary evidence shows that the terms "spectacles" and "eyeglasses" are synonyms, and that "sunglasses" refers to both spectacles and eyeglasses that have been tinted. The online dictionary, www.macmillandictionary.com, gives as the "American English" definition for the term "spectacles" the single word "eyeglasses."³ This same resource defines "eyeglasses" as the "American formal" of "glasses," which are further defined as "an object that you wear in front of your eyes

³ Attached to the Final Office action dated December 7, 2011.

to help you see better.”⁴ Hence, “eyeglasses” and “spectacles” are synonyms. As for “sunglasses,” they are defined as “glasses with dark lenses that you wear to protect your eyes when the sun is bright.”⁵ Hence, “sunglasses” are spectacles or eyeglasses that have been tinted. Based on the plain dictionary definitions of the terms themselves, it is clear that sunglasses are related to, and indeed, to some extent overlap with, spectacles in that both may be offered as prescription eyewear.

Applicant argues that spectacles and sunglasses are not directly competing products: “Spectacles are commonly used for corrective vision,” and “may be sold in an eye doctor’s office,” whereas “sunglasses are used primarily to protect a wearer’s eyes from the sun” and “are commonly sold at sporting goods stores.”⁶ However, applicant did not submit evidence to support its rather narrow interpretation of the trade channels in which the goods, particularly sunglasses, may be encountered. The third-party registrations submitted by the examining attorney, as well as the Internet evidence, on the other hand, tend to show that the goods are related and that they are sold through overlapping trade channels to overlapping classes of purchasers.

The copies of use-based, third-party registrations submitted by the examining attorney serve to suggest that spectacles and sunglasses are of a type which may emanate from a single source. *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467,


⁴ At www.macmillandictionary.com; accessed November 6, 2012. We take judicial notice of these latter online dictionary definitions, as they are not in the record. *See University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *see also*, TBMP §712.01 (3d. ed. rev. 2012).

⁵ *Id.*


⁶ Applicant’s Brief, pp. 14-15.

1470 n.6 (TTAB 1988), *aff'd*, 864 F.2d 149 (Fed. Cir. 1988). *See also, In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993).

Examples of use-based, third-party registrations include:⁷

Reg. No. 3942145 for the mark  for “cases for spectacles and sunglasses; spectacles and sunglasses” owned by DeBauch Limited;

Reg. No. 4016795 for the mark BOUGHT and Reg. No. 4016796 for the mark BOUGHT SUNGLASSES for “eyewear, namely, sunglasses, eyeglasses, spectacles....” owned by Bought Incorporated;

Reg. No. 4003586 for the mark  for, *inter alia*, “spectacles and sunglasses” owned by Zhengguo Zhang;

Reg. No. 4068131 for the mark MAKO for “optical goods, namely, spectacles, spectacle cases, sunglasses....” owned by Allso International Marketing Pty. Limited;

Reg. No. 4007334 for the mark WILLY BONES for, *inter alia*, “spectacles and sunglasses” owned by Brian K Sahs; and

Reg. No. 3989727 for the mark ALTITUDE for, *inter alia*, “spectacles and sunglasses” owned by Radians, Inc.

These prior registrations show that spectacles and sunglasses are likely to be sold together as related merchandise. The Internet evidence further supports this conclusion.⁸ It includes web pages from www.oakley.com/store/, where men’s prescription eyewear and prescription sunglasses are advertised under the mark OAKLEY, and further includes web pages where non-prescription sunglasses are

⁷ From the examining attorney’s Final Office action.

⁸ *Id.* We note that none of the web pages refer to the products pictured therein as “spectacles.” The terminology used includes “eyewear,” “sunglasses,” “optical collection” and “eyeglasses.” However, as noted above, “eyewear” and “spectacles” are synonyms.

advertised under the mark OAKLEY.⁹ The RAY-BAN website offers eyeglasses and sunglasses under the mark RAY-BAN.¹⁰ In addition, at www.pearlevision.com and www.lenscrafters.com, prescription sunglasses are advertised along with regular eyeglasses.¹¹ In view of the above, the goods are related and overlap, and the channels of trade overlap as well. The purchasers would include ordinary members of the general public. These factors favor a finding of likelihood of confusion.

B. Comparison of the Marks

We next turn to consider the marks. At the outset of this consideration, it is noted that “when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 32 USPQ2d 1698 (Fed. Cir. 1992). In comparing the marks, we must consider the marks in their entireties as to appearance, sound, connotation and commercial impression, to determine the similarity or dissimilarity between them. *Palm Bay*, 73 USPQ2d at 1692. The test, under the first *du Pont* factor, 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 that confusion as to the source of the goods offered under the respective marks is likely to result. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir.

⁹ Prescription eyeglasses and sunglasses are sold at www.oakley.com/store/prescription. Non-prescription sunglasses are sold at www.oakley.com/store/sunglasses.

¹⁰ Eyeglasses are offered at www.ray-ban.com/usa/products/optical and sunglasses are offered at www.ray-ban.com/usa/sunstore.

¹¹ See Final Office action.

1985). On the other hand, different features may be analyzed to determine whether the marks are similar. *Price Candy Company v. Gold Medal Candy Corporation*, 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 entirety. *In re National Data Corp.*, 224 USPQ at 751. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

In the case at hand, both marks share the term DIRK, making them similar in appearance and pronunciation. Consumers will be inclined to focus on the term DIRK in both marks, as it is the first term in the cited mark and the only term in applicant's mark. *See Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”). Applicant argues that the cited mark is dominated by the second term in the mark, BIKKEMBERGS, in that it is “much more unique than DIRK.”¹² Even assuming this to be true, we do not find that the unusual nature of the name “Bikkembergs” renders the cited mark necessarily dominated by the term such that confusion with applicant's mark DIRK is avoided. The general commercial impression of both marks, DIRK and DIRK BIKKEMBERGS, is that of a person's name. It is highly likely that consumers will believe that both marks identify the same source and that the cited mark is merely

¹² Applicant's Brief, p. 11.

the complete, full name of an individual whose first name is Dirk. The addition of the term BIKKEMBERGS in the cited mark may add to the likelihood of confusion, inasmuch as it would be perceived as a surname. *See Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co.*, 216 USPQ168, 170 (TTAB 1982) (“Where the marks are otherwise virtually the same, the addition of a house mark or, as in this case, a surname, is more likely to add to the likelihood of confusion than to aid to distinguish the marks.”).

Applicant argues that because “dirk” may be found in the dictionary as having another meaning, specifically “a dagger, especially of the Scottish Highlands,”¹³ consumers of applicant’s sunglasses are just as likely to consider “dirk” as meaning a dagger as they are to consider it to be a first name. There is no evidence in the record to support this assertion and there is nothing in the nature of the goods that would suggest the significance of the mark as it would be likely to be perceived by consumers. The dictionary definition of “dirk” as a dagger carries no greater weight than that of the dictionary definition of “Dirk” as a boy’s first name.¹⁴ Accordingly, we find that purchasers are just as likely to perceive either, or both, meanings of the term when encountering applicant’s mark. Since one of the dictionary meanings is similar to the meaning of the name DIRK in the prior registration, the connotations of both marks are similar. *Cf., In re Polo Int’l Inc.*, 51 USPQ2d 1061, 1063 (TTAB 1999) (finding the acronym “DOC” in DOC-CONTROL

¹³ *Id.*

¹⁴ *See Lansky, 100,000+ Baby Names*, p. 386 (2009) (“Dirk (German) a short form of Derek, Theodoric”).

would be understood to refer to the “documents” managed by applicant's software, not “doctor” as shown in dictionary definition).

Finally, we address applicant’s argument that the form in which registrant uses its mark is BIKKEMBERGS, not DIRK BIKKEMBERGS. Applicant’s argument that registrant is not using the mark in the cited registration, but rather only a portion thereof, is a collateral attack on the cited registration and, as such, is not relevant or appropriate in this *ex parte* appeal. Section 7(b) of the Trademark Act provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant’s ownership of the mark and of the registrant’s exclusive right to use the mark in commerce in connection with the goods and services specified in the certificate. During *ex parte* prosecution, an applicant will not be heard on matters that constitute a collateral attack on the cited registration, as is the case herein. *See In re Dixie Restaurants*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n. 5 (TTAB 1992). Thus, we have given no further consideration to applicant’s remarks in this regard.

For the above reasons, this *du Pont* factor favors a finding of a likelihood of confusion.

C. Strength of the Mark of the Cited Registration

The examining attorney initially refused registration to applicant under Trademark Act § 2(d) on the basis of two registrations for various items of clothing, namely Reg. No. 3955625 for the mark DIRK DEJOINE (in standard character format) and Reg. No. 1539400 for the mark DIRK BIKKEMBERGS (in standard

character format). Applicant argues that the existence of these prior registrations, in addition to the three other registrations for “DIRK-derivative” marks mentioned in applicant’s brief but not introduced as evidence, show that the cited mark is weak and entitled to a narrow scope of protection. The other three registrations are for the marks DIRK DAGGER, DIRK ZELLER and DIRK PITT. As noted above, the reference to these three prior registrations carries little weight because we do not have any information about the registrations beyond the marks themselves, which are readily distinguishable from the cited mark DIRK BIKKEMBERGS. As for the two marks for which we have information, we note that Reg. No. 1539400 is owned by the same owner as the cited mark and is the identical mark. The remaining registration is for the composite mark DIRK DEJOINE, which is distinguishable from the cited mark. That this mark and the cited mark co-exist tells us nothing about whether applicant’s mark, which does not include a unique second element such as DEJOINE, is similar to the cited mark. This *du Pon* factor is considered neutral.

D. Balancing the factors.

In view of close relationship of the goods, the overlapping trade channels and classes of purchasers, and because the marks are similar, we find that registration of the mark DIRK for sunglasses is likely to cause confusion with the previously registered mark DIRK BIKKEMBERGS for spectacles. Further, we have resolved any remaining doubt in favor of the prior registrant. *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.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

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