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Mailed:
June 12, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Schembechler Enterprises, LLC

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Serial No. 85314616

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Timothy Edward Eagle of Varnum, LLP for Schembechler Enterprises, LLC.

Kristina Morris, Trademark Examining Attorney, Law Office 116 (Michael W. Baird, Managing Attorney).

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Before Zervas, Ritchie, and Hightower, Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

On May 6, 2011, applicant Schembechler Enterprises, LLC filed an application to register the mark THE TEAM, THE TEAM, THE TEAM (in standard character form) for goods in International Classes 9 and 16 that are not at issue here, as well as for the following goods in International Class 25:

Clothing, namely, athletic footwear, athletic uniforms, baseball caps, bathing trunks, Bermuda shorts, caps, cloth bibs, coats, jackets, fleece pullovers, footwear, golf shirts, gym shorts, headwear, hat bands, jerseys, jogging suits, polo shirts, rainwear, shorts, socks, sweat pants, sweat shirts, sweat shorts, sweat suits, sweaters, tank

tops, T-shirts, one piece baby undershirts with diaper cover, shirts, and pants, in International Class 25.¹

The examining attorney refused registration of applicant's mark as to the goods in International Class 25 on the ground of a likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), with the prior registered mark TEAM (in standard character form) for "athletic shoes and sandals for men and boys; dress shoes, sandals, and slippers for women and girls."²

The examining attorney also refused registration of applicant's mark for "athletic uniforms" on the ground that it is merely descriptive of those specific goods pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. § 1051(e)(1).

Applicant timely appealed. Both applicant and the examining attorney filed appeal briefs.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Company, Inc.*, 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 similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d

¹ Application Serial No. 85314616, filed pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), as to all classes.

² Registration No. 2809492, issued January 27, 2004; combined declaration of use and incontestability under Sections 8 and 15 of the Trademark Act accepted and acknowledged February 3, 2010.

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 Goods and Channels of Trade

We turn first to the similarity of the goods and the channels of trade, the second and third *du Pont* factors, respectively. Applicant’s goods in Class 25 include “footwear” and “athletic footwear.” The goods in the cited registration are “athletic shoes and sandals for men and boys; dress shoes, sandals, and slippers for women and girls.”

Registrant’s “athletic shoes and sandals for men and boys” are a subset of applicant’s broader category of “athletic footwear,” while applicant’s “footwear” comprises all of the more specifically identified prior registered goods. Therefore, with respect to footwear, we presume that the application encompasses the goods in the prior registration, the goods move in all normal channels of trade, and they are available to all potential classes of ordinary consumers. *See Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Moreover, because the footwear described in the application is legally identical to the goods in the cited registration, we presume that the channels of trade and classes of purchasers are the same. *See American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *see also In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding the Board entitled to rely on this legal presumption in determining likelihood of confusion).

It is sufficient for a finding of likelihood of confusion if confusion is likely with respect to use of the mark on any item that comes within the description of goods in the application or registration. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.net, Inc.*, 90 USPQ2d 1393, 1397 (TTAB 2007). Accordingly, in our likelihood of confusion analysis, these findings under the second and third *du Pont* factors strongly support a finding of likely confusion.

B. Similarity of the Marks

We next consider the *du Pont* factor focusing on the similarity or dissimilarity of “the marks in their entireties as to appearance, sound, connotation, and commercial impression.” *Palm Bay Imports 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). In comparing the marks, we are mindful that the test 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 so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Elec. Mfg. Co. v. JFD Elecs. 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*, No. 92-1086 (Fed. Cir. June 5, 1992). We also keep in mind that when, as here, 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 Am., 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entirety, 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).

Here, applicant’s mark is THE TEAM, THE TEAM, THE TEAM and the cited registered mark is TEAM. Applicant’s mark simply repeats the entire prior registered mark three times and adds the definite article THE. Mere repetition does not necessarily create a new and different meaning or commercial impression of a mark as compared to its separate components. *See In re Tires, Tires, Tires, Inc.*, 94 USPQ2d 1153, 1155 (TTAB 2009) (TIRES TIRES TIRES generic for retail tire store services); *In re Litehouse, Inc.*, 82 USPQ2d 1471, 1474 (TTAB 2007) (CAESAR! CAESAR! merely descriptive of salad dressing); *In re Disc Jockeys, Inc.*, 23 USPQ2d 1715, 1716 (TTAB 1992) (DJDJ merely descriptive of disc jockey services). In addition, the definite article “the” is insignificant as a source-identifier. *See In re*

Thor Tech, Inc., 90 USPQ2d 1634, 1635 (TTAB 2009) (affirming refusal to register WAVE due to a likelihood of confusion with registered mark THE WAVE, stating: “The marks are virtually identical. The addition of the word ‘The’ at the beginning of the registered mark does not have any trademark significance.”); *In re Narwood Prods., Inc.*, 223 USPQ 1034, 1034 (TTAB 1984) (noting the insignificance of the word “the” in comparison of THE MUSIC MAKERS and MUSICMAKERS); *Conde Nast Publ’ns Inc. v. Redbook Publ’g Co.*, 217 USPQ 356, 357 (TTAB 1983) (noting that the word “the” cannot serve as an indication of origin); *U.S. Nat’l Bank of Oregon v. Midwest Savs. & Loan Ass’n*, 194 USPQ 232, 236 (TTAB 1977).

Applicant argues that its mark makes a different overall commercial impression than the mark in the cited registration, and relies on two existing registrations for the mark PIZZA!PIZZA! for “restaurant services” and “pizza for consumption on or off the premises.”³ However, we are not bound by those registrations; each case must be decided on its own facts, based on the particular mark, the particular goods or services, and the particular record in each application. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

We do not view the triple repetition by applicant, taking into account the addition of the word “THE,” as creating a mark with a different meaning or significantly different commercial impression from the cited registered mark TEAM. We find applicant’s mark THE TEAM, THE TEAM, THE TEAM to be similar to the cited mark TEAM in sight, sound, connotation, and commercial impression.

³ See Appeal Brief at 5; Registration Nos. 1439558 and 1399730, February 27, 2012 response to Office action at 2-5.

Therefore, the first *du Pont* factor supports a conclusion that confusion is likely, particularly considering that applicant's goods are legally identical to those identified in the cited registration.

C. Conclusion as to Likelihood of Confusion

We have carefully considered all of the evidence of record as it pertains to the relevant *du Pont* factors. To the extent that any other *du Pont* factors for which no evidence or argument was presented by applicant or the examining attorney may nonetheless be applicable, we treat them as neutral. In view of our findings that the marks are similar and the goods are legally identical and move in the same channels of trade and to the same customers, we find that applicant's mark is likely to cause confusion with the registered mark when used in association with applicant's Class 25 goods.

Mere Descriptiveness

We now turn to the examining attorney's refusal to register the International Class 25 goods in view of the asserted mere descriptiveness of "athletic uniforms," in applicant's identification of goods.

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys knowledge of a quality, characteristic, function, feature, purpose or use of the goods with which it is used. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive must be determined not in the abstract, but in relation to the goods for which registration is sought, the context in which the term is used, and the possible

significance that the term is likely to have to the average purchaser encountering the goods in the marketplace. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Eng'g Sys. Corp.*, 2 USPQ2d 1075, 1076 (TTAB 1986). That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). It is settled that “[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them.” *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002).

Athletic uniforms are worn by teams. To our knowledge, there is no use or purpose for athletic uniforms other than to be worn by members of athletic teams.⁴ For that reason, applicant’s mark THE TEAM, THE TEAM, THE TEAM conveys no information about applicant’s athletic uniforms. Accordingly, the refusal to register applicant’s mark for “athletic uniforms” under Section 2(e)(1) is reversed.

Decision: We affirm the examining attorney’s refusal to register applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), for applicant’s goods in International Class 25. We reverse the refusal to register applicant’s mark for “athletic uniforms” under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). The application will proceed to publication solely as to the goods in International Classes 9 and 16.

⁴ See August 27, 2011 Office action at 13, 46-55 (screenshots from websites offering athletic team uniforms); see also examining attorney’s brief at unnumbered p. 11 (“Athletic uniforms, by their nature of being used to identify members of a group, are commonly intended to be used by sports teams.”).