

**This Opinion is Not a
Precedent of the TTAB**

Mailed: August 11, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gavin McNeill

Serial No. 85461532

Venus Griffith Trunnel,
for Gavin McNeill.

Priscilla Milton, Trademark Examining Attorney, Law Office 110,
Chris A. F. Pedersen, Managing Attorney.

Before Quinn, Masiello, and Hightower,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

Gavin McNeill (“Applicant”) seeks registration on the Principal Register of the following mark for “Caps; Hats; Headwear; Jackets and socks; Sweatshirts; T-shirts; Tank tops; Tops” in International Class 25:¹



¹ Application Serial No. 85461532, filed November 1, 2011, based on Applicant’s claim of first use anywhere and in commerce since at least as early as December 1, 2009. On November 1, 2013, a “child” application, containing services in Class 35, was divided from this application; it is not subject to the present refusal to register or otherwise before us.

The application contains the following description: “The mark consists of a black outline of a baseball hat and the word ‘Cool’ beneath the hat that resembles a face.”

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). Specifically, registration has been refused on the ground that Applicant’s mark, as applied to the goods identified in the application, so resembles the mark COOL!, previously registered in standard characters on the Principal Register for the following goods in International Class 25:

Apres-ski shoes; Beach shoes; Blouses; Canvas shoes; Dress pants; Dress shirts; Dress suits; Dresses; Dresses made from skins; Dressing gowns; Dressing gowns and bath robes; Evening dresses; Head scarves; Jogging pants; Knit dresses; Knit shirts; Knit skirts; Leather shoes; Leisure shoes; Long-sleeved shirts; Lounge pants; Moisture-wicking sports pants; Moisture-wicking sports shirts; Night shirts; Open-necked shirts; Over shirts; Pants; Petti-pants; Pique shirts; Pleated skirts for formal kimonos (hakama); Polo shirts; Sandals and beach shoes; Scarves; Shirts; Shirts and short-sleeved shirts; Shirts and slippers; Shirts for suits; Shoes; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Shoulder scarves; Silk scarves; Ski and snowboard shoes and parts thereof; Skiing shoes; Skirts; Skirts and dresses; Sleep pants; Sleep shirts; T-shirts; Tee shirts; Women’s shoes; Women’s shoes, namely, foldable flats²

as to be likely to cause confusion, to cause mistake, or to deceive.

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 the refusal to register.

² Registration No. 4137929, issued May 8, 2012.

I. Analysis

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, however, 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, 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.”).

We first address the similarity of the goods and channels of trade, the second and third *du Pont* factors, respectively. The “T-shirts” identified in the application are identical to Registrant’s “T-shirts” and essentially identical to Registrant’s “tee shirts” and “short-sleeved or long-sleeved t-shirts.” Therefore, we find that Applicant’s goods and registrant’s goods are, in part, identical.

Because there are no limitations as to channels of trade or classes of purchasers in the description of goods in the cited registration, we presume that the registrant’s goods move in all normal channels of trade for such goods and 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 Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). Moreover, because the goods

described in the application and the cited registration are in part identical, we must 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 Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (“*Viterra*”) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion).

In our likelihood of confusion analysis, these findings under the second and third *du Pont* factors strongly support a conclusion that confusion is likely.

We turn next to the first *du Pont* factor, “the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “The 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) (quotation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013).

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, 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*, 224 USPQ at 751.

We are mindful that when, as here, marks would appear on goods that are identical in part, “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, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).


The cited mark is COOL! Applicant’s mark is:



Applicant’s mark contains prominent design aspects, distinguishing it visually from the cited mark. For marks consisting of words and a design, however, the words are normally given greater weight because they would be used by consumers to request the goods. *See Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011); *M.C.I. Foods Inc. v. Bunte*, 96 USPQ2d

1544, 1551 (TTAB 2010). Indeed, Applicant’s mark consists of the word “cool” stylized to resemble a face below lines forming the bill and crown of a cap, as reflected in the description of the mark (“The mark consists of a black outline of a baseball hat and the word ‘Cool’ beneath the hat that resembles a face.”). We therefore find the word COOL to be the dominant portion of Applicant’s mark.

Applicant argues in part that the Trademark Examining Attorney improperly dissected his mark and “failed to recognize that the design element in Applicant’s mark is dominant.”³ This position does not acknowledge that Applicant’s mark includes design elements that are not entirely distinct from the word “cool,” but rather form the letters of that word. Our primary reviewing court rejected an argument similar to Applicant’s in *Viterra*, affirming the refusal to register the mark XCEED (in standard characters) due to a likelihood of confusion with the

previously registered mark , both for “agricultural seed(s).” The court noted:

Here, the design feature of the X-Seed Mark is not entirely distinct from the literal portion of the mark; rather, the color and design features are incorporated in the letter “X” and are covered in part by the “-Seed” portion of the mark. This is not a case, therefore, where a larger design is separate and independent from the literal features of the mark. The design itself is a stylized letter that overlaps with, and is covered by, other literal portions of the mark. Accordingly, the Board’s determination that the entire literal portion “X-Seed” is the dominant portion of the mark, and not just the stylized “X,” is supported by substantial evidence.

³ Appeal Brief at 6.

101 USPQ2d at 1911. *See also Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983) (finding the word GIANT to be the




dominant feature of the mark).

The literal portion of Applicant's mark and the cited mark are identical – the single word “cool” – except for the exclamation point in the cited registration. We do not consider the exclamation point to distinguish the marks. Used as punctuation, it has no meaningful impact aurally or as to commercial impression. *Cf. In re Litehouse Inc.*, 82 USPQ2d 1471, 1474 (TTAB 2007) (finding that exclamation points in CAESAR!CAESAR! do not significantly change commercial impression of the mark or negate its mere descriptiveness).

Applicant's mark and the cited mark are identical in sound and meaning. Moreover, the fact that Applicant's mark subsumes the cited mark increases the similarity between the two. *See, e.g., Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design for men's cologne, hair spray, conditioner and shampoo likely to cause confusion with CONCEPT for cold permanent wave lotion and neutralizer); *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558, 559 (CCPA 1972) (WEST POINT PEPPERELL and griffin design for fabrics and linens is likely to cause confusion with WEST POINT for woolen piece goods).



For all of these reasons, we find Applicant's mark  to be similar in sound, meaning, and overall commercial impression to the cited mark COOL!, and that these similarities outweigh the difference in appearance. Therefore, the first *du Pont* factor supports a conclusion that confusion is likely.

Turning to Applicant's other arguments, Applicant asserts that because of the number and nature of similar marks in use on similar goods – the sixth *du Pont* factor – the cited mark is weak and entitled to a limited scope of protection. Applicant bases this argument on eight third-party registrations incorporating the term COOL for clothing items.⁴ Even were we to accept Applicant's argument that these registrations limit the scope of protection afforded to the cited registration,⁵ marks considered highly suggestive or “weak” are nonetheless entitled to protection from registration by a subsequent user of a confusingly similar mark for related goods. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010). All of the third-party registrations on which Applicant relies comprise additional verbiage and thus are distinguishable from his mark, in which the identical word COOL is the only literal element. This argument is not persuasive.

⁴ Applicant submitted printouts of these registrations with his March 9, 2013 Response to Office Action.

⁵ It is well-established that third-party registrations are not evidence that the marks therein have been used at all, let alone used so extensively that consumers are sufficiently conditioned by their use that they can distinguish between such marks on the basis of minor differences. The probative value of third-party trademarks depends entirely on their usage. *Palm Bay Imports, Inc.*, 73 USPQ2d at 1693. Where the record includes no evidence about the extent of third-party uses, the probative value of this evidence is minimal. *Han Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1561 (Fed. Cir. 2001).

Finally, there is no evidence supporting Applicant's argument that consumers of the identified goods – including T-shirts, a ubiquitous and typically inexpensive type of clothing – are sophisticated, lessening the likelihood of confusion.

We have considered all the evidence of record as it pertains to the relevant *du Pont* factors. In view of our findings that the marks make similar commercial impressions and the goods are identical in part 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 mark in cited Registration No. 4137929 when used in association with Applicant's goods.

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