

<p>This Opinion is Not a Precedent of the TTAB</p>

Mailed: July 7, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re New Era Cap Co., Inc.
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Serial No. 85515684
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Tara Hart-Nova and David L. Principe of Phillips Lytle LLP
for New Era Cap Co., Inc.

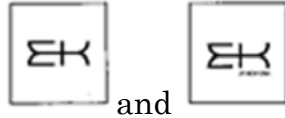
David Yontef, Trademark Examining Attorney, Law Office 118,
Thomas G. Howell, Managing Attorney.

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Before Kuhlke, Taylor and Lykos,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

New Era Cap Co., Inc. (“Applicant”) seeks registration on the Principal Register of the mark **EK** in standard character format for “Headwear, hats, caps, knit hats and baseball caps” in International Class 25.¹ The application includes a claim of ownership of the following two registered marks

¹ Application Serial No.85515684, filed January 13, 2012 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). The application alleges September 9, 2005 as the date of first use anywhere and in commerce.



both for goods identified as “headgear, namely hats and athletic caps” in International Class 25.²

Registration was refused under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that Applicant’s applied-for mark so resembles the following three registered marks each owned by different entities, that, when used on or in connection with Applicant’s identified goods, it is likely to cause confusion or mistake or to deceive:³

Registration No. 2372119, owned by Sigma Kappa Sorority for the mark



on the Principal Register for “clothing, namely, sweatshirts, t-shirts, jackets, hats, socks, sweaters, boxer shorts, pajamas, cloth bibs, and kerchiefs” in International Class 25. The registration is also for a variety of paper goods in International Class 16 as well as a collective membership mark for “indicating membership in a collegiate sorority” in International Class 200. The description of the mark is as follows: “The mark consists of the Greek letters sigma kappa.”⁴

Registration No. 3911907, owned by Ektio Inc., for the mark

² Registration Nos. 3256812 and 3298501 on the Principal Register, alleging September 9, 2005 as the date of first use anywhere and in commerce; Sections 8 and 15 affidavits accepted and acknowledged.

³ Registration No. 3120406 was also cited, but the refusal was withdrawn following cancellation of the registration.

⁴ Registered August 1, 2000, alleging December 1920 as the date of first use anywhere and in commerce for International Class 25; Sections 8 and 15 affidavits accepted and acknowledged; renewed.



on the Principal Register for “footwear” in International Class 25. The description of the mark is as follows: “The mark consists of the letters ‘EK’ enclosed within an oval.” Color is not claimed as a feature of the mark.⁵

Registration No. 4021353 owned by E.L and Limited for the mark



on the Principal Register for “Clothing, namely, t-shirts, knit tops, shirts and jackets” in International Class 25. The description of the mark is as follows: “The mark consists of [t]he letters ‘EK’ in stylized format.” Color is not claimed as a feature of the mark.⁶

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 base our determination under Section 2(d) on 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) (“*du Pont*”). *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

⁵ Registered January 25, 2011, alleging November 19, 2010 as the date of first use anywhere and in commerce.

⁶ Registered September 6, 2011, alleging 2005 as the date of first use anywhere and August 2007 as the date of first use in commerce.

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 (CCPA 1976). These factors, and the other relevant *du Pont* factors, are discussed below.

I. Registration No. 2372119

First we consider the Section 2(d) refusal based on the registered mark  owned by Sigma Kappa Society. It is undisputed that both the application and Sigma Kappa Society's registration both include "hats." *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Because the goods are identical in part, we must presume that these goods travel in the same channels of trade to the same classes of consumers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). Thus, the second and third *du Pont* factors weigh in favor of finding a likelihood of confusion.

Nonetheless, a single *du Pont* factor may be dispositive, and when we compare the marks, we find that to be the case here. *See Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). The first *du Pont* likelihood of confusion factor involves an analysis of the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). "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).

The Examining Attorney contends that the marks are similar in appearance, meaning, sound and commercial impression insofar as Sigma Kappa Society’s mark is a stylized version of the letters “EK” and would be pronounced and perceived by prospective consumers as such. This argument, however, is contradicted by the evidence of record showing that the registered mark consists not of the letters “E” and “K” from the English alphabet but rather the Greek letters Sigma and Kappa, and that Sigma Kappa is a college sorority in the United States. See entry for “Sigma Kappa” from *Wikipedia* (Request for Reconsideration February 27, 2013). Indeed, the description of the mark from the registration explicitly states that “[t]he mark consists of the Greek letters sigma kappa”, and the owner of the registration is, as noted above, the Sigma Kappa Society. While Applicant’s mark would be pronounced as the letters “EK” and only perceived as the letters “EK,” the registered mark is pronounced quite differently as “Sigma Kappa,” and perceived as identifying both Greek letters and the name of a sorority.

Thus, with regard to Registration No. 2372119, the record shows that the dissimilarity of the marks and differences in sound, meaning, and commercial impression are so great that they outweigh the other *du Pont* factors, discussed

above. For that reason, we find the first *du Pont* factor to be dispositive, and the Examining Attorney's Section 2(d) refusal is reversed.

II. Registration Nos. 3911907 and 4021353

Next we turn our attention to the registered marks  for "footwear" and  for "Clothing, namely, t-shirts, knit tops, shirts and jackets." Considering the first *du Pont* factor, Applicant argues that by virtue of its ownership of two prior incontestable registrations for the marks noted above (EK and EK BY NEW ERA, both stylized), the Section 2(d) refusal should be reversed because "Applicant's registrations for its EK marks all predate, by a significant amount, the EK registrations being cited by the examining attorney." Applicant's Brief, p. 9. Applicant explains that "[t]hrough the filing of this application, [it] seeks to expand its incontestable rights in the mark EK in connection with headwear to cover additional stylized versions of its mark." Applicant's Brief, p. 11. Applicant also argues that if the cited registrations incorporating the same literal element "EK" (albeit in different stylization) can co-exist, then Applicant's mark should also be allowed.

Applicant's arguments are unconvincing. As correctly noted by the Examining Attorney in its brief, any purported claim of prior use is irrelevant to this *ex parte* proceeding. See *In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (CCPA 1971). Furthermore, Applicant's previously registered marks contain highly stylized versions of the letters "EK." The application before us however consists of the letters **EK** in standard character format, meaning that if registered, Applicant

would have the right to use the mark in any font, style, size, or color, including versions identical to either of the registered marks. *See* Trademark Rule 2.52(a). If Applicant intended to cover “additional stylizations” of the letters EK, it should have filed applications displaying the mark as such. We therefore agree with the Examining Attorney’s assessment that Applicant’s mark is virtually identical to in appearance, sound, connotation and commercial impression, to the registered marks



and . Thus, the first *du Pont* factor favors a finding of likelihood of confusion.

We turn now to the second *du Pont* factor, a comparison of the goods identified in Applicant’s application vis-à-vis the goods identified in the cited registrations. Applicant contends that the goods in its application and the cited registrations are unrelated because such goods would be found in different sections of a store or web site. Applicant further argues that the involved goods are “very specific” and “narrowly defined” without any overlap. Applicant’s Brief, p. 13.

Applicant’s arguments reflect a misunderstanding of the analysis of the second *du Pont* factor. Even if the goods differ and are not identical or directly competitive, they need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin’s Famous Pastry Shoppe, Inc.*, 223 USPQ 1289 (Fed. Cir. 1984). “The crucial question here is whether source confusion is likely . . . whether or not the goods are displayed close together or far apart in the same store

is immaterial.” *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 n.30 (TTAB 1989), citing *In re Cosmetically Yours, Inc.*, 171 USPQ 563, 565 (TTAB 1971).

To show the relatedness of the goods, the Examining Attorney submitted numerous copies of use-based, third-party registrations for marks identifying goods of the type found in both Applicant’s application and Registrants’ registration. See August 29, 2012 Office Action. Note for example the following:

Registration No. 2046695 for the mark **MARC JACOBS** (typed) for “men's apparel, namely, shirts, pants, jackets, ties, shorts, coats, suits, shoes, hats, sweaters, gloves, belts, underwear and hosiery” in International Class 25;

Registration No. 4129614 for the mark **EMMA STEVENS** (standard characters) for “Clothing, namely, blouses, shirts, T-shirts, polo shirts, halter tops, tank tops, dresses, skirts, blazers, jackets, vests, shorts, jeans, pants, suits, sweaters, cardigans, turtlenecks, sweatshirts, sweat pants, sweat suits, coats, rain coats, parkas, ski jackets, ski vests, ski pants, camisoles, boxer shorts, pajamas, nightshirts, nightgowns, hats, tuques, baseball caps, socks, scarves, shawls, ponchos, bandannas, headbands, gloves, mittens, belts, footwear, namely, shoes, boots, sandals, sneakers, slippers” in International Class 25;

Registration No. 4156703 for the mark **RYO** (standard characters) for “Men's and women's clothing, namely, swimwear, bathing suits, bikinis, cover-ups, tank tops, shirts, skirts, dresses, shorts, jumpers, capris, leggings, pajamas, robes, jerseys, socks, underwear, gloves, belts, ties, vests; headwear, namely, caps and visors; and footwear, namely, sandals, slippers, boots, and athletic shoes, T-shirts, sweatshirts, sweatpants, swim trunks, walking shorts, pants, underwear, tank tops, shirts, jackets and hats” in International Class 25.

(emphasis added). Copies of use-based, third-party registrations may serve to suggest that the goods are of a type which may emanate from a single source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993).

In addition, the Examining Attorney submitted Internet evidence showing third parties offering for sale the same goods as Applicant and Registrants under the same brand name. See for example excerpts from the Under Armour, Adidas and Puma web sites showing use of the same trademark in connection with caps, baseball caps, athletic shoes, shirts and t-shirts. *Id.* This is further evidence that consumers expect to find both parties' products emanating from a common source.

We therefore find persuasive the Examining Attorney's evidence showing the relatedness of the goods via use-based third-party registrations and third-party Internet web sites. This evidence is made even more compelling given that the marks at issue are virtually identical. Thus, the second *du Pont* factor also weighs in favor of finding a likelihood of confusion.

Next we consider established, likely-to-continue channels of trade, the third *du Pont* factor. In the absence of specific limitations in each registration, we must presume that both Registrants' goods will travel in all normal and usual channels of trade and methods of distribution. *Squirtco v. Tomy Corporation*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983); *see also In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992) (because there are no limitations as to channels of trade or classes of purchasers in either the application or the cited registration, it is presumed that the services in the registration and the application move in all

channels of trade normal for those services, and that the services are available to all classes of purchasers for the listed services). Since there are no limitations on the channels of trade in Applicant's identification of goods either, we must make the same presumption with regard to Applicant's goods. As demonstrated by the Internet evidence, Applicant's and Registrants' types of goods are offered in the same channels of trade, such as online and retail stores (e.g. Modells, Sports Authority, and Footlocker). *See* August 29, 2012 Office Action. Thus, there is nothing that prevents Applicant from offering for sale its products through the same channels of trade and to the same consumers who purchase Registrants' goods, and vice-versa. Accordingly, we find that this *du Pont* factor also weighs in favor of finding a likelihood of consumer confusion.

In summary, we have carefully considered all of the evidence of record pertaining to the relevant and discussed *du Pont* likelihood of confusion factors, as well as Applicant's arguments with respect thereto, and find that the Office has met its burden.

Decision: The Section 2(d) refusal to register Applicant's mark is reversed as to Registration No. 2372119 but affirmed as to Registration Nos. 3911907 and 4021353.