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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Perry

Serial No. 85561003

Anthony M. Keats of Stubbs Alderton & Markiles, LLP
for Anthony Joseph Perry.

Marc J. Leipzig, Trademark Examining Attorney, Law Office 115
John Lincoski, Managing Attorney.

Before Quinn, Ritchie, and Lykos, Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Anthony Joseph Perry filed an application to register the mark THE BONEYARD and design as shown below, for “clothing, namely, t-shirts, shirts, dresses, jackets, skirts, pants, shorts, sweaters, sweatshirts, one piece garments for infants and toddlers, sweatpants, robes, undergarments, scarves, gloves, socks, hats, caps, visors, sleepwear; footwear, swimwear,” in International Class 25¹:

¹ Application Serial No. 85561003, filed March 6, 2012, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a *bona fide* intent to use in commerce. The mark includes the following description: The mark consists of the words “THE BONEYARD” in a stylized font, with a skull design in between the “E” and “Y” of “BONEYARD.”



The Trademark Examining Attorney refused registration of the mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the mark BONEYARDS, in standard character format, registered for, as relevant, "belts, footwear, headwear, pants, shirts, shorts, t-shirts," in International Class 25,² that when used in connection with Applicant's identified goods, it will be likely to cause confusion, mistake, or to deceive. Upon final refusal of registration, Applicant filed a timely appeal.³ Both Applicant and the Examining Attorney filed briefs. After careful consideration of the arguments and evidence of record, we affirm the refusal to register.

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). *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 or services.

² Registration No. 3765906, issued March 30, 2010. The cited registration contains goods in other classes which were not cited in the refusal.

³ Registration was finally refused based on another cited registration as well, but as Applicant pointed out with its appeal brief, that registration was cancelled due to failure to file a Section 8 declaration of use. The Examining Attorney thus withdrew that refusal.

See Federated Foods, Inc. v. Fort Howard 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 consider each of the factors as to which Applicant or the Examining Attorney presented arguments or evidence.

The Goods and Channels of Trade

Both the application and the cited registration identify overlapping items of clothing, namely, “t-shirts,” “shirts,” “pants,” “shorts,” and “footwear.” Furthermore, the “hats, caps,” and “visors” identified in the application would be encompassed in the “headwear” identified in the cited registration. Accordingly, the goods are overlapping and identical-in-part.

Because the goods described in the application and the cited registration are identical-in-part, we must presume that the channels of trade and classes of purchasers overlap as well. *See Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) (“Given the in-part identical and in-part related nature of the parties’ goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade.”); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers”).

Although Applicant argues that there are different buyers for what it argues would be different styles from itself and the Registrant, there is nothing in the

recital of goods in either the cited registration or the application that limits either Registrant's or Applicant's channels of trade. *See 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 listed 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). As such, despite Applicant's arguments, neither Applicant nor Registrant is actually limited to providing its overlapping clothing items to a particular audience or via a particular style, and instead both or either may cater to the same whims of the consumer buying the very same item from the very same retailer. Accordingly, we find that these *du Pont* factors weigh heavily in favor of finding a likelihood of consumer confusion.

The Marks

Preliminarily, we note that when the goods at issue are identical or as here identical-in-part, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than if the goods were not identical. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012) citing *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

The mark in the cited registration is BONEYARDS. The differences of the literal portions of Applicant's mark are that it contains an article (*i.e.*, "THE"); it shows a singular rather than plural (*i.e.*, it omits the "S"); and it contains a space rather than combining in a compound word (*i.e.*, "BONE YARD" rather than "BONEYARDS"). None of these three minor differences are source-identifying. *See In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) ("[t]he addition of the word 'The' at the beginning of the registered mark does not have any trademark significance."); *In re Pix of Am., Inc.*, 225 USPQ 691, 692 (TTAB 1985) (use of the plural form of a term "is almost totally insignificant in terms of the likelihood of confusion of purchasers"). We further note that "[t]he 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) (citation omitted).

Applicant's mark contains a design element with a skull design. However, it is well-established that it is typically the words that consumers will use to call for or refer to goods or services. *In re Viterra Inc.*, 101 USPQ2d at 1911, citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983). Indeed in Applicant's mark the design merely serves to emphasize the commercial impression of the literal element, *i.e.*, that of a cemetery or "bone yard." Accordingly, we find that, when considered in their entirety, the marks have effectively the same commercial impression. Furthermore, as the mark in the cited registration is registered in

standard character format and may be presented in any of a variety of ways,⁴ we find the dominant literal portion of Applicant's mark to be substantially identical in sight and sound to this arbitrary mark.

Applicant argues that he uses his mark as his "primary house mark" mark, while Registrant's use of BONEYARDS is merely for one of various lines of products. (Appl's brief at 10-11). We note however that there is no indication of Applicant's mark as a house mark, and he may use the mark as a product mark as well. See Section 7(b) of the Trademark Act. Furthermore, such use would not avoid likelihood of confusion.

In view of the foregoing, the first *du Pont* factor also weighs in favor of finding a likelihood of confusion.

Consumer Care/Fame

Applicant argues that his consumers are sophisticated and would recognize the difference between THE BONEYARD and design mark as used by Applicant for his clothing and BONEYARDS as registered by Registrant. There is no evidence that consumers of clothing that may be priced at various levels would necessarily exercise a heightened degree of care. Furthermore, it is well-established that even sophisticated consumers are not immune from source confusion, especially where, as here, the goods overlap, and the marks are quite similar. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000). To the extent Applicant relies also on his fame as a rock and roll fixture, we note that

⁴ *Citigroup Inc. v. Capital City Bank Group Inc.*, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011) ("If the registrant ... obtains a standard character mark without claim to 'any particular font style, size or color,' the registrant is entitled to depictions of the standard character mark regardless of font, style, size, or color.").

Applicant's fame is not at issue in this proceeding. To the extent Applicant's mark has acquired some degree of renown, this does not avoid likelihood of confusion, and indeed may engender reverse confusion with the mark in the cited registration.⁵ See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993) ("The term 'reverse confusion' has been used to describe the situation where a significantly larger or prominent newcomer 'saturates the market' with a trademark that is confusingly similar to that of a smaller, senior registrant for related goods or services." [cites omitted]) Accordingly, these factors are neutral.

Balancing the Factors

Considering all of the evidence of record as it pertains to the *du Pont* factors, we conclude that the marks are in their dominant literal portions substantially identical in sound, appearance and meaning and, when considered in their entirety, give the same commercial impression; they are used on overlapping and identical-in-part goods, travelling through some of the same channels of trade to the same classes of purchasers, who are generally unsophisticated. Accordingly, we find a likelihood of confusion between Applicant's mark and the mark in the cited registration.

Decision: The Section 2(d) refusal to register is affirmed.

⁵ We do not opine as to Applicant's anticipated *use* of his mark, but merely his right to registration, in light of the previously existing cited registration. In this regard, he could have sought a consent agreement, just as he may seek a license for use.