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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Jockey Club LLC

Serial No. 85595169

David Weild III of Edwards Wildman Palmer LLP for The Jockey Club LLC.

Allison P. Schrody, Trademark Examining Attorney, Law Office 115 (John Lincoski, Managing Attorney).



Before Zervas, Bergsman and Wolfson, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

The Jockey Club LLC (“Applicant”) seeks registration on the Principal Register of the mark THE JOCKEY CLUB RACING COLORS (in standard character form) for “luggage, bags, namely, courier bags, beach bags, tote bags, backpacks, and travel bags; leather goods, namely, wallets, briefcases, attaché cases, handbags, leather covers for diaries, notebook covers, garment bags for travel and saddles, all made of leather” in International Class 18.¹

¹ Application Serial No. 85595169 was filed on April 11, 2012, based on an allegation of a *bona fide* intention to use the mark in commerce.

The Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), having determined that Applicant's mark is likely to cause confusion or mistake or to deceive with the marks which are the subject of the following six registrations for International Class 25 goods owned by Jockey International, Inc.:

Cited Mark	Goods
JOCKEY Reg. No. 391692 ²	Underwear, such as men's and boys' undershirts, underdrawers, both with and without legs, as well as hosiery
JOCKEY Reg. No. 509364 ³	Men's and boys' underwear, undershirts, hosiery, sport shirts, and t-shirts
JOCKEY Reg. No. 3258066 ⁴	Underwear tops and bottoms; shorts, shirts; active wear, namely boxer shorts, bicycle shorts, gym shorts, pants, pullovers, sport shirts, t-shirts, tank tops, jogging suits, warm-up suits; long underwear; sleepwear; nightwear, pajamas; robes; panties, bras, all-in-ones in the nature of camisoles with built in bras, camisoles, foundation garments, crop tops, stockings, tights and hosiery
JOCKEY PERSON TO PERSON Reg. No. 3545069 ⁵	Shorts; shirts; active wear, namely, women's sweat pants, sweat shirts, sweat shorts, t-shirts, tank tops; camisoles; jackets; pants; slacks
 JOCKEY Reg. No. 3555240 ⁶	Underwear tops and bottoms; hosiery and socks for women; shirts; pants; activewear for women, namely, sweat pants, t-shirts, tank tops; long underwear; sleepwear; night wear; pajamas; robes; women's intimate apparel, namely, panties, bras, all-in-ones, camisoles, slips, foundation garments, and crop tops
 JOCKEY Reg. No. 3758137 ⁷	Underwear tops and bottoms; shirts; active wear, pants, t-shirts, tank tops, long underwear; sleepwear; nightwear; pajamas; panties; bras; camisoles; foundation garments; crop tops; socks; hosiery

² Registered November 18, 1941. Fourth renewal, December 15, 2011.

³ Registered May 30, 1949. Third renewal, November 26, 2008.

⁴ Registered July 3, 2007. Section 8 affidavit accepted.

⁵ Registered December 9, 2008. Section 8 affidavit accepted August 19, 2014.

⁶ Registered December 30, 2008.

⁷ Registered March 9, 2010.

When the refusal was made final, Applicant filed a Request for Reconsideration and an appeal. After the Examining Attorney denied the Request for Reconsideration, the Board resumed the appeal and Applicant and the Examining Attorney filed briefs. We affirm the refusal to register.

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); *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 Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014).

In addition to the similarities or dissimilarities of the marks and the goods, the relevant *du Pont* factors in this case are the similarities or dissimilarities of trade channels and purchasers, as argued by Applicant and the Examining Attorney.

We focus our analysis on Registration Nos. 391692, 509364 and 3258066, all for the mark JOCKEY (in standard characters) for various clothing items because when considered vis-à-vis Applicant’s mark and identified goods, this mark is most

likely to support a finding of likelihood of confusion. That is, if confusion is likely between those marks, there is no need for us to consider the likelihood of confusion with the other cited marks, while if there is no likelihood of confusion between Applicant's mark and the JOCKEY standard character mark, then there would be no likelihood of confusion with the other cited marks. *See, e.g., In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010). Thus, all references in the remainder of this opinion to JOCKEY alone are to the JOCKEY mark of these three registrations.

Similarity or Dissimilarity of the Marks

We compare the marks for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay*, 73 USPQ2d at 1692. 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 that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks.⁸ *In re Association of the United States Army*, 85 USPQ2d 1264 (TTAB 2007); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely

⁸ Because the goods at issue are common consumer goods, the average purchaser is the ordinary consumer who is a member of the general public.

upon their imperfect recollections. *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255 (TTAB 1980).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the 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 National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (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”). However, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, “there is nothing wrong in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on a consideration of the marks in their entireties.” *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

With these principles in mind, we turn to Applicant’s arguments in support of registration. Applicant argues that the common term JOCKEY is part of a “lengthy adjectival phrase”; that RACING COLORS is “the more distinctive phrase of Applicant’s mark”; and that JOCKEY is “buried amongst other wording” and is less dominant than other portions of the mark, namely, the terms RACING COLORS which primarily evokes the context of horse racing. Applicant also states that

JOCKEY is a non-distinctive term when used in connection with underwear, and has a multiplicity of meaning.

While there are similarities and dissimilarities between the registered JOCKEY mark and Applicant's THE JOCKEY CLUB RACING COLORS mark, "[t]he practical question is whether they are significant" because "[t]he purchasing public, we believe, does not indulge in such recognitional contortions but sees things as they are." *B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 6 USPQ2 1719, 1721 (Fed. Cir. 1988). As Applicant recognizes at p. 7 of its Brief, its mark is a combination of two components, THE JOCKEY CLUB and RACING COLORS. Despite Applicant's protests to the contrary, THE JOCKEY CLUB, as the initial phrase of the mark, is the dominant phrase. The dominance of THE JOCKEY CLUB is heightened if Applicant depicts its mark in a form where RACING COLORS is a minor part of its mark, in smaller lettering than THE JOCKEY CLUB, which it is entitled to do because it has identified its mark in standard characters in its application. Further, "racing colors," as a unitary term, has significance in the context of horse racing, where racing colors identify a jockey or the owner of a horse ridden in a race.⁹

JOCKEY, in THE JOCKEY CLUB, signifies who the club celebrates, and forms the dominant term in THE JOCKEY CLUB. "THE" at the beginning of the mark does not have any trademark significance, *see In re Thor Tech Inc.*, 90 USPQ2d

⁹ See webpages introduced by Applicant generally, but particularly www.oughtonlimited.com/blog/racing-colors, indicating that racing colors identify riders and horse owners and www.championsilks.com ("We know how important your racing colors are ...").

1634, 1635 (TTAB 2009) (WAVE and THE WAVE are “virtually identical” and likely to be confused), and CLUB suggests an association or a meeting place - for jockeys.¹⁰ Thus, JOCKEY, the dominant term in Applicant’s mark, is identical to registrant’s JOCKEY marks.

In view of the foregoing, we find that the marks are similar in connotation and commercial impression, with registrant’s mark referring to the jockey or “someone who rides horses in races,”¹¹ and the dominant part of Applicant’s mark evoking a club for a “jockey.” In addition, with the inclusion of the shared term JOCKEY in Applicant’s mark, we find that the marks are similar in sound and appearance, and that the points of similarity of the marks are greater than the points of dissimilarity. As noted above, we are mindful that marks must be compared in their entirety and should not be dissected. We have given appropriate weight to the components of Applicant’s mark and rest our ultimate conclusion on a comparison of the marks in their entirety.

In arriving at our conclusion, we are not persuaded with those arguments made by Applicant and noted above. We also disagree with the following arguments made by Applicant:

¹⁰ See definition of “club” from <www.merriam-webster.com/dictionary/club>, defining “club” in relevant part as “the meeting place of a club <lunch at the *club*>” and “an athletic association or team.” The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002). See also *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

¹¹ See definition of “jockey” from www.merriam-webster.com/dictionary/jockey, submitted with Applicant’s Second Request for Reconsideration.

1. “Jockey” has several meanings, as demonstrated by the various definitions of the term in the record. The connotation of JOCKEY in registrant’s mark, however, may be the same as JOCKEY in Applicant’s mark. There is no reason to suspect that JOCKEY will have one definition in one mark and another definition in the other mark.

2. Registrant’s mark “conjure[s] up no commercial impression other than that of a male supportive undergarment.”¹² The record does not contain corroborating evidence of any fame or renown of JOCKEY, and we will not construe Applicant’s statement as a concession that registrant’s mark is famous for underwear.¹³ In addition, “underwear” is not within any definition of “jockey” in the record.

3. The registered JOCKEY mark is weak based on third-party webpages containing the marks MIAMI JOCKEY CLUB, and MONTE CARLO POLO AND JOCKEY CLUB.¹⁴ These marks differ from registrant’s mark.

4. Third-party registrations demonstrate that Applicant’s and registrant’s marks can coexist without risk of confusion. However, (i) the

¹² Applicant's Brief at 7.

¹³ See, however, *Jockey International Inc. v. Butler*, 3 USPQ2d 1607, 1612 (TTAB 1987) (“The record before us establishes beyond any doubt that JOCKEY word and design marks are famous trademarks in the field of clothing. Accordingly, that the propensity of consumers to associate a relatively unknown mark with one which is well known to them increases the likelihood of confusion or deception is an important factor in opposer’s favor. *E.g.*, *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 699, 223 USPQ 1281, 1282 (Fed. Cir. 1984); *Finn v. Cooper’s Incorporated*, 292 F.2d 555, 130 USPQ 269 (CCPA 1961).”).

¹⁴ The application for registration of the mark submitted by Applicant has no probative value because third-party applications are only evidence that an application has been filed for a particular mark.

marks of the two third-party registrations Applicant submitted are farther removed from the marks in either the cited registrations or involved application; and (ii) the third-party registrations Applicant submitted are not evidence of use of the marks shown therein and, therefore, are not proof that consumers are familiar with said marks so as to be accustomed to the existence of similar marks in the marketplace. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982).

In sum, Applicant's arguments do not persuade us that the marks are dissimilar in sound, appearance, meaning or commercial impression.

Similarity or Dissimilarity of the Goods

We base 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. That is, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. *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 Examining Attorney placed in the record webpages from several third-party websites that offer clothing (including undergarments) and bags, luggage and leather accessories under the same mark. *See, e.g.*, the webpages from:

- **TravelSmith** “Clothing, Gear & Advice To Go,” offering luggage, bags, wallets, luggage accessories, shirts, underwear, and undershirts (<http://travelsmith.com>);
- **J.Crew**, offering handbags, totes, clutches, duffels, suitcases, leather wallets, leather billfolds, backpacks, weekender bags, briefcases, garment bags, and providing links to “shirts,” “tees” and “underwear” as categories (<http://www.jcrew.com>);
- **Gap**, offering satchel bags, canvas bags, messenger bags, totes, travel totes, backpacks, clutches, wallets, and women’s clothing goods including bras and underwear (<http://gap.com>);
- **Brooks Brothers**, offering briefcases, duffels, messenger bags, weekender bags, totes, socks, boxer shorts and t-shirts (<http://brooksbrothers.com>);
- **L.L. Bean**, displaying links to luggage, tote bags, backpacks, messenger bags, duffels, gear bags, briefcases, and garment bags, and girls’ long underwear and other clothing goods (<http://llbean.com>);
- **Filson**, offering tote bags and satchels and small leather goods including leather wallets, notebook covers, smartphone cases, passport cases, satchels, totes and luggage tags, as well as long underwear and long john tops (<http://filson.com>);
- **Under Armour**, offering backpacks, equipment bags, duffels, travel bags, messenger bags and men’s undershirts and underwear (<http://underarmour.com>); and

- **Ralph Lauren**, offering handbags, traveler bags, underwear and t-shirts (<http://ralphlauren.com>).¹⁵

In view of this evidence, the Examining Attorney has established that Applicant's and registrant's goods are commercially related.

Applicant submitted registrations for the mark SAM EDELMAN¹⁶ for footwear and EDELMAN¹⁷ for, *inter alia*, "handbags, traveling bags, luggage trunks, umbrellas, harnesses and saddlery," and argued that the Office "has permitted very similar marks to coexist for goods in Class 18 on one hand and goods in Class 25 on the other hand, perceiving no risk of confusion."¹⁸ We do not know the circumstances involving the registration of these two marks, and we are not bound by prior decisions of Examining Attorneys and determine each case on its own record. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Applicant's evidence therefore does not persuade us that the goods are not commercially related.

Similarity or Dissimilarity of Classes of Purchasers and Trade Channels

Because there are no limitations or restrictions as to trade channels or classes of purchasers in the respective identifications of goods, we presume that the goods are or would be marketed in all normal trade channels for such goods and to all normal classes of purchasers of such goods. *See Packard Press Inc. v. Hewlett-Packard Co.*, 56 USPQ2d 1351, 1357 (Fed. Cir. 2000). As noted earlier in this decision, because

¹⁵ The Examining Attorney also pointed out registrant also owned now-cancelled Registration No. 1715756 for the mark JOCKEY (in typed or standard character form) for "luggage, brief cases and carrying cases."

¹⁶ Registration No. 3271895.

¹⁷ Registration No. 3000104.

¹⁸ Applicant's Brief at 5-6.

the goods at issue are common consumer goods, the average purchaser is the ordinary consumer who is a member of the general public.

The classes of purchasers of the goods involved in this appeal are the same, as they are all common consumer goods offered to the general public.

As for the trade channels, the Examining Attorney relies on webpages from retailers Brooks Brothers, REI, Dover Saddlery, Chick's Discount Saddlery, Athleta and Adidas showing that clothing (including undergarments) and luggage, bags, and leather goods including saddles and wallets, are commonly sold together at the same types of stores.¹⁹ The Examining Attorney remarks that specialty sporting goods stores typically offer bags, luggage, accessories and clothing goods which are specialized for particular activities.²⁰ Through this evidence, the Examining Attorney has established that the trade channels for Applicant's and registrant's goods are related.

Conclusion

We have found that the marks are similar in commercial impression and that the points of similarity of the marks are closer than the points of dissimilarity with regard to appearance, meaning and sound. In addition, we have found that the goods are related and that they travel through related trade channels and that the customers of both Applicant's and registrant's goods are the same. We therefore find that Applicant's mark, when use on the goods set forth in Applicant's application, is

¹⁹ Submitted with the Examining Attorney's August 25, 2014 denial of the Request for Reconsideration and the February 4, 2014 Final Office Action.

²⁰ Examining Attorney Brief at unnumbered p. 12.

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likely to be confused with registrant's standard character JOCKEY marks for the goods set forth in the underlying registrations.

Decision: The refusal to register Applicant's mark under Section 2(d) of the Trademark Act is affirmed.