

This Opinion is Not a
Precedent of the TTAB

Mailed: December 3, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re John Paul Merkel

Serial No. 85618114

Christine McLeod of Beusse Wolter Sanks Mora & Maire, P.A.,
for John Paul Merkel.

Matthew G. Galan, Trademark Examining Attorney, Law Office 113,
Odette Bonnet, Managing Attorney.

Before Taylor, Shaw, and Hightower,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

John Paul Merkel (“Applicant”) seeks registration on the Principal Register of
the following mark:



for “Clothing, namely, shirts, t-shirts, sweat shirts, jackets, shorts, pants, caps, and hats; Footwear, namely, boxing, wrestling, and mixed martial arts shoes” in International Class 25.¹

¹ Application Serial No. 85618114, filed May 7, 2012 based on Applicant’s claim of first use anywhere and in commerce since at least as early as April 9, 2012.

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as used in connection with his goods, so resembles the mark **d t f**, previously registered in standard characters on the Principal Register for "clothing, namely, shirts, t shirts, caps, visors, jackets" in International Class 25,² as to be likely to cause confusion, to cause mistake, or to deceive.

After the Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

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 Co.*, 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 second *du Pont* factor, the similarity of the goods. It is not necessary that the goods be identical or even competitive to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such that they

² Registration No. 4166704, issued July 3, 2012.

would be encountered by the same persons in situations that would give rise, because of the marks, to a mistaken belief that they originate from the same source or that there is an association or connection between the sources of the goods. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009). It is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a class in an application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Applicant's goods are "Clothing, namely, shirts, t-shirts, sweat shirts, jackets, shorts, pants, caps, and hats; Footwear, namely, boxing, wrestling, and mixed martial arts shoes." The goods identified in the cited registration are "clothing, namely, shirts, t shirts, caps, visors, jackets." Both the application and the cited registration identify shirts, T-shirts, jackets, and caps. Therefore, we find the goods to be identical in part.

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 usual channels of trade for such goods and are available to all potential classes of purchasers, including ordinary purchasers. *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, considerations under the third and fourth *du Pont* factors, respectively. *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 Board entitled to rely on this legal presumption in determining likelihood of confusion).


In our likelihood of confusion analysis, these findings under the second, third, and fourth *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 entireties 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). We begin by noting 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) (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 entireties, 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 entirety. *In re Nat’l Data*, 224 USPQ at 751.

Registrant is entitled to protection of its mark **d t f** in any font style, case, size, or color, including a stylization that uses the font style employed by applicant, and therefore we must consider its mark as though it were depicted in such font style. *Citigroup Inc.*, 98 USPQ2d at 1258-59. We are also 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 **d t f**. Applicant’s mark is . We find D.T.F, the top and clearly the largest portion of Applicant’s mark, to be the dominant part of that mark. Given the relative sizes of the text, we do not agree with Applicant that the phrase “Down To Fight” should be treated as the dominant feature of his mark.³ We also note that the periods in Applicant’s mark have no meaningful impact distinguishing this initialism from the registered mark visually, aurally, or as to commercial impression. *Cf. Goodyear Tire & Rubber Co. v. Dayco*

³ Appeal Brief at 3.


Corp., 201 USPQ 485, 488 n.4 (TTAB 1978) (FAST-FINDER with hyphen is substantially identical to FASTFINDER); *Henry I. Siegel Co. v. Highlander, Ltd.*, 183 USPQ 496, 499 (TTAB 1974) (H.I.S. would suggest possessive form of pronoun “he” and be pronounced “his”).

The dominant part of Applicant’s mark is substantially identical to the entirety of the cited registered mark. Likelihood of confusion has been found where, as here, the entirety of one mark is incorporated within another. *See, e.g., Coca-Cola Bottling Co. of Memphis, Tenn., Inc. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) (BENGAL LANCER for club soda, quinine water and ginger ale likely to cause confusion with BENGAL for gin); *Johnson Publ’g Co. v. Int’l Dev. Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY DRUM for hairdressing products likely to cause confusion with EBONY for cosmetics).

We find that the presence of the phrase DOWN TO FIGHT does not significantly distinguish Applicant’s mark from the cited mark **d t f**. To the contrary, the registered mark could serve equally well as an initialism for the phrase “down to fight.” Applicant argues that “it is more likely that consumers would regard Registrant’s mark, ‘D T F’ as standing for an alternate and more popular ‘scandalous’ meaning to consumers familiar with the abbreviation.”⁴ Applicant, however, submitted no evidence regarding any such alternate meaning.⁵

⁴ Applicant’s Brief at 4.

⁵ In support of his argument, Applicant referenced application Serial No. 77958620. It is well-established that the Board does not take judicial notice of records residing in the Patent and Trademark Office. *See, e.g., In re Sela Prods., LLC*, 107 USPQ2d 1580, 1583 (TTAB 2013); *In re Jonathan Drew Inc.*, 97 USPQ2d 1640, 1644 n.11 (TTAB 2011); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1293 (TTAB 1986) (stating that

Considering the marks **d t f** and  as a whole, we find that they make similar overall commercial impressions. The first *du Pont* factor thus weighs in favor of a likelihood of confusion.

In view of our findings that the marks are similar and that the identified goods are identical in part and travel through the same channels of trade to the same classes of customers, we find that Applicant's mark is likely to cause confusion with the mark in cited Registration No. 4166704 when used in association with Applicant's goods.

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

“we do not take judicial notice of application and registration files that reside in the Patent and Trademark Office on the basis of their mere identification in briefs”).