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Subject: U.S. TRADEMARK APPLICATION NO. 85627251 - SOLO - 139582-00001 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85627251

MARK: SOLO



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: 4162 Doerr Road, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

139582-00001

CORRESPONDENT E-MAIL ADDRESS:

EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

The applicant has appealed the examining attorney's¹ final refusal to register the trademark SOLO for goods identified as "snowmobile, motorcycle and ATV clothing, namely, gloves, pants, shirts, boots and socks" in International Class 025 on the grounds that the applied-for mark is likely to cause confusion, mistake, or deception under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), with the mark SOLO in U.S. Registration No. 2927554 for "clothing, namely, jeans, pants, t-shirts, blouses, shorts, jackets, sweaters, coats, socks, undergarments, and hats" in International Class 025 and with the mark SOLO in U.S. Registration No. 3579672 for "footwear" in International Class 025.

STATEMENT OF THE FACTS

Applicant filed its application on May 16, 2012, seeking to register the mark SOLO in standard character format on the Principal Register for goods identified as "snowmobile, motorcycle and ATV clothing, namely, gloves, pants, shirts, boots and socks" in International Class 025. In the first Office Action dated September 12, 2012, the examining attorney refused registration under Section 2(d) on the grounds that applicant's mark, when used on the identified goods, so resembles the marks in Registration Nos. 29227554 (SOLO), 2945667 (SOLO LIMITED), and 3579672 (SOLO) as to likely cause confusion, to cause mistake, or to deceive. The examining attorney also required applicant to provide a substitute specimen because it did not show the applied-for mark used in commerce in connection with any of the goods specified in the application.

In applicant's response on March 8, 2013, applicant provided a substitute specimen and argued against the refusals to register the mark under Section 2(d) of the Trademark Act.

On March 23, 2013, the examining attorney indicated that applicant's substitute specimen satisfied the specimen requirement. The examining attorney also withdrew the refusal under Section

¹ On December 24, 2013, the application was reassigned to the undersigned examining attorney for purposes of this appeal.

2(d) of the Trademark Act as to cancelled U.S. Registration No. 2945667 (SOLO LIMITED). However, as to the likelihood of confusion refusals based on U.S. Registration Nos. 2927554 and 3579672, the examining attorney did not find applicant's arguments persuasive, and the refusals were made final.

On September 25, 2013, applicant filed a Notice of Appeal and requested reconsideration of the examining attorney's final Section 2(d) refusals. On December 11, 2013, the examining attorney reviewed applicant's request to reconsider, but maintained and continued the final refusal to register because of a likelihood of confusion with the marks in U.S. Registration Nos. 2927554 and 3579672.

This appeal now follows.

ISSUE ON APPEAL

The sole issue on appeal is whether applicant's mark, SOLO, when used on or in connection with the identified clothing goods, so resembles the marks in U.S. Registration Nos. 2927554 and 3579672 as to likely cause confusion, to cause mistake, or to deceive under Section 2(d) of the Trademark Act.

ARGUMENT

THE MARKS ARE CONFUSINGLY SIMILAR BECAUSE THE LITERAL ELEMENTS OF THE MARKS ARE IDENTICAL AND THE GOODS ARE CLOSELY RELATED SUCH THAT CONSUMERS ARE LIKELY TO BE CONFUSED OR MISTAKEN OR DECEIVED AS TO THE SOURCE OF THE GOODS UNDER SECTION 2(D) OF THE TRADEMARK ACT.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods of the applicant and registrants. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this

determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). However, not all the *du Pont* factors are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

The overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrants from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

In any likelihood of confusion determination, a two-part analysis is involved in order to determine the similarity of the marks and the similarity or relatedness of the goods. *Syndicat Des Proprietaires Viticulteurs De Chateauneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1938 (TTAB 2013) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976)); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); see TMEP §1207.01. That is, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Additionally, the goods are compared to determine whether they are similar

or commercially related or travel in the same trade channels. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §1207.01, (a)(vi).

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

I. The Marks are Confusingly Similar.

Marks are compared in their entirety for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

A. Applicant's Mark is Confusingly Similar to Both of the Registered Marks Because the Literal Elements of the Respective Marks are Identical.

In this case, the applied-for mark is SOLO in standard characters, and the registered marks are SOLO in stylized lettering (U.S. Registration No. 2927554) and SOLO in stylized lettering (U.S. Registration No. 3579672). Thus, the marks are highly similar in appearance and identical in sound. In addition, the connotation and commercial impression of the marks do not differ when considered in connection with the applicant's and registrants' respective goods. In fact, applicant stated that the

marks are “nearly identical” and never disputed the fact that the marks are similar in terms of sound, connotation, and commercial impression.² Therefore, the marks are confusingly similar.

Applicant did argue, however, that the holding in *Astra Pharmaceutical Products, Inc. v. Beckman Products, Inc.* supports a reversal of the refusal under Section 2(d). In that case, the First Circuit stated that the mere use of identical marks, even if used in the same broad industry, does not demonstrate likelihood of confusion. *See Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201 (1st Cir. 1983). However, the *Astra* ruling is not persuasive when applied to the facts in this case. In *Astra*, the Board overturned the refusal to register under Section 2(d) not based on the marks, but because the class of consumers was different. Specifically, the deciding factor was based upon the sophistication of the purchasers who were all in the medical industry. *Id.* at 1206. Here, however, the applicant’s and registrants’ goods are clothing items and would not be considered akin to the sophisticated medical goods in *Astra*. Thus, applicant’s reliance on the *Astra* holding to show that identical marks were not likely to cause confusion is inapplicable in this case, and therefore, is also insufficient to obviate the refusal under Section 2(d) or to diminish the high degree of similarity between the respective marks.

B. The Stylization of the Registered Marks Does Not Obviate the Similarity Between the Respective Marks.

Even though applicant conceded that the marks are “nearly identical,”³ applicant nonetheless argued that the stylization of the registered marks was sufficient to determine that the marks were not confusingly similar.⁴ As noted previously, applicant chose to apply for its mark in standard characters. Generally, a mark in standard characters may be displayed in any lettering style, which means that the

² *See* Applicant’s Response to First Action dated March 8, 2013, Applicant’s Request for Reconsideration dated September 25, 2013, and Applicant’s Appeal Brief dated December 13, 2013, p. 3.

³ *Id.*

⁴ *See* Applicant’s Response to First Action dated March 8, 2013, Applicant’s Request for Reconsideration dated September 25, 2013, and Applicant’s Appeal Brief dated December 13, 2013, p. 4.

rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterro Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in a stylized format generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. *See, e.g., In re Viterro Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that “the argument concerning a difference in type style is not viable where one party asserts rights in no particular display”). In this case, applicant has the freedom to display its mark in the exact same stylization as either of the registered marks. Therefore, the stylized lettering in the registered marks does not avoid a likelihood of confusion with applicant’s mark in standard characters.

C. The Marks of the Respective Parties are Confusingly Similar Despite the Fact that Other Marks Exist for Clothing that Also Contain the Term SOLO.

Applicant argued that the presence of additional registrations that use the word SOLO with regard to clothing is evidence of dilution and the fact that the applied-for mark “is merely one of a crowd of marks.”⁵ However, the dilution of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with *similar goods*. *See Nat’l Cable Television Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a

⁵ *See* Applicant’s Request for Reconsideration dated September 25, 2013 and Applicant’s Appeal Brief dated December 13, 2013, p. 9.

mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982).

Furthermore, the registrations to which applicant refers to support its dilution argument all contain other terms that serve to distinguish source among those marks.⁶ Specifically, applicant referenced the following third party registrations that use the term SOLO for Class 025 clothing: LOBO SOLO (Registration No. 4358788); KORET SOLOS (Registration No. 2925465); SOLO MODA (Registration No. 4307130); SOLO THE CAT (Registration No. 3848218); SOLO NOVE (Registration No. 3423837); and SOLOS KORET (Registration No. 2042095). In contrast to these registrations, the marks at issue in this case contain no other term to distinguish source. Rather, the entire literal element within applicant's and registrants' marks is the term "SOLO." Thus, the marks in this case are easily distinguishable from the third party registrations submitted by the applicant.

Moreover, even if applicant had established by evidence that the term SOLO is diluted, the registrants are still entitled to protection against registration by a mark with an identical literal element. In a similar case, the Board recently held that the marks ENDORPHINS and ENDORPHIN used on clothing goods were highly similar and that evidence of seven active third-party registrations incorporating the term ENDORPHINS for related goods and services was insufficient to entitle the registrant to a limited scope of protection. *See In re Adam Khatib*, Application No. 85556033, (Trademark Trial & App. Bd.

⁶ *See* Applicant's Request for Reconsideration dated September 25, 2013 and Applicant's Appeal Brief dated December 13, 2013, pp. 9-10.

January 22, 2014).⁷ The Board based its reasoning in part on the fact that none of the cited third party registrations consisted of the words ENDORPHINS or ENDORPHIN alone, but rather, had additional wording to distinguish the marks from each other. *Id.* In this case, the Board is presented with an identical situation wherein each of the marks consists of the same term, SOLO, without any additional distinguishing terms or elements that purchasers can use to distinguish between the sources of the goods. While the Trademark Trial and Appeal Board has stated that decisions designated as not precedential are not binding upon the Board, they may be cited for whatever persuasive value they might have. TBMP §101.03; TMEP §705.05.

Accordingly, because applicant has not submitted any marketplace evidence of the same or similar terms used on similar goods, the registrants' protection should not be limited based on alleged dilution. Furthermore, because the third party registrations submitted all contain additional matter to distinguish the marks from each other, the applied-for mark should not be considered part of a crowded field of marks.

In sum, because the marks of the respective parties contain the same literal element, and the stylization in the registrants' marks is insufficient to diminish the similarity between the marks, the marks are confusingly similar.

⁷ To view and print this decision, visit <http://ttabvue.uspto.gov/ttabvue/> and insert the application number specified.

Find the final decision in the prosecution history and left click on it to view it as a .pdf document.

II. The Goods are Closely Related.

When considering relatedness, the goods of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i). The respective goods need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1597 (TTAB 2011); TMEP §1207.01(a)(i).

A. The Goods of the Respective Parties are Related for Purposes of Likelihood of Confusion Because the Same Companies Produce Clothing and Sport Specific Clothing under the Same Mark.

The evidence in this case shows that applicant’s “snowmobile, motorcycle, and ATV clothing” and the registrants’ clothing (Registration No. 2927554) and footwear (Registration No. 3579672) are highly related, because they often emanate from one common entity under a single mark. The evidence made of record in the September 12, 2012 Office Action, the March 23, 2013 final Office Action, and the October 22, 2013 denial of applicant’s request for reconsideration supports this finding. For example, Harley Davidson provides both “casual” clothing and specially designed clothing used for riding motorcycles.⁸ Further, Fox Racing makes “casual” clothing for men and women including denim, shirts, boxers, socks, sweaters, and shoes in addition to specialized motocross clothing with protective

⁸ See Examining Attorney’s outgoing Office Action dated September 12, 2012, pp. 53-61.

features, including gloves, race pants, jerseys, and boots.⁹ Similarly, Ski-doo sells “casual” sportswear such as hoodies and t-shirts in addition to specially designed snowmobile clothing such as jackets, pants, gloves, socks and boots.¹⁰ Finally, Polaris, a popular ATV manufacturer, also produces “casual” clothing such as t-shirts and sweatshirts in addition to protective clothing for riding such as gloves, riding shirts, Tek Vest® chest protectors, and boots.¹¹ Moreover, the additional website evidence from Thor,¹² O’Neal,¹³ Speed and Strength,¹⁴ Alpine Stars,¹⁵ Icon,¹⁶ Answer Racing¹⁷, and Gaerne¹⁸ also show that a single entity provides “sport specific” clothing similar to applicant in addition to everyday clothing and footwear similar to both of the registrants. The submitted evidence demonstrates not only that the same entities provide both applicant’s and registrants’ goods to the same classes of consumer through the same trade channels, but also that the related goods are sold under one common brand name.

Additionally, the third party registrations of record from the USPTO’s X-search database show that applicant’s “sport specific clothing” and registrants’ clothing and “footwear” are of a kind that may emanate from a single source under a single mark.¹⁹ The examining attorney has attached the following table summarizing a representative sample of relevant third-part marks registered for use showing that applicant’s “snowmobile, motorcycle and ATV clothing” and registrants’ clothing and footwear may emanate from a single source under a single mark:

⁹ See Examining Attorney’s outgoing Final Office Action dated March 23, 2013, pp. 6-37.

¹⁰ See Examining Attorney’s outgoing Office Action dated September 12, 2012, pp. 63-76.

¹¹ See Examining Attorney’s outgoing Office Action dated September 12, 2012, pp. 77-93.

¹² See Examining Attorney’s outgoing Office Action dated September 12, 2012, pp. 11-28.

¹³ See Examining Attorney’s outgoing Office Action dated September 12, 2012, pp. 29-45.

¹⁴ See Examining Attorney’s outgoing Office Action dated September 12, 2012, pp. 46-50.

¹⁵ See Examining Attorney’s outgoing Final Office Action dated March 23, 2013, pp. 38-51.

¹⁶ See Examining Attorney’s outgoing Final Office Action dated March 23, 2013, pp. 52-60.

¹⁷ See Examining Attorney’s outgoing Final Office Action dated March 23, 2013, pp. 61-70.

¹⁸ See Examining Attorney’s outgoing Final Office Action dated March 23, 2013, pp. 70-73.

¹⁹ See Examining Attorney’s outgoing denial of Applicant’s Request for Reconsideration dated October 11, 2013, pp. 2-70.

REGISTRATION NUMBER	MARK	GOODS IN CLASS 025
2776637	HMK	Clothing; namely shirts, pants, sweaters, sweatshirts, jackets, vests, socks, hats, gloves, and mittens; and shoes and boots; namely snowmobile boots, winter boots, and shoes
3301343	RR	Outerwear, namely, parkas, jackets , vests, overcoats and snowmobile suits; Clothing , namely, coveralls, overalls, shop coats, vests, pants, shirts and boots
4159897	SABERTOOTH	Boots; Boots for motorcycling; Denim jackets; Denims; Gloves; Golf shirts; Hats; Hooded sweat shirts; Leather hats; Leather jackets; Leather pants; Leather shirts; Leather vests; Lingerie; Long-sleeved shirts; Motorcycle gloves; Motorcycle jackets; Polo shirts; Rain jackets; Shirts; Short-sleeved shirts; Sports caps and hats; Sweat pants; Sweat shirts; T-shirts; Tee shirts; Vests; Waterproof jackets and pants; Work shoes and boots
4350531	MILST R	Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps , athletic uniforms; Leather vests; Light-reflecting jackets; Motorcycle gloves; Motorcycle jackets; Reversible jackets; Waterproof jackets and pants.
4184265	DS DANIEL SMART	Gloves; Heavy jackets; Jackets; Leather jackets; Leather vests; Motorcycle gloves; Motorcycle jackets; Scarfs; Shirts; Sleeved or sleeveless jackets; T-shirts; Vests
3500046	FIERCELY AMERICAN	Clothing, namely, T-shirts, anoraks , aprons, cloth baby bibs, bandannas, jerseys, socks, shorts, pants, coats , blouses, body suits, booties, boots , boxing trunks, caps, hats, berets, sport caps, golf caps, golf hats, straw hats , visors, toques, ear-muffs, fur hats , capes, jackets , blazers, topcoats , waistcoats,

REGISTRATION NUMBER	MARK	GOODS IN CLASS 025
		<p>parkas, ponchos, coveralls, gloves, mittens, lingerie, underwear, sleepwear, namely, night shirts, nightgowns, pajamas, bath wraps, bathrobes, dressing gowns, housecoats, kimonos, robes, wraparounds and wraps, thermal underwear, neckties, neck warmers, overalls, rain ponchos, raincoats, sandals, scarves, tank tops, skirts, slacks, snow suits, snowmobile suits, leg warmers, leggings, leotards, suspenders, sweat shirts, sweatband wristlets, sweaters, sweatpants, track suits, swim pants, bikinis, swim trunks, halters, wrestling singlets, shoes, boots, athletic shoes, jogging shoes, overshoes, slip-ons, slippers, thongs, and toe rubbers, and wrist bands</p>
2930812	KRICKETS	<p>Clothing and footwear, namely, dresses, pants, hot pant sets, jackets, overalls, jumpsuits, pant suits, pants, slacks, matching pant, shorts and jacket sets, vests, diaper vests, training pants, camisoles, panties, undershirts, briefs, boxer and half boxer longs, socks, tights, pantyhose, weskits, shorts, ponchos, scarves, toques, bonnets, hats, berets, caps, rain hats, night caps, cowboy hats, sun hats, clogs, belts, suspenders, blazers, sport jackets, blouses, coveralls, jeans, jumpers, shirts, mitts, leg warmers, rain coats, camper pants, knitted shirts, skirts, sweaters, sweatshirts, parkas, car coats, duffle coats, reversible coats, ski jackets, ski slacks, ski suits, snowsuits, vests, snowmobile suits, winter boots, rain boots, shoes, sandals and slippers</p>
4355192	DRYDER	<p>Bicycle gloves; Motorcycle gloves; Motorcycle rain suits; Outdoor gloves; Rain coats; Rain suits; Riding coats; Sport coats; Sports pants; Waterproof footwear; Waterproof jackets and pants</p>
4371321	SHADOW DISTRIBUTING	<p>Clothing and motorcycle apparel, namely, jackets, pants, boots, and gloves</p>

REGISTRATION NUMBER	MARK	GOODS IN CLASS 025
4404452	EBR	Jackets; leather jackets; textile jackets; motorcycle jackets; fleece tops; sweatshirts; hooded sweatshirts; shirts; woven shirts; dress shirts; long and short sleeved t-shirts; sleeveless t-shirts; long and short-sleeved shirts; sleeveless shirts; turtle neck shirts; tank tops; moisture-wicking long and short-sleeved shirts; golf shirts; uniforms; liveries; headwear; beanies; baseball caps; hats; neck gaiters; neck tubes; scarves; motorcycle suits; leather motorcycle suits; textile motorcycle suits; motorcycle rain suits; vests; leather vests; underwear; wicking underwear tops; wicking underwear bottoms; footwear; boots; shoes; sandals; motorcycle boots; socks; wicking socks; gloves; motorcycle gloves; belts; leather belts; textile belts; pants; motorcycle pants; leather pants; textile pants; jeans

As all of the above submitted evidence clearly demonstrates, there is a relationship between applicant's "sport" clothing goods and the registrants' clothing and footwear. *See In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). Accordingly, applicant's and registrants' goods are related because they often emanate from a single source under a single mark.

B. The Differences Between Sport Clothing and Casual Clothing are Insufficient to Obviate the Relatedness of the Goods.

Applicant argues that its goods are distinct from the registrants' goods, because its products are specialized clothing items for ATV, snowboarding, and motorcycle sports enthusiasts.²⁰ Specifically,

²⁰ *See* Applicant's Response to First Action dated March 8, 2013, Applicant's Request for Reconsideration dated September 25, 2013, and Applicant's Appeal Brief dated December 13, 2013, pp. 6-8.

applicant indicates that its goods are specially designed to protect the rider and include features such as protective patches, areas to accommodate shin guards, different grips and specialized padding.²¹ However, the fact that the goods of the parties may differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source or sponsorship of those goods. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); TMEP §1207.01. Thus, because the evidence of record clearly demonstrates that the goods of the respective parties are sold by the same companies under the same mark and are therefore related, it is likely that consumers would be confused as to the *source of the goods*, even if they are not confused about the differences in the features of the goods.

To bolster its argument, the applicant relies on the holding in *In re British Bulldog*, where the Board reversed a “close call” refusal to register the design mark “PLAYERS” for men’s underwear based on a likelihood of confusion with an existing registration for the mark “PLAYERS” for shoes.²² See *In re British Bulldog*, 224 USPQ 854, 855-56 (TTAB 1984). In that case, the Board ultimately reversed the likelihood of confusion refusal because it was persuaded by applicant’s argument that a different commercial impression was created when the marks were viewed in relation to the respective goods. However, this argument is unpersuasive in the present case, because applicant does not contend that a different commercial impression is created by the marks in this case. Furthermore, each determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256

²¹ See Applicant’s Appeal Brief dated December 13, 2013, p. 5.

²² See Applicant’s Appeal Brief dated December 13, 2013, p. 6.

(Fed. Cir. 2011). As such, based on the evidence of record, it is clear that the goods of the respective parties involved in this case are, in fact, highly related.

Furthermore, the Board has found many different types of apparel to be related goods in cases adjudicated since 1985 when it decided *British Bulldog*. See, e.g., *Jockey Int'l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1236 (TTAB 1992) (underwear related to neckties); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (women's pants, blouses, shorts and jackets related to women's shoes); *In re Pix of Am., Inc.*, 225 USPQ 691, 691-92 (TTAB 1985) (women's shoes related to outer shirts).

For example, the Board held in *In re Black Star Industries, LLC* in 2014 that clothing items similar to the applicant and the registrants were in fact related. Specifically, the Board stated that the registrant's goods in that case, which included "t-shirts, sweatshirts, hats, and jackets", were "legally equivalent" in part to applicant's goods, which included "motorcycle t-shirts, motorcycle sweatshirts, motorcycle hats, and motorcycle jackets." See *In re Black Star Industries, LLC*, Application No. 77551787, 2010 TTAB LEXIS 195, at *4 (January 22, 2014);²³ see also *In re KTM-Sportmotorcycle AG*, Application No. 79019115, 2011 TTAB LEXIS 94 (March 22, 2011) (finding that a likelihood of confusion between the applied-for mark, KTM POWERWEAR, for protective motorcycle clothing and other "casual" clothing items in Class 025, and the registered mark, POWERWEAR, for "sport pants and sport clothing, namely compression pants, shirts and shorts.").²⁴ Even though the Board ultimately reversed the Section 2(d) refusal in *Black Star*, it did so based on lack of similarity between the marks, not because the goods were unrelated. *Id.* Thus, because applicant's mark is nearly identical to both of the registrants' marks, the

²³ To view and print this decision, visit <http://ttabvue.uspto.gov/ttabvue/> and insert the application number specified.

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Black Star decision is persuasive evidence that supports a finding of relatedness between applicant's "sport" clothing and the registrants' "casual" clothing and footwear.

Moreover, where the marks of the respective parties are identical or virtually identical, as is the case here, the relationship between the relevant goods need not be as close to support a finding of likelihood of confusion. See *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009); TMEP §1207.01(a).

Finally, applicant asserts that the examining attorney has not met its evidentiary burden in this case to show sufficient relatedness between the goods of the respective parties.²⁵ This argument is unpersuasive and unfounded. Specifically, the examining attorney has attached a variety of internet evidence throughout the prosecution of the case to show multiple examples of manufacturers who market clothing goods similar to that of the applicant and the registrants.²⁶ Applicant should note that evidence obtained from the Internet may be used to support a determination under Trademark Act Section 2(d) that goods are related. See, e.g., *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007). Moreover, the examining attorney also attached evidence of third-party registrations, which may have probative value to the extent that they serve to suggest that the listed goods are of a type which may emanate from a single source.²⁷ See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1983), citing *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). Accordingly, the evidence of record is substantial, and

²⁵ See Applicant's Request for Reconsideration dated September 25, 2013 and Applicant's Appeal Brief dated December 13, 2013, p. 6.

²⁶ See, generally, Examining Attorney's outgoing Office Action dated September 12, 2012 and Examining Attorney's outgoing final Office Action dated March 23, 2013.

²⁷ See, generally, and Examining Attorney's outgoing denial of Applicant's Request for Reconsideration dated October 11, 2013.

the examining attorney asserts that it has met its burden in showing that the goods of the respective parties are related.

C. The Goods of the Respective Parties Travel in the Same Channels of Trade and Are Marketed to the Same Class of Purchasers.

Applicant argues that the specialized nature of its goods (i.e. “snowmobile, motorcycle, and ATV clothing”) means that it is unlikely that the applicant’s and registrants’ products travel in the same channels of trade or share actual or potential purchasers sufficient to cause confusion.²⁸ Specifically, applicant stated that its goods are not sold at department or other casual clothing stores, but can only be purchased through its own website or through authorized dealers who specialize in selling snowmobile, motorcycle, and ATV clothing.²⁹ This argument is unpersuasive, because neither the application nor the registrations contain any limitations regarding trade channels for the goods. Therefore, based on this presumption, it is assumed that applicant’s more specialized “sport” goods and registrants’ “casual” clothing goods are sold everywhere that is normal for such items to be sold, i.e., clothing and department stores and specialty sport stores. *See In re Sun Mountain Sports, Inc.*, Application No. 74673773, 1998 TTAB LEXIS 149, at *5 (May 26, 1998) (stating that because applicant’s identified golf wear contained no limitations in the identification as to the channels of trade, the goods would therefore be sold in all normal retail channels, including chain stores, department stores, and golf specialty shops.”).³⁰

Moreover, with respect to applicant’s and registrants’ goods, the question of likelihood of confusion is determined based on the description of the goods stated in the application and registration

²⁸ See Applicant’s Appeal Brief dated December 13, 2013, pp. 6-7.

²⁹ *Id.*, at 8.

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at issue, not on extrinsic evidence of actual use. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Specifically, the Board recently held in *In re Darryl F. White* that the goods of applicant and registrant were related, because applicant's broadly identified clothing goods encompassed the registrant's more specific camping apparel. *See In re Darryl F. White*, Application No. 77201896, 2011 TTAB LEXIS 262, at *4-5 (August 26, 2011);³¹ *see also Hachette Filipacchi Presse v. Ev International, LLC*, Opposition No. 91174433 to Application No. 78545895, 2008 TTAB LEXIS 631, at *10-11 (stating that applicant's maternity wear is a subset of opposer's clothing, because opposer's registrations do not exclude this subset of clothing.).³² The Board continued by noting that "applicant's pants encompass registrant's outdoor camping pants, which are more narrowly identified inasmuch as they recite a particular purpose, namely, outdoor camping. Put another way, registrant's outdoor camping pants are a subset of applicant's more generally identified pants." *In re White*, 2011 TTAB LEXIS 262, at *4-5.

In this case, applicant's goods are recited as "Snowmobile, motorcycle and ATV clothing, namely, gloves, pants, shirts, boots and socks", and the registrants' goods are "clothing, namely, jeans, pants, t-shirts, blouses, shorts, jackets, sweaters, coats, socks, undergarments, and hats" (Registration No. 2927554) and "footwear" (Registration No. 3579672). As in *White*, the goods of the registrants are broad enough to encompass applicant's more specialized clothing items, and therefore, applicant's goods would be considered a "subset" of the registrants' more generally identified clothing and

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footwear items. *Id.* Accordingly, because the cited registrations encompass applicant's "sport clothing," the goods of the respective parties are considered related for likelihood of confusion purposes.

Finally, applicant argues that it markets its goods to an entirely different class of purchasers than both of the registrants, because it only markets to snowmobile, motorcycle, and ATV enthusiasts.³³ However, this argument is unpersuasive, because applicant is impermissibly reading limitations into both of the registrations. The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980); *see* TMEP §1207.01(a)(iii). Accordingly, because the registrations do not have any restrictions in the identification as to channels of trade or class of purchasers, the registrants' "casual" clothing and footwear could be marketed to the same consumers who are purchasing applicant's more "specialized sport" clothing and vice versa. In fact, applicant's class of consumers is merely a subset of registrants' larger class of consumers. *See In re Black Star Industries*, 2010 TTAB LEXIS 195, at *5 (stating that registrant's "general" clothing would be purchased by the same motorcyclists who would also purchase applicant's specialized motorcycle clothing.). Therefore, applicant's argument that the respective goods are marketed to a different class of consumers is incorrect.

³³ *See* Applicant's Appeal Brief dated December 13, 203, p. 7.

D. Although Applicant Claims that its Sport Clothing is Sold to a Highly Sophisticated Consumer, There is No Evidence in the Record to Demonstrate that Applicant's Products would be Sold to a Different Class of Consumers When Compared to Registrants' Products.

Applicant also argues that its clothing products are bought by “sophisticated purchasers, which undercuts any likelihood of confusion.”³⁴ Specifically, applicant states that “sophisticated consumers would not overlook the marked and distinct differences between Applicant’s specialized sport clothing and Registrants’ everyday casual clothing and footwear.”³⁵ However, this argument is unpersuasive, because as noted above, the fact that the goods of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source or sponsorship of those goods. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); TMEP §1207.01.

In addition, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Imagineering Inc. v. Van Klassens Inc.*, 53 F.3d 1260, 1265, 34 USPQ2d 1526, 1530 (Fed. Cir. 1995); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). Moreover, applicant has not submitted any evidence of record to demonstrate that individuals who enjoy motorcycling, snowboarding, or ATV sports are any more sophisticated in terms of their purchasing decisions related to clothing than the general public. *See In re Black Star Industries*, 2010 TTAB LEXIS 195, at *5 (noting that the “sophisticated purchaser argument” was a neutral factor in the decision, because applicant failed to establish as part of the record that motorcyclists are sophisticated consumers.).

³⁴ *Id.*, at 8.

³⁵ *Id.*

Ultimately, the goods in this case are related, because the evidence of record demonstrates that the goods of the respective parties are not only sold by companies under the same mark, but they are also sold in the same channels of trade to the same class of purchasers. Thus, when consumers of applicant's "snowmobile, motorcycle, and ATV clothing" encounter the registrants' clothing and footwear under nearly identical SOLO marks, they are likely to be confused as to the source of the clothing goods. Therefore, the goods of the respective parties are related.

III. Additional *du Pont* Factors Do Not Obviate a Finding of a Likelihood of Confusion.

A. Applicant's Argument that the Registered Marks are not Famous is not Dispositive to a Finding of a Likelihood of Confusion.

Applicant argues that the registered marks are not famous, and therefore, the marks should not be awarded a broad scope of protection. However, this argument is not persuasive, because the examining attorney is not expected to submit evidence regarding the fame of the cited mark in an ex parte proceeding. Accordingly, this factor is usually treated as neutral in such proceedings. *See In re Thomas*, 79 U.S.P.Q.2D 1021, 2006 TTAB LEXIS 135, at *18.n11 (TTAB 2006); TMEP §1207.01(d)(ix). Furthermore, the trademark examining attorney made no assertion that the registered marks were famous when determining the presence of a likelihood of confusion. Therefore, applicant's argument is unpersuasive, because the evidence relied upon by the examining attorney is sufficient to show, *without any allegation of fame*, that the marks are not only nearly identical, but also that the goods travel in the same channels of trade and to the same class of purchasers. Therefore, the examining attorney does not need to rely on granting a broader scope of protection to the registrants based on the "fame of the marks" in order to determine that there is a likelihood of confusion between the respective marks.

B. The Lack of Actual Confusion Does Not Obviate a Refusal Based on Likelihood of Confusion.

The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is not necessary to show actual confusion to establish a likelihood of confusion. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983)); TMEP §1207.01(d)(ii).

Applicant argues that there is no actual confusion in the marketplace, because it is not aware of any actual confusion, and the marks have peacefully coexisted for over five years.³⁶ However, an assertion that confusion has not occurred is of little probative value in a likelihood of confusion determination. In fact, the Trademark Trial and Appeal Board stated as follows:

³⁶ See Applicant's Appeal Brief dated December 13, 2013, p. 10

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an *ex parte* proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984). Applicant has provided no evidence other than its own assertion that the parties' goods have been sold together in the same locality such that confusion would be expected based on the circumstances. By contrast, the evidence of record submitted by the examining attorney clearly establishes that it is likely that the goods would travel in similar channels of trade and would be encountered by a similar class of purchasers. Accordingly, based on this evidence, purchasers are likely to be confused as to the source of the respective clothing goods offered under nearly identical SOLO marks.

Ultimately, because the marks are nearly identical, and goods of the respective parties are highly related, the remaining *du Pont* factors do not obviate the likelihood that consumers will be confused in the marketplace as to the source of applicant's and registrants' goods. Accordingly, there is a likelihood of confusion between the respective marks under Section 2(d) of the Trademark Act.

CONCLUSION

Applicant's applied-for mark, SOLO, is confusingly similar to the registrants' marks. Further, the goods of the respective parties are closely related. Moreover, the additional *du Pont* factors do not obviate the likelihood of confusion. Accordingly, because the marks are nearly identical and there is a close relationship between the goods, there is a likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). The examining attorney therefore respectfully requests that the refusal to register applicant's mark be affirmed.

Respectfully submitted,

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