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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re 4162 Doerr Road, Inc.

Serial No. 85627251

Kimberly A. Berger of Miller, Canfield, Paddock and Stone for
4162 Doerr Road, Inc.

Brin Anderson Desai, Trademark Examining Attorney, Law Office
113 (Odette Bonnet, Managing Attorney).¹

Before Quinn, Wolfson and Gorowitz,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

On May 16, 2012, 4162 Doerr Road, Inc., doing business as
Marshall Distributing, Inc., filed an application under Section
1(a) of the Trademark Act, 15 U.S.C. § 1051(a), to register the
mark **SOLO** (in standard characters) for "snowmobile, motorcycle
and ATV clothing, namely, gloves, pants, shirts, boots and
socks" in International Class 25. The application alleges first
use anywhere and first use in commerce on April 30, 2008.

¹ The above-named examining attorney did not enter an appearance in the
application until the filing of the appeal brief.

Serial No. 85627251

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark, when used for applicant's goods, so resembles two previously registered marks as to be likely to cause confusion. The marks are owned by unrelated entities. The registered marks are the mark shown below

SOLO

for "clothing, namely, jeans, pants, t-shirts, blouses, shorts, jackets, sweaters, coats, socks, undergarments, and hats" in International Class 25;² and the mark shown below



for "footwear" in International Class 25.³

When the refusals were made final, applicant appealed and requested reconsideration. The request for reconsideration was denied, and applicant and the examining attorney filed briefs.

Applicant concedes that its mark and the registered marks "are nearly identical." (Brief, p. 3). Although applicant further acknowledges that the goods "fall within the same broad

² Registration No. 2927554, issued February 22, 2005; Sections 8 and 15 affidavits accepted and acknowledged.

³ Registration No. 3579672, issued February 24, 2009. The registration includes the following statements: "The mark consists of the word 'SOLO' in stylized block lettering outlined by a single line border with ovals within the 'O' letters. Color is not claimed as a feature of the mark."

category of clothing," it goes on to contend that the goods are specifically different and travel in different trade channels, and that its goods are bought by sophisticated purchasers. Applicant also asserts that the cited marks are part of a crowded field of similar marks in the clothing field, and that there are no known instances of actual confusion. Lastly, applicant states that the cited marks are not famous. In support of its position, applicant submitted copies of six third-party registrations.

The examining attorney maintains that applicant's mark and each of the registered marks are virtually identical. Further, the examining attorney contends that applicant's "sport" clothing goods and registrants' clothing and footwear are related and move through similar trade channels. In this connection the examining attorney introduced several third-party registrations and excerpts of third-party websites to show that goods of the types involved herein may be produced and sold by the same entity under the same mark, and that these types of goods move through the same trade channels to the same classes of purchasers. The examining attorney likewise is not persuaded by applicant's other arguments.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E.*

Serial No. 85627251

I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first direct our attention to the *du Pont* factor of the similarity/dissimilarity between the marks. Applicant concedes, as indicated earlier, that its mark is "nearly identical" to each of the registered marks. Indeed, the marks are identical in sound and meaning (with the term "solo" having no particular connotation other than its ordinary meaning). As to appearance, each of the registered marks is stylized, but only minimally so, especially in the case of Registration No. 2927554. Applicant's mark is in standard characters, thus applicant is entitled to all depictions of its standard character mark regardless of the font style, size, and/or color. See *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909-10 (Fed. Cir. 2012); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011). As to the mark shown in Registration No. 3579672, the stylized design of the letters does not form a separate commercial impression apart from the literal portion that is identical to the applied-for mark. Accordingly, the marks must be considered to be very similar in

appearance. In view of the identity in sound and meaning, and the similarity in appearance, the marks engender essentially identical overall commercial impressions.

The near identity between applicant's mark and each of the registered marks, as conceded by applicant, weighs heavily in favor of a finding of a likelihood of confusion.

We next turn our focus to the second *du Pont* factor involving the similarity/dissimilarity between the goods. We make our determination regarding the similarities between the goods, channels of trade and classes of purchasers based on the goods as they are identified in the application and registration, respectively. *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); and *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011). Applicant's identification of goods reads "snowmobile, motorcycle and ATV clothing, namely, gloves, pants, shirts, boots and socks." One registrant's identification reads "clothing, namely, jeans, pants, t-shirts, blouses, shorts, jackets, sweaters, coats, socks, undergarments, and hats," and the other registrant's identification is for "footwear."

It is not necessary that the respective goods be identical or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods are related in some manner,

Serial No. 85627251

and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originated from the same producer. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991). As found above, the marks are nearly identical. "[T]he greater degree of similarity between the applicant's mark and the cited registered mark, the lesser the degree of similarity between the applicant's goods or services and the registrant's goods or services that is required to support a finding of likelihood of confusion." *Time Warner Entertainment Co. L.P. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002). The issue here, of course, is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of these goods. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

The examining attorney introduced several use-based third-party registrations showing that the same entity has registered the same mark for both motorsport clothing and/or motorsport footwear on the one hand, and casual clothing and/or casual footwear on the other. (Exhibits to Office action, Oct. 11, 2013). A representative sample follows:

- Reg. No. 2776637 for the mark HMK for "clothing; namely shirts, pants, sweaters, sweatshirts, jackets, vests,

socks, hats, gloves, and mittens; and shoes and boots; namely snowmobile boots, winter boots, and shoes";

- Reg. No. 2930812 for the mark KRICKETS for "dresses, jackets, pants, slacks, snowmobile suits, winter boots, shoes, sandals";
- Reg. No. 3301343 for the mark RR and design for "outerwear, namely, parkas, jackets, vests, overcoats and snowmobile suits; clothing, namely, coveralls, overalls, shop coats, vests, pants, shirts and boots";
- Reg. No. 4159897 for the mark SABERTOOTH for "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"; and
- Reg. No. 4184265 for the mark DS DANIEL SMART and design for "gloves; heavy jackets; jackets; leather jackets; leather vests; motorcycle gloves; motorcycle jackets; scarfs; shirts; sleeved or sleeveless jackets; t-shirts; vests."

"Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may

Serial No. 85627251

nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source." *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd*, 864 F.2d 149 (Fed. Cir. 1988). See also *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

The evidence of record includes excerpts of third-party websites showing that certain manufacturers produce both motorsport clothing and/or motorsport footwear, and casual clothing and/or casual footwear under a common mark. The examples include Harley Davidson, Thor, Polaris, Speed and Strength, O'Neal, Fox Racing, Alpine Stars, Icon, Answer Racing and Ski-doo. (Exhibits to Office actions, Sep. 7, 2012 and Mar. 23, 2013).

In view of the above, we find that applicant's goods are related to the goods of each registrant. The evidence also shows that the goods travel in similar trade channels (e.g., online retailers) to the same classes of ordinary purchasers. These factors involving the similarity between applicant's goods and each registrant's goods weigh in favor of finding a likelihood of confusion.

In addition to the key *du Pont* factors discussed above, there are additional factors to consider in this case. Applicant has submitted six third-party registrations for marks

Serial No. 85627251

that include the term "SOLO," all for clothing. The marks are as follows: SOLOS KORET (Reg. No. 2042095); KORET SOLOS (Reg. No. 2925465); SOLO NOVE (Reg. No. 3423837); SOLO THE CAT (Reg. No. 3848218); SOLO MODA (MODA disclaimed) (Reg. No. 4307130); and LOBO SOLO (Reg. No. 4358788).

Although we have considered applicant's evidence of the third-party registrations, it is of limited probative value to support applicant's position because "[t]he existence of [third-party] registrations is not evidence of what happens in the marketplace or that consumers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive." *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010). In any event, none of these registrations is as close in sound, appearance, meaning and commercial impression to each of the cited registered marks as is applicant's applied-for mark. We find this factor to be neutral.

Applicant contends that purchasers of its goods are sophisticated when it comes to buying applicant's clothing. There is nothing in the respective identifications of goods that warrants a finding that consumers of either applicant's or registrants' goods would make a careful purchasing decision.

Serial No. 85627251

There are no price restrictions in the identifications, and we must assume that the respective goods include relatively inexpensive items. However, even assuming that applicant's and/or either registrant's goods may involve a careful purchase, it is settled that even sophisticated purchasers are not immune from source confusion, especially in cases such as the instant one involving very similar marks and legally identical goods. See *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers...are not infallible."). See also *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). We find that the near identity between the marks and the similarity between the goods sold thereunder outweigh any presumed sophisticated purchasing decision. See *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods). In view thereof, we find this factor to be neutral.

Applicant states, through its counsel, that it is unaware of any actual confusion with the cited marks despite five years of contemporaneous use. Applicant's assertion, in this *ex parte*

proceeding, is entitled to little weight. See *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) (“uncorroborated statements of no known instances of actual confusion are of little evidentiary value”). See also *In re Bisset-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973) (stating that testimony of applicant’s corporate president’s unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009); *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1588 (TTAB 2007); *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984). In any event, the record is devoid of evidence relating to the extent of use of applicant’s and registrants’ marks and, thus, whether there have been meaningful opportunities for instances of actual confusion to have occurred in the marketplace. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000). Accordingly, the *du Pont* factor of the length of time during and conditions under which there has been contemporaneous use of the marks without evidence of actual confusion is considered neutral.

Applicant also makes the argument that the cited marks are not famous. We simply reiterate what the Board has stated in the past on this point: “It appears that applicant contends that the absence of evidence of fame of the registrant’s mark

Serial No. 85627251

should be treated as a factor in applicant's favor. Because this is an ex parte proceeding, we would not expect the examining attorney to submit evidence of fame of the cited mark. This *du Pont* factor, as is normally the case in ex parte proceedings, must be treated as neutral." *In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006). See TMEP § 1207.01(d)(ix) (April 2014).

We have carefully considered all of the evidence made of record pertaining to the issue of likelihood of confusion, as well as all of the arguments related thereto, including any evidence and arguments not specifically discussed in this opinion. We conclude that purchasers familiar with registrant's "clothing, namely, jeans, pants, t-shirts, blouses, shorts, jackets, sweaters, coats, socks, undergarments, and hats" sold under the mark SOLO (stylized), or registrant's "footwear" sold under the mark SOLO (stylized), would be likely to mistakenly believe, upon encountering applicant's mark SOLO for "snowmobile, motorcycle and ATV clothing, namely, gloves, pants, shirts, boots and socks," that the goods originated from or are associated with or sponsored by the same entity.

Decision: The refusals to register are affirmed.