

This Opinion is Not a
Precedent of the TTAB

Mailed: December 12, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Kenneth T. Riddleberger

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Serial Nos. 85632364 and 85637348¹

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Matthew H. Swyers of The Trademark Company PLLC,
for Kenneth T. Riddleberger.

Susan B. Allen, Acting Senior Attorney, Law Office 101,
Ronald R. Sussman, Managing Attorney.

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Before Zervas, Lykos and Adlin,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Kenneth T. Riddleberger (“Applicant”) seeks registration on the Principal Register of the marks **8UP**² and **8UPSPORTS**,³ both in standard character format

¹ Because the Board deems the cases to have common questions of fact and of law, and the records are largely identical, the appeals are hereby consolidated. *See, e.g., In re Anderson*, 101 USPQ2d 1912, 1915 (TTAB 2012) (Board *sua sponte* consolidated two appeals).

² Application Serial No. 85637348, filed May 29, 2012, pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging January 1, 2009 as the date of first use anywhere and April 11, 2009 as the date of first use in commerce.

³ Application Serial No. 85632364, filed May 22, 2012, pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging January 5, 2009 as the date of first use anywhere and April 11, 2009 as the date of first use in commerce. The application includes a statement that “The word(s) ‘8UPSPORTS’ has no meaning in a foreign language.”

for, as amended, “Coats, t-shirts, head wear, long sleeve t-shirts, short sleeve shirts, tank tops, sports bras, sweatshirts, sweatpants, thongs, hoods, pants, jeans, shorts, bathing suits, hats, caps, balaclavas, socks, sweatbands, wrist bands, head bands, jackets, cloth bibs, chaps, cowboy hats, belts, underwear, boxers, pajamas, lingerie, rain jackets, rain pants, polo shirts, sweaters, vests, jerseys, gloves, scarves, shoes, flip flops, sandals, outerwear, namely, ponchos, face coverings, namely, knit face masks, wetsuits, booties, sun glasses, backpacks, dress shirts, jock straps, athletic uniforms, footwear, cleats, golf shoes, skirts, blouses” in International Class 25.

In each application, Applicant claimed ownership of a Supplemental Register registration for the mark displayed at right, for “Coats, t-shirts, head wear, long sleeve t-shirts, short sleeve shirts, tank tops, sports bra, sweatshirts, sweatpants, thongs,



hoods, pants, jeans, slacks, shorts, bathing suits, hats, caps, skull caps, balaclavas, socks, sweatbands, wrist bands, head bands, jackets, cloth bibs, belt, underwear, boxers, pajamas, lingerie, rain jacket, rain pants, polo shirt, sweater, vest, jerseys, gloves, scarves” in International Class 25.⁴

During *ex parte* prosecution of the applications, in response to the Trademark Examining Attorney’s inquiry regarding the meaning of the term “8UP,” Applicant

⁴ Registration No. 4103259, issued on February 21, 2012, alleging October 5, 2010 as the date of first use anywhere and February 10, 2011 as the date of first use in commerce. The description of the mark is as follows: “The mark consists of the number "8" with a face in the upper portion and the letters "UP" in the lower portion.” Color is not claimed as a feature of the mark.

responded that the term had no significance in relation to the identified goods, nor any meaning in a foreign language.

Registration was refused under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that Applicant's applied-for marks so resemble the following two registered marks owned by two different individuals, that, when used on or in connection with Applicant's identified goods, it is likely to cause confusion or mistake or to deceive:

Registration No. 3777317 issued April 20, 2010, owned by Ralph Calebrese, for the mark displayed below on the Principal Register



for "Clothing, namely, T-shirts, Hats, Visors, Beanies, Sweatshirts, Hooded Sweatshirts, Coats, Jackets, Gloves, Jeans, Polo shirts, Long sleeve T-shirts, Wind Breakers, Sock Hats, Sweat Bands, Socks, Shorts, Button up Shirts, Scarves, Sandals, Pants, Sweats, Tank Tops, Ski Mask, Skirts, Underwear, Under Garments, Belts" in International Class 25 with a disclaimer of the word "APPAREL"; and

Registration No. 3905603 issued January 11, 2011, owned by Casey Baldwin for the mark displayed below on the Principal Register



for "Sweat shirts; Swim wear; T-shirts" in International Class 25, with a disclaimer of "CLOTHING."

When the refusals were made final, Applicant appealed. For the reasons set forth below, we affirm the refusals to register.

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”). See also *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, 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 (CCPA 1976). These factors, and the other relevant *du Pont* factors, are discussed below.

I. *Goods/Trade Channels/Purchasers*

We first consider the goods as they are identified in the involved applications and cited registrations, as well as the similarity or dissimilarity of established, likely to continue trade channels. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) and *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). It is undisputed that the involved applications and cited registrations involve goods that are identical, at least in part as to “t-shirts” and “sweatshirts.” Because the goods are legally identical in part, and neither registration nor the involved applications contain any limitations on the

channels of trade and classes of purchasers, we must presume that the channels of trade and classes of purchasers are also the same. *See Stone Lion*, 110 USPQ2d at 1161; *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion). We further note that the Trademark Examining Attorney submitted evidence that clothing items of this type are typically sold in department stores, such as Dillards or Nordstrom or via online retailers. Thus, the in part identical nature of the goods and legal presumptions regarding the channels of trade and purchasers weigh in favor of finding a likelihood of confusion.

II. *The Marks*

Next we turn to the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). “The 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) (“*Coach Servs. Inc.*”).

Consistent with these principles, we observe that both Applicant’s and Registrants’ marks are comprised, either in whole or in part, of the numerical and literal phrase “8UP” and/or its phonetic equivalent “ATE UP.” Indeed, this phrase is the lead portion of each mark, making it the dominant feature. *See Palm Bay Imports Inc.*, 73 USPQ2d at 1692 (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “Veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word).

Our analysis however 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.”). Consistent with this principle, we observe the distinctions in terms of wording, namely the presence of the descriptive term “sports” in Applicant’s mark **8UPSPORTS** and “apparel” and “clothing” in each of the cited marks, respectively. It is well established, however, that descriptive or generic terms such as these are typically less significant or less dominant when

comparing marks. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997). As such, prospective consumers are more likely to focus on the shared term “8UP” when encountering the marks.

We further acknowledge the stylized wording and presence of design elements in Registrants’ marks. Nonetheless, it is more likely that prospective consumers will overlook these distinctions and instead confuse the marks as originating from the same source, given that they either contain or consist solely of the literal element “8UP” or the phonetic equivalent thereof. It is well established that when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser’s memory and to be used in calling for the services; therefore, the word portion is normally accorded greater weight in determining whether marks are confusingly similar. *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999). *See also CBS Inc. v. Morrow*, 708 F. 2d 1579, 218 USPQ 198, 200 (Fed. Cir 1983); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267-68 (TTAB 2011).

In addition, because Applicant applied to register his marks in standard character form, Applicant’s’ marks, if registered, could potentially be used in any stylized display or color scheme, including one that is identical to that used by either Registrant. *See Trademark Rule 2.52(a)*. That is to say, if Applicant’s mark were registered, Applicant would have the right to use his standard character marks **8UP** and **8UPSPORTS** in the same stylized font, size and shades of color as depicted in each of the registered marks.

Applicant contends that the Office acted inconsistently in permitting registration of the two cited marks and not permitting the registrations of Applicant's marks. This argument is not persuasive because we are not privy to the record of the prior registrations and are bound to make a decision based on the record before us. *See AMF Inc. v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (CCPA 1973); *In re International Taste, Inc.*, 53 USPQ2d 1604 (TTAB 2000); and *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994).

We therefore agree with the Examining Attorney's determination that Applicant's mark is similar in sound, appearance, connotation, and commercial impression to the registered marks. This *du Pont* factor also weighs in favor of finding a likelihood of confusion.

III. *Lack of Actual Confusion*

Applicant contends that it is unaware of any instances of actual confusion. However, "[t]he fact that an applicant in an ex parte case is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis, inasmuch as the Board in such cases generally has no way to know whether the registrant likewise is unaware of any instances of actual confusion...." *In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001). Furthermore, there is no evidence that the nature and extent of Applicant's and Registrants' actual use of their marks in the marketplace, including the extent of any geographical overlap, has been so substantial so as to render the apparent absence of actual confusion legally significant. *See In re Thomas*, 79 USPQ2d 1021,

1028 (TTAB 2006); *In re Continental Graphics Corp.*, 52 USPQ2d 1377 (TTAB 1999); *Gillette Canada, Inc. v. Ranir*, 23 USPQ2d 1768 (TTAB 1992). We therefore find that this *du Pont* factor is neutral.

To the extent that there are any other relevant *du Pont* factors, we treat them as neutral.

IV. *Conclusion*

After considering all of the evidence of record and arguments pertaining to the *du Pont* likelihood of confusion factors, we find that the Trademark Examining Attorney has carried the Office's burden of showing a likelihood of confusion between Applicant's marks and the cited registered marks.

Decision: The Section 2(d) refusals to register Applicant's marks are affirmed.