

**This Opinion is Not a
Precedent of the TTAB**

Mailed: July 22, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Vincent Monfredo
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Serial No. 85667426
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Luke Brean of BreanLaw, LLC,
for Vincent Monfredo.

Alain J. Lapter, Trademark Examining Attorney, Law Office 105,
Susan C. Hayash, Managing Attorney.

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Before Bergsman, Lykos, and Hightower,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

Vincent Monfredo (“Applicant”) seeks registration on the Principal Register of the following mark, with AMERICA disclaimed, for “Baseball caps and hats; sweatshirts; t-shirts” in International Class 25:¹



¹ Application Serial No. 85667426, filed July 2, 2012, based on Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Specifically, registration has been refused on the ground that Applicant's mark, as applied to the goods identified in the application, so resembles the mark SECOND II NONE, previously registered in standard characters on the Principal Register for "Baseball caps; caps; shirts; sweat shirts" in International Class 25,² as to be likely to cause confusion, to cause mistake, or to deceive.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

I. Analysis

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 Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, 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.").

² Registration No. 3773474, issued April 6, 2010.

We first address the similarity of the goods and channels of trade, the second and third *du Pont* factors, respectively. Applicant's Class 25 goods are "Baseball caps and hats; Sweatshirts; T-shirts." The goods recited in the cited registration are "Baseball caps; caps; shirts; sweat shirts." We find that Applicant's goods and registrant's goods are, in part, identical. The goods of both include baseball caps and sweatshirts. Applicant's T-shirts are a subset of the broader "shirts" identified in the cited registration. Registrant's "caps" are a subset of Applicant's "hats."

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 registrant's goods move in all normal channels of trade for such goods and are available to all potential classes of ordinary consumers. *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); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Moreover, because the baseball caps, shirts, and sweatshirts 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. *See American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *see also In re Viterra 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 and third *du Pont* factors strongly support a conclusion that confusion is likely.

We turn next to the *du Pont* likelihood of confusion factor focusing on “the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “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) (citation omitted).

Because the similarity or dissimilarity of the marks is determined on the marks in their entirety, 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. 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).

The cited mark is SECOND II NONE, while Applicant's mark is:



with AMERICA disclaimed.

Applicant directed the entirety of his appeal brief to the first *du Pont* factor, arguing that his mark differs from the cited mark in sight, sound, and commercial impression, and that there is no prohibition against marks sharing a common term. Applicant emphasizes the addition of the initial term AMERICA to his mark, and argues that the Trademark Examining Attorney improperly dismissed the design elements of his mark.

We do not find that the use of the phonetic equivalents of the Roman numeral II (in registrant's mark) and preposition TO (in Applicant's mark) serves to significantly distinguish the marks, particularly with respect to sound and overall commercial impression. The presence in Applicant's mark of the term AMERICA and the eagle silhouette, however, presents a closer question.

On the one hand, AMERICA is disclaimed from Applicant's mark and may be geographically descriptive in association with his goods, given that Applicant is an individual from New York. It is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. *See Cunningham v.*

Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re Nat’l Data*, 224 USPQ at 752); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

On the other hand, AMERICA is the first and largest word in Applicant’s mark, increasing its prominence and lessening its similarity to the cited registered mark. *See, e.g., Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (stating that consumers will first notice the identical lead word on encountering the marks); *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (stating that “it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”). For marks consisting of words and a design, the words are normally given greater weight because they would be used by consumers to request the goods or services. *See Productos Lacteos Tocumbo S.A. de C.V. v. Paletteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011); *M.C.I. Foods Inc. v. Bunte*, 96 USPQ2d 1544, 1551 (TTAB 2010). Here, however, the design depicts the silhouette of an eagle’s head, reinforcing the significance of the disclaimed term AMERICA. We agree with Applicant that the overall commercial impression of his

mark thus conveys a patriotic message that is absent from the cited registered mark
SECOND II NONE.

Nonetheless, we are 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.*, 23 USPQ2d at 1700; *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007). Applicant’s mark, moreover, essentially incorporates the phonetic equivalent of Registrant’s entire mark. While we agree with Applicant that “[t]here is no explicit rule that likelihood of confusion *automatically* applies where a junior user’s mark contains in part the whole of another mark,”³ here, the fact that the cited registered mark (or its phonetic equivalent) is subsumed by Applicant’s mark increases the similarity between the two. *See, e.g., Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design for men’s cologne, hair spray, conditioner and shampoo likely to cause confusion with CONCEPT for cold permanent wave lotion and neutralizer); *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558, 559 (CCPA 1972) (WEST POINT PEPPERELL and griffin design for fabrics and linens is likely to cause confusion with WEST POINT for woolen piece goods); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (VANTAGE TITAN confusingly similar to TITAN for medical diagnostic apparatus); *In re Riddle*, 225 USPQ 630, 632 (TTAB 1985) (RICHARD PETTY’S ACCU TUNE for automotive service centers confusingly

³ Appeal Brief at 3, 7 TTABVUE 4.

similar to ACCU-TUNE for automotive testing equipment). In this regard, consumers may mistakenly believe that the mark in the cited registration, SECOND II NONE, is a shortened version of Applicant's mark.

For all of the reasons discussed above, we find Applicant's mark to be similar in sight, sound, meaning, and overall commercial impression to the cited mark SECOND II NONE. Therefore, the first *du Pont* factor supports a conclusion that confusion is likely.

We have considered the evidence of record as it pertains to the relevant *du Pont* factors. To the extent that any other *du Pont* factors for which no evidence was presented by Applicant or the Trademark Examining Attorney may nonetheless be applicable, we treat them as neutral. In view of our findings that the marks are similar and the goods are in part identical and move in the same channels of trade and to the same customers, we find that Applicant's mark is likely to cause confusion with the mark in cited Registration No. 3773474 when used in association with Applicant's goods.

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