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Subject: U.S. TRADEMARK APPLICATION NO. 85864264 - GET CENSORED - 13#626 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85864264 MARK: GET CENSORED	
CORRESPONDENT ADDRESS: ANDREW LAHSER LAW OFFICE OF ANDREW P LAHSER PLC 16824 E AVENUE OF THE FOUNTAINS STE 14 FOUNTAIN HILLS, AZ 85268-8408	GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp TTAB INFORMATION: http://www.uspto.gov/trademarks/process/appeal/index.jsp
APPLICANT: Shanon Preston	
CORRESPONDENT'S REFERENCE/DOCKET NO: 13#626 CORRESPONDENT E-MAIL ADDRESS: docket@lahserpatent.com	

EXAMINING ATTORNEY'S APPEAL BRIEF

The Applicant, Shanon Preston, has appealed the Examining Attorney's refusal to register the mark GET CENSORED, stylized and with design elements, under Section 2(d) of the

Trademark Act of 1946 (as amended) (hereinafter “the Trademark Act”), 15 U.S.C. §1052(d). This refusal is the only issue on appeal.

FACTS

On March 1, 2013, Applicant filed an intent-to-use application for the mark GET CENSORED, stylized and with design elements, for goods identified as: “*Hats; Jackets; Pants; Rash guards; Shirts; Shorts; Sleepwear; Sports bra; Sweat pants; Sweat shirts; Swim wear; T-shirts; Tops; Underwear; Yoga pants*” in International Class 25.

In an Office action dated June 21, 2013, the Examining Attorney refused registration under Section 2(d) of the Trademark Act, based on a likelihood of confusion with the marks in U.S. Registration Nos. 3279611 and 4144833, for the marks SINSORED and CENSORED, respectively, both of which are registered for clothing, including items of clothing identical to those listed in the application. The Examining Attorney also required that applicant amend the description of the mark, which used ambiguous wording and did not clearly describe all features of the mark.

On December 23, 2013, Applicant responded to the Office action and presented arguments against a likelihood of confusion with the cited registrations. Applicant’s response also satisfied the requirement pertaining to the description of the mark. On January 10, 2014, the Examining Attorney withdrew the refusal in part, as to U.S. Registration No. 3279611, and continued and made final the refusal of registration with respect to U.S. Registration No. 4144833. On August 19, 2014, a Notice of Abandonment was mailed to Applicant indicating that the application was abandoned for Applicant’s failure to file a timely response to the January 10, 2014 final Office action. On September 12, 2014, Applicant filed a petition to revive the application, which was granted on September 25, 2014. Applicant’s petition included a request

for reconsideration and a Notice of Appeal. Applicant's request for reconsideration included an amendment to the identification of goods, such that it now reads as follows: "*Clothing sold only through owner's online store, namely, hats, jackets, pants, rash guards, shirts, shorts, sleepwear, sports bra, sweat pants, sweat shirts, swim wear, t-shirts, tops, underwear, and yoga pants*" in International Class 25.

On October 8, 2014, the Examining Attorney denied Applicant's request for reconsideration, and on December 15, 2014, Applicant filed an Appeal Brief.

ISSUE ON APPEAL

Whether Applicant's use of the mark GET CENSORED, stylized and with minimal design elements, for "*Clothing sold only through owner's online store, namely, hats, jackets, pants, rash guards, shirts, shorts, sleepwear, sports bra, sweat pants, sweat shirts, swim wear, t-shirts, tops, underwear, and yoga pants*" in International Class 25 creates a likelihood of confusion with U.S. Registration No. 4144833 for the mark CENSORED, in standard characters, for "*Clothing, namely, long trousers, jeans, pants, slacks, short trousers, shorts, boxer shorts, 3/4 length trousers, slacks with strap under foot, culottes, blouses, dresses, sweaters, shirts, short-sleeved shirts, T-shirts, long-sleeved shirts, socks; footwear, headgear, namely, hats, caps, head kerchiefs; outerwear for gentlemen and ladies, namely, waistcoats, jackets, denim jackets, coats, tunics, blazers, lounging jackets, bomber jackets, overalls, dungarees; underwear; undergarments; belts, scarves, gloves, bathing fashion for gentlemen and ladies, namely, beachwear, swim wear, bathing suits, swimsuits and bathing trunks; leisure and city shoes for gentlemen and ladies*" in International Class 25.

LIKELIHOOD OF CONFUSION ANALYSIS

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 registrant. *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)). Not all the *du Pont* factors, however, 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.

In this case, the factors that are the most relevant are the similarity of the marks and the similarity and nature 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).

ARGUMENT

1. APPLICANT'S GOODS OVERLAP WITH REGISTRANT'S GOODS SIGNIFICANTLY AND ARE OTHERWISE CLOSELY RELATED

Applicant's identification of goods, as amended, reads as follows (emphasis added to show terms that are identical to, or overlap with, Registrant's identification):

Class 25:

Clothing sold only through owner's online store, namely, hats, jackets, pants, rash guards,¹ shirts, shorts, sleepwear, sports bra, sweat pants, sweat shirts, swim wear, t-shirts, tops, underwear, and yoga pants;

The identification of goods in U.S. Registration No. 4144833 reads as follows (emphasis added to show terms that are identical to, or overlap with, Applicant's identification):

Class 25:

Clothing, namely, long trousers, jeans, pants, slacks, short trousers, shorts, boxer shorts, 3/4 length trousers, slacks with strap under foot, culottes, blouses, dresses, sweaters, shirts, short-sleeved shirts, T-shirts, long-sleeved shirts, socks; footwear, headgear, namely, hats, caps, head kerchiefs; outerwear for gentlemen and ladies, namely, waistcoats, jackets, denim jackets, coats, tunics, blazers, lounging jackets, bomber jackets, overalls, dungarees; underwear; undergarments; belts, scarves, gloves, bathing fashion for gentlemen and ladies, namely, beachwear, swim wear, bathing suits, swimsuits and bathing trunks; leisure and city shoes for gentlemen and ladies;

Thus, each item of apparel in Applicant's identification is either identical to, encompassed by, or encompasses wording in Registrant's identification, while the evidence discussed below shows that the other apparel items in the registration are also closely related to Applicant's goods. Specifically, the following items of apparel appear in both identifications using identical wording: *Hats, jackets, pants, shirts, shorts, swim wear, t-shirts, and underwear.*

However, 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

¹ “Rash guards,” as shown by the evidence of record from the J.CREW and ROXY websites (attached to the January 10, 2014 Office action), are a type of shirt, and therefore encompassed by Registrant's wording “shirts.”

public as to the origin of the goods.”). 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)).

In this case, the identification set forth in the application has a limitation as to the trade channels – namely, that the goods are “sold only through owner's online store” – but otherwise contains no limitation as to the nature, type, or classes of purchasers, while the registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Because the registration contains no limitations, it is presumed that these goods “travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Further, in addition to the identical wording listed above, the application and registration each use broad wording to describe the goods and this wording is presumed to encompass all goods of the type described, including the narrower terms also listed in the registration and application, respectively. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)).

Because each item in Applicant’s identification is either identical to, encompassed by, or encompasses wording in Registrant’s identification, a likelihood of confusion is demonstrated even in the absence of evidence. However, the previously-attached Internet evidence consists of online retail stores showing the following marks applied to goods like those of Applicant offered

through the same type of trade channel as Applicant's goods, as well as many of the same types of apparel as listed in the cited registration:

- BROOKS BROTHERS
- BCBGMAXAZRIA
- EXPRESS
- FOREVER 21
- J. CREW
- RAG & BONE
- ROXY
- TORY BURCH

This evidence establishes that the same entity commonly manufactures the relevant goods and markets the goods under the same mark.

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).

Additionally, the Examining Attorney has attached the following third-party registrations from the Office's X-Search database, which constitute a representative sample of third-party marks registered for use in connection with the same or similar goods as those of both applicant and registrant in this case:

Registration No.	Mark
3053930	LOYALE
3098239	ROCKSMITH
3153210	CARASAN
3307974	SURFING CAPITOL OF THE WORLD
3359783	[design only]

Registration No.	Mark
3448095	COCKY ATHLETICS
3711968	GROUNDSKILLZ
3899150	CAT EYES! [+ design]
3974924	CAULFIELD PREP.
3984928	[design only]
4048018	ISABEL ARDEE
4058835	BELIEVE, STRIVE, CONQUER
4121602	FEARLESS FIGHTING FEMALES [+ design]
4175352	REI [+ design]
4204775	GRACE CHEN
4335338	MAKING THE WORLD A BETTER PLACE ONE BURRITO AT A TIME
4342996	NEO BURRITO
4353697	REPOP
4353847	PARIDES
4354161	JEN KAO
4355559	BE [stylized]
4355728	MIAMI GIRL

This evidence shows that the goods listed therein, including many of the specific clothing items listed in Applicant's and Registrant's identifications, are of a kind that may emanate from a single source under a single mark. *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).

In light of the foregoing, Applicant's and Registrant's identifications of goods are identical in part, overlap significantly, and are otherwise closely related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

2. THE APPLIED-FOR MARK INCORPORATES REGISTRANT'S MARK IN ITS ENTIRETY AND IS OTHERWISE HIGHLY SIMILAR TO REGISTRANT'S MARK

The mark in U.S. Registration No. 4144833 is CENSORED, in standard characters.

The applied-for mark is GET CENSORED, stylized and with the wording "CENSORED" presented prominently in the mark, within a rectangle carrier design, while the wording "GET" appears in a significantly smaller font in the upper-left corner of the mark.

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)).

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810,

1813 (TTAB 2014). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012).

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. See *In re Nat'l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751.

In the present case, the stylization of the applied-for mark presents the word CENSORED in a significantly larger font size than the wording GET, while the rectangular carrier design surrounds the word CENSORED, emphasizing its prominence in the mark. Additionally, the word CENSORED is presented in a bold, uppercase stylization, unlike the word GET, which is presented in a thinner, lowercase stylization at the periphery of the mark. Depending on the size and presentation of the mark on the goods, for example on a small hangtag or label, the word "GET" might even be completely overlooked by a consumer. Based on the foregoing, the Examining Attorney has determined that the wording CENSORED is therefore more significant or dominant in creating a commercial impression, and that it is thus the term most likely to be remembered by a consumer retaining only a general impression of the mark.

Because the registered mark is CENSORED (in standard characters), applicant has essentially incorporated the entire registered mark into the applied-for mark, presenting that wording as the dominant feature in the mark. Incorporating the entirety of one mark within

another does not obviate the similarity between the compared marks, nor does the addition of other terms or designs necessarily overcome a likelihood of confusion under Section 2(d). *See Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 1022, 194 USPQ 419, 422 (C.C.P.A. 1977) (finding CALIFORNIA CONCEPT and surfer design and CONCEPT confusingly similar); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar); *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2D 1651, 1660-61 (TTAB 2014) (finding PRECISION and PRECISION DISTRIBUTION CONTROL confusingly similar). In the present case, the marks are identical in part.

Furthermore, where the goods of an applicant and registrant are identical or virtually identical, as in the present case, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods. *See United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014) (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)).

In light of the foregoing, the marks are confusingly similar in sound, appearance, connotation, and commercial impression.

3. APPLICANT'S ARGUMENTS AND EVIDENCE ARE NOT PERSUASIVE

Registrant's Identification Encompasses All Normal Channels of Trade, Including Applicant's Narrower Trade Channels

Applicant's principal argument, as shown by Applicant's statement of the issue, which asks whether the respective trade channels are "sufficiently distinct,"² is that the limitation of trade channels in Applicant's amended identification of goods suffices to avoid a likelihood of confusion. However, as discussed above in this Brief, the identification of goods in the cited registration contains no limitation as to trade channels, and therefore the goods can be presumed to travel in all normal trade channels for such goods, including online retail stores like that of the Applicant. As the Board has recently emphasized, when an applicant's identification is limited to a particular channel of trade or class of purchasers, but the identification in the cited registration has no such limitation, then it can be presumed that the registration's broader identification encompasses any normal channels of trade for those goods or services, including those in the narrower identification. *See In re Midwest Gaming & Entertainment LLC*, 106 USPQ2d 1163, 1165-66 (TTAB 2013) ("[A]lthough applicant has limited its trade channels to casinos and its purchasers presumably to casino patrons, registrant's unrestricted registration encompasses bar services rendered in a casino setting to casino patrons."); *see also Kangol Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992) (specific to clothing); *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994) (same).

In the present case, Applicant's identification does not explicitly indicate that Applicant's "online store" excludes the goods of others, so based on the identification of goods in the application and registration, the wording in the registration encompasses goods sold in online

² Applicant's statement of the issue reads as follows (emphasis in original): "*Under what circumstances have trademarks been found to travel in sufficiently distinct channels of trade to support a finding of **no likelihood of confusion when used on similar marks** [sic]?"*

retail stores, including Applicant's store. While Applicant's Brief states that the online store "only include[s] Applicant's products, to the exclusion of all others," this limitation must be present in the identification of goods in order for it to have legal effect. *See In re Pix of America, Inc.*, 225 USPQ at 691 (citing *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973)).

Furthermore, even if Applicant were to further amend the identification of goods to indicate that Applicant's online store does not sell the goods of others, there would still be a likelihood of confusion since these goods are closely related and could still be offered in the same *type* of trade channels. Even where an applicant and registrant are incapable of offering their goods and/or services in the exact same venue, there may be a likelihood of confusion where the trade channels could consist of the same *type* of venue, as illustrated by the Board's analysis in *In re Midwest Gaming*:

We acknowledge that if, as we must presume, the registrant were to render its restaurant and bar services in a casino to casino patrons, it is unlikely that it would be rendering such services in the same casino(s) in which applicant is rendering its bar services. However, the relevant class of purchasers, i.e., casino patrons, would be the same in both cases, and we must assume that they could encounter applicant's and the registrant's services in the different casinos. We find that they would be likely to be confused if they were to encounter "bar services" and "restaurant and bar services," respectively, both offered under the mark LOTUS, in those different casinos.

106 USPQ2d at 1166. Similarly, even if Applicant's and Registrant's goods would never appear in *the exact same online store*, the relevant class of purchasers – people purchasing clothing via the Internet – would be the same in both cases, though they may encounter Applicant's and Registrant's goods in different online stores.

Thus, the restriction of the channels of trade in Applicant's identification of goods does not obviate the likelihood of confusion with Registrant's mark.

The Slight Differences Between the Marks Are Insufficient to Obviate the Likelihood of Confusion, Even Considering the "Visual Circumstances Inherent in Online Sales"

Applicant also contends that differences in stylization, appearance and connotation between the marks are sufficient to overcome the likelihood of confusion in the present case. For example, applicant argues that the wording "GET CENSORED" is a "call to action," while Registrant's mark "CENSORED" instead "implies that the goods have already been examined by government officials and deemed unfit for society," and that the stylization of the applied-for mark obviates the similarity between the marks. However, these arguments are not compelling for multiple reasons, discussed below.

First, with respect to the stylization in the applied-for mark, the Board should note that the registered mark is in standard characters. A mark in standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra 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). Thus, a mark presented in stylized characters and/or with a design element, as in the present case, generally will not avoid likelihood of confusion with a mark in standard characters because the marks could be presented in the same manner of display. *See, e.g., In re Viterra 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").

Furthermore, in the present case, to the extent the stylization of the applied-for mark influences the likelihood-of-confusion analysis, the stylization in fact *enhances* the likelihood of confusion, since the wording “CENSORED” is presented far more prominently in the mark than the wording “GET,” as discussed previously in this Brief.

With respect to the differences in meaning conveyed by adding the word “GET” to the word “CENSORED,” these nuanced differences in meaning or connotation are greatly diminished by the overall appearance of the applied-for mark, wherein the wording “CENSORED” is placed prominently and consumers may even overlook the small word “GET” in the upper left-hand corner of the mark. To the extent a consumer does notice the word “GET,” she may simply view the wording GET CENSORED as imploring consumers to purchase, or “get”, clothing that is offered under the mark CENSORED by Registrant.

In connection with the above-referenced arguments, Applicant contends that because Applicant’s goods are offered only through its “online stores,” then “any consumer who purchases from Applicant would necessarily be faced directly with the visual differences between the two trademarks” in light of the visual nature of a website-based store. However, this argument is not compelling because Registrant’s mark is incorporated within Applicant’s mark, and presented prominently in that mark. Applicant’s mark does not *differ* from Registrant’s mark in terms of stylization, but has instead *added* stylization and additional wording to Registrant’s standard character mark. As discussed previously in this Brief, when an applicant has added stylization and/or wording to a registered mark that is in standard characters, this does not generally obviate the likelihood of confusion.

The Cases Discussed in Applicant's Brief Differ Meaningfully from the Present Case

Applicant's Brief includes discussions of a number of cases where the Board and courts have found no likelihood of confusion based on differing trade channels or differences in connotation between marks. However, for both the reasons discussed previously in this Brief – principally, that the identification of goods in the cited registration encompasses Applicant's narrower trade channels – and for the reasons discussed below, the analysis in the cases cited by Applicant each relied upon either legal principals or fact patterns that are inapplicable to the present case.

First, Applicant discusses *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984), where the Board determined there was no likelihood of confusion for the mark PLAYERS' when used on footwear and underwear, respectively. As the Board explained in analyzing the commercial impressions of the marks, the word PLAYERS' has a very different connotation when applied to footwear (i.e., that the goods are adapted to playing sports) versus underwear (where the term "implies something else, primarily indoors in nature"). *Id.* at 856. Therefore, the Board's decision rested primarily on the fact that the connotation of the mark changed when it was applied to the applicant's and registrant's goods, respectively, which reduced the likelihood of confusion. In the present case, the goods of Applicant and Registrant overlap significantly, while the marks differ only slightly. Therefore, the fact pattern in the present case is unlike that in *In re British Bulldog*, where the marks were identical while the goods differed slightly, so the case is of limited value to the present analysis.

Applicant next discusses *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 202 USPQ 81 (2d Cir. 1979), wherein the court relied heavily on extrinsic evidence of differences between the actual goods of the parties, which would be inappropriate in the present *ex parte*

proceeding. Specifically, the court emphasized the difference between the trade channels and classes of purchasers for “an inexpensive golf jacket” and a “fashionable and expensive woman’s coat.” *Id.* at 1134. In the present case, neither Applicant’s nor Registrant’s identification of goods is restricted to either inexpensive or high-fashion items. Thus, Applicant’s and Registrant’s identifications are presumed to encompass both affordable and expensive clothing, so the type of distinction drawn in *McGregor-Doniger* cannot be made in the present case, where the evidence shows Applicant’s and Registrant’s goods are closely related.

Applicant also urges the Board to follow the reasoning of the district court in *H. Lubovsky, Inc. v. Esprit De Corp.*, 627 F.Supp. 483, 228 USPQ 814 (SDNY 1986), which found no infringement for the same mark used on apparel and footwear. However, as the Board has noted in non-precedential decisions discussing *Lubovsky*, “*ex parte* decisions on registrability generally do not have the factual records of an infringement action,” and the court in *Lubovsky* “was clearly influenced by the defendant’s fame as well as the fact that the defendant’s merchandise was targeted at” different consumer demographics, issues which are generally not relevant in an *ex parte* proceeding. *In re Body Culture, Inc.*, Ser. No. 78487664, 2006 TTAB LEXIS 271 (June 20, 2006); *see also In re Gamila Co.*, Ser. No. 85748352, 2014 TTAB LEXIS 259 (June 18, 2014) (distinguishing *Lubovsky* as relying on “extrinsic factors”). Additionally, because Applicant’s and Registrant’s goods are identical in part and overlap significantly, and because Registrant’s identification encompasses Applicant’s narrower trade channels, the type of distinctions made in *Lubovsky* cannot be made in the present case.

The present case is also unlike *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917 (TTAB 2006), the facts of which are mischaracterized in Applicant’s brief. Applicant states that the applicant’s goods in *Standard Knitting* included “shirts that were

sold in automotive dealerships.” Applicant’s Brief, at p.5. However, in *Standard Knitting* the applicant’s goods were “automobiles and structural parts thereof,” while the opposer’s goods were a variety of clothing items. In fact, the Board’s conclusion that there was no likelihood of confusion was based primarily on the fact that “automobiles and structural parts thereof” are “vastly different goods” from clothing. *Standard Knitting*, 77 USPQ2d at 1931-32. Therefore, the analysis in *Standard Knitting* does not apply to the present case, where the goods are essentially identical and overlap significantly.

Applicant also cites *In re The Shoe Works Inc.*, 6 USPQ2d 1890 (TTAB 1988), where the Board found no likelihood of confusion between PALMBAY on clothing and shoes and PALM BAY on shoes. However, the Board’s decision in that case was heavily influenced by the presence of a consent agreement between the parties. *Id.* at 1892 (“[I]n this case, it is our opinion that the agreement, which is quite explicit in its terms, is entitled to considerable weight.”). Because there is no consent agreement in the present case, *In re The Shoe Works* does not support Applicant’s position.

Thus, for the reasons discussed above, the cases discussed in Applicant’s Brief do not undercut or obviate the likelihood of confusion in the present case. Furthermore, to the extent Applicant’s arguments or evidence have created any doubt as to whether there is a likelihood of confusion in the present case, any such doubt must be resolved in favor of Registrant. *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).

CONCLUSION

Applicant's identification of goods is identical in part and overlaps significantly with the types of clothing listed in the cited registration, while the wording in the registration also encompasses Applicant's narrower channels of trade. Additionally, the evidence of record firmly establishes that the goods of Applicant and Registrant are closely related. Furthermore, the applied-for mark GET CENSORED (plus design) fully incorporates the registered standard character mark CENSORED, and in fact places the wording CENSORED prominently in the mark. As a result, the marks are highly similar in sound, appearance, connotation, and commercial impression. In light of the foregoing, there is a likelihood of confusion and the refusal to register should be affirmed.

Respectfully submitted,

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