

This Opinion is not a
Precedent of the TTAB

Oral Hearing: July 14, 2015

Mailed: August 21, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Shannon Preston

Serial No. 85864264

Andrew P. Lahser of Andrew P. Lahser, PLC,
for Shannon Preston.

Wendell S. Phillips III, Trademark Examining Attorney, Law Office 110,
Chris A. F. Pedersen, Managing Attorney.

Before Bucher, Shaw, and Masiello,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Applicant, Shannon Preston, filed an application to register on the Principal
Register the mark



for goods identified as “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 25.¹

The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of a likelihood of confusion with the mark in U.S. Registration No. 4144833 for the mark CENSORED, in standard characters, for following goods in International 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.²

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

Analysis

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

¹ Application Serial No. 85864264 was filed on March 1, 2013, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

² Issued May 22, 2012.

du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, 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). In this case, Applicant also submitted arguments regarding differences in the goods' channels of trade.

A. The similarity or dissimilarity and nature of the goods described in the application and registration

We begin by considering the nature of the goods. It is settled that the goods need not be similar or competitive in nature to support a finding of likelihood of confusion. The question is not whether purchasers can differentiate the goods themselves, but rather whether purchasers are likely to confuse the source of the goods. *See Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). Further, in an *ex parte* appeal, likelihood of confusion is determined on the basis of the goods and services as they are identified in the application and the cited registration. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Many of Applicant's goods are identical to Registrant's goods. Hats, jackets, pants, shirts, shorts, swim wear, t-shirts, and underwear are all identified in both the application and cited registration. Based on this identity of goods, the *du Pont* factor of the similarity of the goods favors a finding of likelihood of confusion. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (Likelihood of confusion must be found as to a particular class in

an application if there is likely to be confusion with respect to any item that comes within the identification of goods in the class).

B. Channels of trade and classes of purchasers

We next consider the *du Pont* factor relating to the channels of trade and classes of purchasers. Applicant argues that the channels of trade for the respective goods are different because its goods are sold only through Applicant's online stores, as noted in the identification of goods. Accordingly, "consumers would never encounter Applicant's goods in the same context as Registrant's goods, thereby lessening any potential likelihood of confusion."³ But the issue is not whether purchasers would confuse the respective 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).

If the cited registration, as here, describes the goods broadly, and there is no limitation as to their nature, type, channels of trade, or class of purchasers, it is presumed that the registration encompasses all goods of the type described, that they move in all normal channels of trade, including the Internet, and that they are available to all classes of purchasers. *See, e.g., In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638 (TTAB 1990) ("We have no authority to read any restrictions or limitations into the registrant's description of goods.").

Both Applicant's and Registrant's goods would therefore be sold on the Internet, albeit on different websites. The mere fact that they would be sold on different websites does not compel the conclusion that the channels of trade are significantly

³ Applicant's Br., p. 4.

different. If the cited registration has an unrestricted identification of goods, an applicant does not necessarily avoid a likelihood of confusion merely by more narrowly identifying its channels of trade. *See, e.g., In re Diet Center, Inc.*, 4 USPQ2d 1975 (TTAB 1987) (noting that, although applicant had limited its identification to indicate that its goods were sold only through franchised outlets offering weight reduction services, the cited registration's identification contained no limitations as to trade channels or classes of customers and thus it must be presumed that registrant's goods travel through all the ordinary channels of trade).

Applicant agrees in its reply brief that the third-party website evidence introduced by the Examining Attorney supports its position that Applicant's and Registrant's channels of trade are distinguishable because "a manufacturer's/owner's retail establishments do not commonly sell the goods of third parties."⁴ We find the evidence does not support Applicant's argument.

As an initial matter, whether manufacturers choose to sell their own goods in their own retail establishments does not mean that such manufacturers do not also sell their products through third-party stores as well. Moreover, even if a manufacturer chooses to sell its goods only in its own stores, as Applicant apparently has chosen to do, customers may not necessarily know of this policy and accordingly would not be surprised to find the manufacturer's goods in a third-party store. Neither will customers be aware of the limitation stated in Applicant's identification of goods.

⁴ Applicant's Reply Br., p. 1.

More importantly, manufacturers do not forfeit their right to prevent later users from adopting similar marks for similar goods simply because the manufacturers choose to sell their goods in their own establishments. Applicant's argument would deny a basic trademark right to a vast number of manufacturers who choose to make and sell their own products, and thus it is anathema to trademark jurisprudence. *See In re Thor Tech*, 90 USPQ2d at 1638 (“We have no authority to read any restrictions or limitations into the registrant's description of goods.”).

This *du Pont* factor favors a finding of likelihood of confusion.

C. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression

We now turn to consider the marks, comparing them for similarities and dissimilarities in 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, 1692 (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) (citation omitted).

Although marks must be considered in their entirety, it is settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ

749, 751 (Fed. Cir. 1985) (“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 consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable.”).

Finally, in assessing the similarity or dissimilarity of the marks, we keep in mind that when marks appear on identical goods, as they do here, the degree of similarity necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Applicant’s mark is GET CENSORED in the design format shown above with a broken border design. The word “CENSORED” is by far the most prominent term in the mark. “CENSORED” is significantly larger than the word “GET,” it appears in the heaviest typeface, and it appears in the center of the mark. In comparison, the word “GET” is much smaller and appears in the upper left hand corner. We view “CENSORED” to be the dominant element of Applicant’s mark.

The mark in the cited registration is CENSORED, which is identical to the dominant element in Applicant’s mark. The cited mark is in standard character form, and could thus be used in any form, including one similar in appearance to the word “CENSORED” in Applicant’s mark. Thus, prospective purchasers of these goods could well believe that Applicant’s mark is merely a different version of Registrant’s mark. We also find the marks are similar in sound to the extent that the dominant element of both marks is the same word, “censored.” The element

GET in Applicant's mark creates a slight difference in sound, as between the two marks.

With respect to the meanings of the two marks, Applicant argues that the marks have "slightly different commercial impressions" because "Applicant's mark includes a meaning that is conveyed through the call to action 'GET CENSORED';"⁵ whereas Registrant's mark "implies that the goods have already been examined by government officials and deemed unfit for society, that is, previously forbidden."⁶ As Applicant argues, "Applicant's mark sarcastically infers that others might need to remove them from their clothing. Registrant's mark infers that the clothing itself is forbidden."⁷ Although this is a possible interpretation of the meaning of the marks, it is more likely that prospective consumers seeing Applicant's GET CENSORED mark could simply view the word "get" as an exhortation to buy Registrant's CENSORED brand goods. In viewing the marks in their entirety, we find they create similar commercial impressions, of something that has been or should be "censored."

We find that when the marks are considered in their entirety, the marks are similar in appearance, sound, connotation and commercial impression.

⁵ Applicant's Br., p. 3.

⁶ *Id.*

⁷ *Id.*

D. Balancing the factors

After considering all of the applicable *du Pont* factors, we find that Applicant's mark, GET CENSORED and design, for a variety of clothing items is likely to cause confusion with the cited mark, CENSORED, also for a variety of clothing items.

Decision: The refusal to register is affirmed.