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Subject: U.S. TRADEMARK APPLICATION NO. 85864287 - UNRATED - 13#629 - EXAMINER BRIEF

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

<b>U.S. APPLICATION SERIAL NO.</b> 85864287  <b>MARK:</b> UNRATED	
<b>CORRESPONDENT ADDRESS:</b> ANDREW P LAHSER  LAW OFFICE OF ANDREW P LAHSER PLC  16824 E AVENUE OF THE FOUNTAINS SUITE 14  FOUNTAIN HILLS, AZ 85268-8408	<b>GENERAL TRADEMARK INFORMATION:</b>  <a href="http://www.uspto.gov/trademarks/index.jsp">http://www.uspto.gov/trademarks/index.jsp</a>  <b>TTAB INFORMATION:</b>  <a href="http://www.uspto.gov/trademarks/process/appeal/index.jsp">http://www.uspto.gov/trademarks/process/appeal/index.jsp</a>
<b>APPLICANT:</b> Shanon Preston	
<b>CORRESPONDENT'S REFERENCE/DOCKET NO:</b>  13#629  <b>CORRESPONDENT E-MAIL ADDRESS:</b>  docket@lahserpatent.com	

**EXAMINING ATTORNEY'S APPEAL BRIEF**

The Applicant, Shanon Preston, has appealed the Examining Attorney's refusal to register the mark UNRATED in standard characters 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 UNRATED in standard characters for goods identified as “Anti-sweat underwear; 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. 3332414 and 3651681, for the marks NOT RATED and UNR8ED, respectively; both marks are registered for use with footwear.

On December 23, 2013, Applicant responded to the Office action and presented arguments against a likelihood of confusion with the cited registrations. On January 13, 2014, the Examining Attorney withdrew the refusal in part, as to U.S. Registration No. 3332414, and made final the refusal of registration with respect to U.S. Registration No. 3651681. On July 14, 2014, Applicant filed both a Request for Reconsideration and a Notice of Appeal, wherein Applicant amended the identification of goods to read “Clothing sold only through owner's online store, namely, anti-sweat underwear, hats, jackets, pants, rash guards, shirts, shorts, sleepwear, sports bra, sweat pants, sweat shirts, swim wear, t-shirts, tops, underwear, yoga pants”. The Examining Attorney denied Applicant’s Request for Reconsideration on July 16, 2014, and on September 15, 2014, Applicant filed an Appeal Brief.

## ISSUE ON APPEAL

Whether Applicant's use of the mark UNRATED, in standard characters, for "*Clothing sold only through owner's online store, namely, anti-sweat underwear, 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 creates a likelihood of confusion with U.S. Registration No. 3651681 for the mark UNR8ED, also in standard characters, for "*footwear*" 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 an 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. THE APPLIED-FOR MARK IS THE PHONETIC EQUIVALENT OF, AND OTHERWISE HIGHLY SIMILAR TO, REGISTRANT'S MARK

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *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 their entireties that confusion as to the source of the goods offered under applicant's and registrant's 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); *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

In the present case, as shown by the Wikipedia® article for "SMS language," attached to the January 13, 2014 Office action, the numeral "8" is frequently used as an abbreviation for the phoneme "ate," so the marks UNRATED and UNR8ED are essentially phonetic equivalents and

thus sound similar. Applicant has not denied or rebutted this evidence. Further, while the title of the Wikipedia® article implies that such abbreviations are limited to text messaging, the body of the article explicitly indicates that this technique of abbreviation is also used in various other Internet-based communications, as well as more generally “outside of its original context [of SMS messaging].” Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007).

In addition to being essentially identical in sound, the applied-for mark and registered mark both consist of a single word that begins with the same three letters “UNR” and ends with the same two letters “ED”. Thus, the only difference in appearance between the marks is that the applied-for mark uses the letters “AT” in place of the number “8” in the middle portion of the mark.

Furthermore, because potential consumers of Applicant’s and/or Registrant’s goods may use the spellings “UNRATED” and “UNR8ED” interchangeably when communicating by text message, Internet-based communications, or other informal means, these terms have essentially the same meaning and connotation in that context.<sup>1</sup>

In light of the foregoing, the marks are identical in sound, highly similar in appearance, and essentially identical in connotation and commercial impression. Therefore, the applied-for mark is confusingly similar to the registered mark.

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<sup>1</sup> This is particularly relevant in light of the restriction of trade channels in Applicant’s amended identification of goods, which indicates the goods are sold only through Applicant’s website. For a product sold only via the Internet, it seems likely there would be a greater chance that consumers discussing that product may use a method of abbreviation that is popular in Internet-based communications, as compared to a product sold only in a brick-and-mortar establishment, for example.

## 2. APPLICANT'S GOODS ARE CLOSELY RELATED TO REGISTRANT'S GOODS

Applicant's identification of goods, as amended, reads as follows:

Class 25:

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

The identification of goods in U.S. Registration No. 3651681 is “*footwear*” in Class 25.

As shown by the evidence discussed below, these goods are closely related because the same entities frequently offer both footwear and clothing like that of Applicant, including through online retail stores apparently operated by the owners of the marks used on those goods.

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 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)); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1597 (TTAB 2011).

The evidence attached to the previous Office actions and to the Examining Attorney's denial of Applicant's Request for Reconsideration included the websites of a wide range of

entities who offer both footwear and one or more of the clothing items included in Applicant’s identification. Furthermore, most of these examples show the goods being offered for sale via online retail stores that appear to be operated by the owners of the third-party marks used on those goods. This shows that entities who sell products like those of Applicant through their own online retail stores will often also offer footwear under the same marks and offer that footwear via the same channel of trade, contrary to Applicant’s assertion that “[i]t is less likely that shoes will be sold online, due to fit issues, than other forms of apparel.” Applicant’s Brief, at p.6. The following list summarizes the Internet evidence the Examining Attorney has made of record:

<b><u>Mark Used on Goods</u></b>	<b><u>Goods Shown/Listed</u></b>	<b><u>Nature of Evidence</u></b>
ADIDAS	Footwear and yoga pants	Owner’s online retail store
BANANA REPUBLIC	Footwear and underwear, hats, outerwear, pants, shirts, shorts, t-shirts	Owner’s online retail store
BCBGMAXAZRIA	Footwear and jackets, pants, shirts, shorts, tops	Owner’s online retail store
BETSEY JOHNSON	Footwear and underwear	Owner’s online retail store
BROOKS BROTHERS	Footwear and underwear, hats, outerwear, pants, shirts, shorts, sleepwear, swimwear, tops	Owner’s online retail store
EXPRESS	Footwear and underwear, jackets, pants, shirts, shorts, swimwear, t-shirts, tops, yoga attire	Owner’s online retail store
FOREVER 21	Footwear and intimate wear, jackets, pants, shirts, shorts, swimwear, tops	Owner’s online retail store
KATE SPADE NEW YORK	Footwear and jackets, pants, shirts, shorts, tops	Owner’s online retail store
LC LAUREN CONRAD	Footwear and jackets, pants, shirts, tops	Third party’s online retail store (KOHL’S)
MARC JACOBS	Footwear and jackets, pants, tops, swimwear	Owner’s online retail store
NIKE [“swoosh” design]	Footwear and sports bras, hats, pants, jackets	Owner’s online retail store
OLD NAVY	Footwear and hats, outerwear, pants, shirts, shorts,	Owner’s online retail store

<u>Mark Used on Goods</u>	<u>Goods Shown/Listed</u>	<u>Nature of Evidence</u>
	sleepwear, sweatshirts, swimwear, t-shirts, tops	
REBECCA MINKOFF	Footwear and jackets	Owner's online retail store
SPLENDID	Footwear and sleepwear, underwear, jackets, bottoms, tops, swimwear	Owner's online retail store
TORY BURCH	Footwear and jackets, pants, shirts, swimwear, tops	Owner's online retail store

Material obtained from the Internet is generally accepted as competent evidence. *See In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-03 (TTAB 2009) (accepting Internet evidence to show relatedness of goods in a likelihood of confusion determination).

In addition to the above-listed Internet evidence, the Examining Attorney has made of record copies of the following third-party registrations, which are further probative evidence of the relatedness of Applicant's and Registrant's goods:

<u>U.S. Registration No.</u>	<u>Mark</u>	<u>Relevant Goods</u>
2686685	BIKINI BAR	Footwear and underwear, hats, pants, shirts, shorts, sleepwear, swimwear, sweat shirts, sweat pants, jackets, rash guards, tops
3127933	HAVE -IT- BAD !	Footwear and underwear, hats, jackets, pants, rash guards, shirts, shorts, sleepwear, sweat pants, sweat shirts, swimwear, t-shirts, tops
3446051	FIDELIS APPAREL	Footwear and swimwear, shorts, underwear, pants, hats, tops, jackets, rash guards, sleepwear, sweat pants, t-shirts
3584994	NORTH COAST SURF SHOP	Footwear and underwear, hats, jackets, pants, rash guards, shirts, shorts, swimwear, sweat pants, sweat shirts, t-shirts
3984928	[design only]	Footwear and underwear, hats, jackets, pants, rash guards, shirts, shorts, sleepwear, sports bras, sweat pants, sweat shirts, swimwear, t-shirts, tops
4090804	[design only]	Footwear and hats, underwear, jackets, pants, rash guards, shirts, shorts, sleepwear, sweatpants, sweatshirts, swimwear, T-shirts, tops
4175352	REI	Footwear and underwear, hats, jackets, pants, rash guards, shirts, shorts, sleepwear, sports

<b>U.S. Registration No.</b>	<b>Mark</b>	<b>Relevant Goods</b>
		bras, sweatpants, sweatshirts, swimwear, T-shirts, tops
4305636	SLICK WILLIES	Footwear and hats, jackets, pants, shirts, shorts, swimwear, t-shirts
4341948	SHE-BALLS	Footwear and shirts, pants, jackets, hats
4342996	NEO BURRITO	Footwear and hats, jackets, pants, shirts, shorts, swimwear, t-shirts, tops, yoga pants
4343584	SHEDHEAD	Footwear and t-shirts, sweatshirts, pants, shorts, jackets, hats, pajamas, shirts
4344035	SANDTAN	Footwear and hats, shirts, swimwear, T-shirts, tank tops
4350493	BLACK ROOSTER	Footwear and jackets, pants, shirts
4350650	BLOSSOMING SECRETS	Footwear and tops, bottoms, shirts, T-shirts, pants, headwear, underwear, sleepwear, swimwear
4353100	MARIE MEILI	Footwear and lingerie, underwear, bras, swimwear, T-shirts, sweat pants, sweatshirts, tops, shirts, pants, jackets
4355611	JUST FABULOUS	Footwear and blouses, jeans, pants, shirts, sweat pants, sweat shirts, swim wear, tank tops
4355742	ICON I'LL CHANGE OVER NOTHING	Footwear and shirts, pants, jackets, hats

*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).

As shown by the Internet evidence and third-party registrations discussed above, the same entity commonly manufactures both footwear and other apparel items like those of Applicant, and markets those goods under the same mark as the footwear, including through the entities' own online retail stores. Therefore, Applicant's and Registrant's goods are 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).

### 3. APPLICANT'S ARGUMENTS AND EVIDENCE ARE NOT PERSUASIVE

#### *The Evidence in the Present Case Shows Close Relatedness of the Goods, Unlike in the Cases Cited in Applicant's Brief*

Applicant's Brief includes discussions of a number of cases where the Board and courts have found footwear and/or various clothing items to be unrelated for likelihood of confusion purposes, or where there was no likelihood of confusion for other reasons. However, as Applicant acknowledges, each case must be determined on its own particular facts, and "generally the Board finds footwear and apparel related." Applicant's Brief at p. 4. In each of the cases cited by Applicant, the analysis relied upon either legal principles 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.

Applicant contends that the marks in the present case "project slightly different connotations because of the highly unusual spelling of Registrant's mark," and that therefore the present case is similar to *In re British Bulldog*. However, unlike "PLAYERS," the wording "UNRATED" (or its phonetic equivalent "UNR8ED") does not have a different connotation when applied to footwear as opposed to when it is used on other clothing items. The term brings

to mind a lack of censorship, or that the product has not been reviewed by a third party, which has no particular meaning as applied to either Registrant's footwear or the other clothing items in Applicant's identification of goods. Therefore, the Board's holding in *In re British Bulldog* is not directly applicable to the likelihood of confusion analysis in the present case.

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, to the extent the *Lubovsky* court did hold that trade channels for footwear and other apparel items are meaningfully different, the evidence in the present case supports the opposite conclusion.<sup>2</sup>

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.”).

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<sup>2</sup> It is also possible that the trade channels for footwear and clothing have converged in the years since 1986, when the *Lubovsky* court issued its opinion. In fact, the particular type of trade channel to which Applicant's goods are restricted – an online retail store – did not yet exist at the time *Lubovsky* was decided.

Because there is no consent agreement in the present case, *In re The Shoe Works* does not support Applicant's position.

Applicant also discusses a number of other cases involving types of clothing other than footwear, but those cases likewise do not provide sufficient support for Applicant's position. For example, in *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 202 USPQ 81 (2d Cir. 1979), the court relied heavily on extrinsic evidence of differences between the actual goods of the parties, which would be inappropriate in the present case. 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 identification is presumed to encompass both affordable and expensive clothing, while Registrant's identification is presumed to encompass both affordable and expensive footwear. Therefore, 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.

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 "shirt [sic] that were sold in automotive dealerships." Applicant's Brief, at p.6. 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.

Finally, the present case is unlike *Clark & Freeman Corp. v. Heartland Co. Ltd.*, 811 F.Supp. 137, 25 USPQ2d 2030 (SDNY 1993), where the court did not conduct a full likelihood of confusion analysis because that was not the issue brought before the court. The plaintiff and defendant had already used the mark HEARTLAND concurrently for a number of years on footwear and clothing, respectively, and the question was whether the senior user could “bridge the gap” and begin using the mark on clothing for the first time. *Id.* at 141-42. The court’s reasoning was based largely on equitable concerns, as this excerpt illustrates:

It would be inequitable to allow plaintiffs to exploit defendants' substantial goodwill at this late date, simply because they are the senior user. As Judge Learned Hand stated in discussing expansion into related markets: “The owner's rights in such appendant markets are easily lost; they must be asserted early, lest they be made the means of reaping a harvest which others have sown.”

*Id.* at 142 (quoting *Dwinell-Wright Co. v. White House Milk Co.*, 132 F.2d 822 (2d Cir. 1943)). Because the present case involves no such factual background, and because matters of equity are not considered in an *ex parte* proceeding of this sort, *Clark & Freeman* is inapplicable to the present case.

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. In fact, in the vast majority of court and Board cases, both precedential and non-precedential, as discussed below, footwear has been found to be closely related to other clothing items. This is because only under unusual circumstances will these otherwise closely related goods be deemed unrelated.

For example, in *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), the Board found a likelihood of confusion existed for stylized and typed versions of the word ESSENTIALS when used on footwear and women’s clothing, including some of the clothing items listed in Applicant’s identification in the present case, such as jackets, pants, and shorts. Although the

applicant argued that that the goods travelled in different trade channels and that the registration deserved only limited protection because “ESSENTIALS” was “highly suggestive” and diluted, the Board was not convinced:

Despite applicant's argument to the contrary, we believe that these goods are related. A woman's ensemble, which may consist of a coordinated set of pants, a blouse and a jacket, is incomplete without a pair of shoes which match or contrast therewith. Such goods are frequently purchased in a single shopping expedition. When shopping for shoes, a purchaser is usually looking for a shoe style or color to wear with a particular outfit. The items sold by applicant and registrant are considered to be complementary goods.

*Id.* at 1388.

Similarly, in *In re Pix of America, Inc.*, the Board affirmed a Section 2(d) refusal for the mark NEWPORTS on “women’s shoes” because of an existing registration for “NEWPORT” on “outer shirts,” despite the existence of a consent agreement between the applicant and registrant. 225 USPQ 691 (TTAB 1985). The Board’s decision emphasized the complementary nature of apparel and footwear, which are often purchased together or selected to complement one another, and are generally sold in the same types of retail outlets. *Id.* at 691-92.

As Applicant acknowledges, *In re Melville Corp.* and *In re Pix of America, Inc.* are consistent with the majority of the decisions of the courts and the Board, which have generally found clothing and footwear to be closely related goods. *See, e.g., Avon Shoe Co. v. David Crystal, Inc.*, 279 F.2d 607, 125 USPQ 607 (2d Cir. 1960) (women’s shoes and women’s sportswear); *General Shoe Co. v. Hollywood-Maxwell Co.*, 277 F.2d 169, 125 USPQ 443 (CCPA 1960) (shoes and brassieres); *In re Keller, Heumann & Thompson Co.*, 81 F.2d 399, 28 USPQ 221 (CCPA 1936) (men’s shoes and men’s suits, topcoats and overcoats); *Villager, Inc. v. Dial Shoe Co.*, 256 F.Supp. 694, 150 USPQ 528 (E.D.Pa. 1966) (shoes and young women’s apparel);

*U.S. Shoe Corp. v. Oxford Indus., Inc.*, 165 USPQ 86 (TTAB 1970) (shoes and women's and girls' shirt-shifts); *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984) (athletic shoes and men's shirts); *see also In re Paris Seagull (Far East) Ltd.*, Ser. No. 75059887, 1998 TTAB LEXIS 309, at \*5-6 (Sept. 9, 1998) (footwear and various clothing items, including women's shirts, jackets, pants, shorts, T-shirts, and undergarments); *In re Underground Sounds Direct Marketing*, Ser. No. 75126661, 2000 TTAB LEXIS 56, at \*5-7 (Feb. 9, 2000) (footwear and various clothing items, including shirts, pants, hats, jackets, and T-shirts); *In re Palladium Investors, Ltd.*, Ser. No. 75285366, 2000 TTAB LEXIS 105, at \*3 (Feb. 17, 2000) (footwear and various clothing items); *In re Wiesner Products, Inc.*, Ser. No. 75348071, 2000 TTAB LEXIS 873, at \*3-5 (Dec. 12, 2000) (footwear and a wide variety of clothing items); *In re Smith & Jones, Inc.*, Ser. No. 74641262, 1997 TTAB LEXIS 144, at \*4-7 (Oct. 27, 1997) (footwear and infants' and children's clothing); *In re Zinky Electronics*, Ser. No. 78383898, 2006 TTAB LEXIS 858, at \*11-13 (Dec. 11, 2006) (footwear and t-shirts, jackets and headwear).

Much like in these prior decisions, the facts of the present case show that Applicant's and Registrant's goods are closely related, supporting the refusal under Section 2(d) of the Trademark Act.

*The Relevant Wording In The Marks Is Not Diluted*

Applicant has also made of record a number of registrations for marks that contain the word "RATED," either alone or combined with a designation that corresponds to ratings used in either the Motion Picture Association of America (MPAA) ratings system for motion pictures or the Entertainment Software Rating Board (ESRB) ratings system for video games. However, this evidence is insufficient to show dilution of the relevant wording in the marketplace, for the reasons listed below.

First, the weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with *similar goods*. See *Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by Applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982).

Furthermore, and perhaps more importantly, none of the marks referenced by Applicant contain the relevant wording that is common to the applied-for and registered marks: UNRATED or its phonetic equivalent. Instead, these registrations include only the word "RATED" either combined with other terms or as a standalone mark. Applicant's Brief, at pp. 2-3. Therefore, while this evidence provides some support for the contention that consumers may be accustomed to differentiating between marks that contain "RATED," such as "RATED X MAS," "PRO-RATED," "G-RATED," or "RATED X," there is no evidence that consumers are accustomed to differentiating between marks that combine the prefix "UN-" with "RATED" or its phonetic equivalent. Therefore, this evidence is of limited value in determining the relative strength or weakness of Registrant's mark.

However, even assuming *arguendo* that this evidence did show some weakness or dilution with respect to Registrant's mark, the Court of Appeals for the Federal Circuit and the Board have recognized that marks deemed "weak" are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); *see also King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974).

In light of the foregoing, the evidence provided by Applicant to show dilution or weakness with respect to Registrant's mark is not compelling.

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

Applicant's Brief also repeatedly indicates that the channels of trade are distinct for Applicant's and Registrant's goods, based upon the limitation in Applicant's amended identification of goods, which restricts the goods to those sold via Applicant's "online store." However, while Applicant has limited the identification of goods to a particular channel of trade, Registrant's identification of goods is not limited to any particular trade channel. 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 retail stores, including Applicant's store. While Applicant's Brief states that Applicant's online store "does not sell goods of 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 same exact 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 and/or footwear via the Internet – would be the same in both cases, even if they 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 "Visual Circumstance Inherent in Online Sales" Does Not Obviate the Likelihood of Confusion*

Applicant also contends that the likelihood of confusion with Registrant's mark is diminished or negated because "any consumer who purchases from Applicant would necessarily be faced directly with the visual differences between the two trademarks, because, online stores are presented visually to users on computing devices." Applicant's Brief, at p. 4. However, this argument overlooks the likelihood that a consumer who has only heard Registrant's mark spoken aloud may enter the term "UNRATED" into an Internet search engine, hoping to find a seller of Registrant's goods, and instead be presented with Applicant's online retail store. In such a circumstance, the consumer may even consummate the sale without ever realizing her mistake.

Similarly, if a consumer has seen a reference to Registrant's mark in social media, via text messaging, or in an email communication, the consumer may be uncertain whether the sender of the message was using SMS abbreviations or "leet" speak. Applicant states (without evidentiary support) that "[a]s anyone who has abbreviated words in SMS messages knows, or otherwise written in 1337 (leet) speak, you would not abbreviate proper names, such as trademark." Applicant's Brief, at p. 4. However, there is no evidence in the record to indicate that consumers avoid abbreviating brand names or trademarks in informal communications. Therefore, it would be reasonable for a consumer who encounters the mark "UNR8ED" in such

an informal communication to be unsure whether the mark in question is spelled “UNRATED” or “UNR8ED,” and this uncertainty could lead the consumer to find Applicant’s online store when the consumer was seeking to purchase Registrant’s goods.

Finally, 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**

The evidence of record firmly establishes that Applicant’s goods are closely related to Registrant’s goods. Further, the applied-for mark UNRATED is identical in sound, highly similar in appearance, and virtually identical in commercial impression and connotation to the registered mark UNR8ED. Thus, there is a likelihood of confusion and the refusal to register should be affirmed.

Respectfully submitted,

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