

This Opinion is not a
Precedent of the TTAB

Oral Hearing: July 14, 2015

Mailed: August 21, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Shannon Preston
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Serial No. 85864287
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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.
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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 UNRATED in standard characters for goods identified as “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 25.¹

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¹ Application Serial No. 85864287 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.

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. 3651681 for the mark UNR8ED, also in standard characters, for “footwear” in international Class 25.² 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. 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 evidence regarding the use of similar marks by third parties and arguments regarding differences in the goods’ channels of trade.

² Issued July 7, 2009; combined Section 8 and 15 declaration accepted and acknowledged August 26, 2014.

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

We begin by considering 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).

Applicant's mark is UNRATED in standard characters. Registrant's mark is UNR8ED, also in standard characters. The only difference between the marks is Registrant's substitution of the number "8" for the letters "at" in the word "unrated." The Examining Attorney argues that "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."³

Today's consumers are frequently presented with the substitutions of certain letters or words with phonetically equivalent numerals.⁴ For example, the number "2" is sometimes used instead of the words "to" or "too" and the number "4" is sometimes used instead of the word "for," as in "4 sale." This occurs in a variety of internet-based communications such as emails and text messages.⁵ The use of numbers or special characters to represent letters is often inconsequential to the sound and meaning of a word. *See In Home Federal Savings and Loan Association*,

³ Examining Attorney's Br., p.4. (Emphasis in Original).

⁴ Office Action, January 13, 2014; According to the Wikipedia entry submitted by the Examining Attorney, "SMS language . . . is a term for the abbreviations and slang commonly used with mobile phone text messaging, but sometimes used with other internet-based communication such as email and instant messaging."

⁵ *Id.*

213 USPQ 68, 69 (TTAB 1982) (applicant's mark TRAN\$FUND is similar to TRANSFUND).

“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). We find that when the marks are spoken there is no difference between UNRATED and UNR8ED. Accordingly, both marks convey the same commercial impression, that of something that is “unrated.”

Citing *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984), Applicant argues that the Board should find there is no likelihood of confusion inasmuch as the marks project slightly different connotations. Applicant argues that its mark calls to mind the movie rating system whereas the “highly unusual spelling of Registrant’s mark” is unlikely to do so because consumers “would not abbreviate proper names, such as trademarks.”⁶ We do not find this argument that the marks project slightly different connotations to be persuasive. The nearest rating used by the Motion Picture Association of America (“MPAA”), is “not rated”⁷ rather than “unrated” as used by Applicant. Even assuming, *arguendo*, that Applicant’s mark calls to mind the MPAA rating system, given the similarity of pronunciation of both marks, we

⁶ Applicant’s Br., p. 4.

⁷ *Id.*, p. 3.

see no reason why Registrant's mark, when spoken, would not call to mind the same system or the same rating.

Regarding the appearance of the marks, although both marks begin with and end with the same letters, Registrant's use of the number "8" in place of the letters "at" does create some difference in the appearance of the marks. Nevertheless, we find that the marks are similar in sound, connotation, and commercial impression. Similarity as to any one factor may be sufficient to support a finding that the marks are confusingly similar. *See Krim-Ko Corp. v. The Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion."); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988).

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

We next turn to the goods. It is settled that 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).

Applicant's goods are "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.” Registrant’s goods are “footwear.” The Examining Attorney, in support of his contention that the goods at issue are commercially related, has made of record examples of webpages from third-party vendors offering goods that are similar in nature to those of both Applicant and Registrant under the same mark, including the following, *inter alia*:⁸

- bananarepublic.gap.com – a website for the store Banana Republic showing the sale of a variety of men’s clothing items alongside men’s shoes;
- express.com – a website for the store Express showing the sale of a variety of men’s clothing items alongside women’s shoes and sandals;
- forever21.com – a website for the store Forever 21 showing the sale of a variety of women’s clothing items alongside a variety of women’s shoes;
- brooksbrothers.com – a website for the store Brooks Brothers listing a variety of men’s clothing items alongside men’s shoes;
- bcbg.com – a website for the store BCBGMAXAZRIA listing a variety of women’s clothing items alongside women’s shoes; and
- katespade.com – a website for the store Kate Spade listing a variety of women’s clothing items alongside women’s shoes.

The Examining Attorney also made of record a number of third-party registrations showing that both Applicant’s and Registrant’s types of goods are offered under a single mark by others:⁹

- U.S. Registration No. 3584994 for the mark **NORTH COAST SURF SHOP** used on footwear and underwear, hats, jackets, pants, rash guards, shirts, shorts, swimwear, sweat pants, sweat shirts, t-shirts;
- U.S. Registration No. 4175352 for the mark  used on footwear and underwear, hats, jackets, pants, rash guards, shirts, shorts, sleepwear, sports bras, sweatpants, sweatshirts, swimwear, T-shirts, tops;
- U.S. Registration No. 4341948 for the mark **She-Balls** used on footwear and shirts, pants, jackets, hats;

⁸ Office Actions of June 21, 2013 and January 13, 2014.

⁹ *Id.*

- U.S. Registration No. 4342996 for the mark **Neo Burrito** used on footwear and hats, jackets, pants, shirts, shorts, swimwear, t-shirts, tops, yoga pants;
- U.S. Registration No. 4343584 for the mark **SHEDHEAD** used on footwear and t-shirts, sweatshirts, pants, shorts, jackets, hats, pajamas, shirts;
- U.S. Registration No. 4344035 for the mark **SANDTAN** used on footwear and hats, shirts, swimwear, T-shirts, tank tops;
- U.S. Registration No. 4350493 for the mark **BLACK ROOSTER** used on footwear and jackets, pants, shirts;
- U.S. Registration No. 4350650 for the mark **BLOSSOMING SECRETS** used on footwear and tops, bottoms, shirts, T-shirts, pants, headwear, underwear, sleepwear, swimwear; and
- U.S. Registration No. 4353100 for the mark  used on footwear and lingerie, underwear, bras, swimwear, T-shirts, sweat pants, sweatshirts, tops, shirts, pants, jackets.

Although such third-party registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless may have probative value to the extent they are based on use in commerce and serve to suggest that the goods identified therein are of a kind which may emanate from a single source under a single mark., i.e., that the same entity may provide clothing and footwear under the same mark. *See In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009); and *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

We find that the third-party website evidence is competent to show that some clothing retailers use a single mark to identify both Applicant's and Registrant's types of goods and that the third-party registrations suggest that clothing and footwear may emanate from a common source. This evidence shows that consumers searching for information about clothing and footwear will likely see them

commonly associated with each other, either by retailer or by brand. Based upon this evidence we find that Registrant's goods are related to those provided by Applicant for purposes of our determination herein.

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

C. 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."¹⁰ 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.").

¹⁰ Applicant's Br., p. 5.

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 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."¹¹ 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

¹¹ Applicant's Reply Br., p. 1.

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.

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.

D. The number and nature of similar marks in use on similar goods

We next consider the strength of the marks and third-party use of similar marks on similar goods. Evidence of third-party use falls under the sixth *du Pont* factor: the "number and nature of similar marks in use on similar goods." *Du Pont*, 177 USPQ at 567. If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm Bay Imports*, 73 USPQ2d at 1693; *See also Juice Generation, Inc. v. GS Enters. LLC*, — F.3d —, 2015 WL 4400033 (Fed. Cir. July 20, 2015) ("The weaker an Opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.").

Applicant contends that the existence of other similar registered marks comprising the term “rated” used on similar clothing goods entitles Registrant’s mark to only a narrow scope of protection. Applicant made of record the following “rated” marks:¹²

- Registration No. 797265 for the mark **PRO-RATED** used on men’s and boy’s outer garments;
- Registration No. 1701132 for the mark **TEAM RATED** used on t-shirts, sweatshirts, and pants;
- Registration No. 2163868 for the mark **RATED X MAS** used on tee shirts, jackets, hats, shorts, sweatshirts, and underclothes;
- Registration No. 2996623 for the mark **RATED X** used on clothing and footwear;
- Registration No. 3322308 for the mark **G-RATED CLOTHING** (stylized) used on t-shirts, hats, sweatshirts, shoes, and pants;
- Registration No. 3774459 for the mark **RATED** (stylized) used on clothing and apparel;
- Registration No. 3817572 for the mark **UNDER RATED** used on men’s, woman’s, and children’s clothing;
- Registration No. 3944881 for the mark **FIVE STARZ RATED** used on hats and shirts;
- Registration No. 4359360 for the mark **RATED M BY MARIO LOPEZ** used on underwear, shirts, loungewear, and shorts; and
- Registration No. 3332414 for the mark **NOT RATED** used on footwear.

Absent evidence of actual use, third-party registrations are of limited probative value for the *du Pont* factor relating to a crowded field and relative weakness. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976) (third-party registrations “are entitled to little weight on the question of likelihood of confusion where there is no evidence of actual use” of the marks therein). *See also*

¹² Applicant’s response of December 23, 2011; Registration No. 2056365 is for the mark **TR** in stylized form and has not been considered.

In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“Even if prior registrations had some characteristics similar to [Applicant’s] application, the PTO’s allowance of such prior registrations does not bind the Board or this court.”). Moreover, based on the limited record before us, we have no way of knowing whether any of the owners of the other marks are related or whether they have entered into consent agreements permitting the use and registration of the marks on the various products.

Nevertheless, when we compare all of the listed “rated” marks, we find Applicant’s mark is most similar to Registrant’s mark in that they are pronounced exactly the same and have the same meaning. That is, even if consumers are able to distinguish among the “rated” marks by minute differences, Applicant’s mark, when spoken, has no such difference. *See King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401 182 USPQ 108, 109 (CCPA 1974) (Even a weak mark is entitled to protection against the registration of a similar mark for closely related goods.). Accordingly, this *du Pont* factor is neutral.

E. Balancing the factors

After considering all of the applicable *du Pont* factors, we find that Applicant’s mark, UNRATED, for a variety of clothing items is likely to cause confusion with the cited mark, UNR8ED, for footwear.

Decision: The refusal to register is affirmed.