

This Opinion is not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ReSashay Square Dance, Inc.

Serial No. 86041312

Martin P. Hoffman of Stein IP LLC,
for ReSashay Square Dance, Inc.

Lyndsay Kuykendall, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.

Before Kuhlke, Taylor and Wellington,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

ReSashay Square Dance, Inc (“Applicant”) seeks registration on the Principal
Register of the mark ReSashay (in standard characters)¹ for, as amended:

On-line retail consignment stores featuring women's,
men's and children's square dancing apparel and
accessories, namely, children's square dancing petticoats;
On-line retail store services featuring women's, men's and
children's square dancing apparel and accessories,

¹ Although Applicant seeks to register the mark in standard character format, the mark appears on the drawing page and on the specimen as set forth above in both capital and lower case lettering.

namely, children's square dancing petticoats in International Class 35.²

The Trademark Examining Attorney has refused registration of Applicant's mark on the grounds of a likelihood of confusion under Trademark Action Section 2(d), 15 U.S.C. § 1052(d), with the mark in registration No. 3892932, MYSASHAY (standard characters), for "Ballet shoes; Ballet slippers; Footwear for women; Insoles for footwear" in International Class 25.³

When the refusal was made final, Applicant requested reconsideration. After the Examining Attorney denied the request for reconsideration, Applicant appealed to this Board. We reverse the refusal to register.

I. Evidentiary Matters

Before proceeding to the merits of the refusal, we address an evidentiary matter. Applicant has attached to its brief numerous exhibits which either duplicate or are somewhat similar⁴ to those it made of record with its request for reconsideration. To the extent that the exhibits are duplicates, the Board generally discourages attaching such materials to the briefs. *See In re SL & E Training Stable, Inc.*, 88 USPQ2d 1216, 1220 n.9 (TTAB 2007) (attaching as exhibits to brief material already of record only adds to the bulk of the filed, and requires the Board to

² Application Serial No. 86041312 was filed on August 19, 2013, based upon Applicant's claim of first use anywhere and in commerce since at least as early as August 29, 2007.

³ Registered December 21, 2010.

⁴ We particularly note that the similar web pages are of merchandise which Applicant offers for sale on its website, but which were retrieved at different times and thus reflect apparent changes in inventory. To the extent that these web pages differ, they are considered untimely evidence and will not be further considered because "[t]he record in the application should be complete prior to the filing of an appeal." See 37 C.F.R. § 2,142(d).

determine whether attachments had been made properly of record); *In re Thor Tech Inc.*, 85 USPQ2d 1474, 1475 n.3 (TTAB 2007) (attaching evidence from record to briefs is duplicative and unnecessary). It is much more helpful to identify, by the date of submission and the page numbers in the TSDR (Trademark Status and Document Retrieval) database, the materials referred to in a brief. Additionally, when citing to the briefs, citations should reflect the TTABVUE⁵ docket entry number, and the electronic page number where the argument appears.

II. Discussion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion as set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services at issue. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In this case, Applicant and the Examining Attorney have also submitted arguments regarding the relevant channels of trade, the sophistication of the purchasers and actual confusion. We have considered each of these issues and all other matters of which there is evidence of record.

The Marks

⁵ TTABVUE is the Board's electronic docketing system.

We consider first the *du Pont* factor of the similarity or dissimilarity of the marks at issue in their entireties as to 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 (Fed. Cir. 2005). Nonetheless, it is not improper to accord more or less weight to a particular feature of a mark so long as the ultimate conclusion rests on a consideration of the marks in their entireties. *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant's mark RESASHAY and the cited mark MYSASHAY are similar in appearance and sound to the extent that they both include as the last six letters the word SASHAY, but differ in that they each begin with a different two letter, single syllable "prefix"; Applicant's mark beginning with the letters "RE" and the cited mark with the letters "MY." The common word "SASHAY," as set forth below, is defined, in pertinent part, on Vocabulary.com as both a particular ballet movement and square dancing step. In ballet the term is defined as "quick gliding steps with one foot always leading" and in square dancing as "a square dance figure; partners circling each other taking a sideways step."⁶ As noted by the Examining Attorney, and confirmed above, "sashay" has a strong definition in the dance community." However, contrary to the Examining Attorney's position, we do not find this affiliation with the dance community results in the term SASHAY dominating both marks. Instead, because of that "strong definition" with the dance community, we

⁶ Exhibit to the March 15, 2014 Office Action.

find the “SASHAY” portion of each marks to be highly suggestive of the goods or services offered and sold thereunder and, thus, a weaker element of each mark. *See, e.g., Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1837 (TTAB 2013) *citing to Pioneer Hi-Bred Corn Co. v. Welp.*, 280 F.2d 151, 126 USPQ 398 (CCPA 1960) (“The record shows that both parties deal in hybrid poultry, and ‘Hy’ therefore has a suggestive significance, hence is not entitled to as great weight in determining likelihood of confusion as an arbitrary word or syllable.”); *Lauritzen & Co. v. The Borden Co.*, 239 F.2d 405, 112 USPQ 60, 62 (CCPA 1956) (“In the instant case, the syllable ‘lac,’ which is common to the two trademarks under consideration, has a somewhat descriptive connotation as applied to milk products, and has been commonly used as a portion of trademarks for such products. Accordingly, it should be given little weight in determining whether those marks are confusingly similar.”). Accordingly, we find that the letters “RE” in Applicant’s mark and “MY” in the cited mark serve to distinguish the marks in both appearance and sound.

We further find the differing two first letters distinguish the two marks in terms of connotation. First the term “resashay” is not only a term of art in the square dancing community,⁷ but also imparts a meaning that may be understood by consumers as a play on second-hand ownership of the children’s petticoats offered for sale in connection with Applicant’s online retail consignment store services, while the letters “MY” in the cited mark MYSASHAY lend an overall possessive quality to that term.

⁷ See exhibit to Applicant’s August 15, 2014, Request for Reconsideration.

While there is a degree of similarity between Applicant's mark RESASHAY and the cited mark MYSASHAY in terms of appearance and sound, when viewed as a whole, each mark conveys a separate and distinct connotation and commercial impression, inasmuch as the common element SASHAY is suggestive to the dance community – which is the focus of the respective goods and services. That is, consumers, when viewing the marks in their entireties, and keeping in the mind the dance centric nature of the respective goods and services, will focus on the letters RE and MY to distinguish the marks.

Accordingly, this *du Pont* factors weighs in favor of finding no likelihood of confusion.

The Goods and Services

We now consider the second *du Pont* factor, the similarity or dissimilarity of the goods and services. It is well-established that the goods and services need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods and services are related in some manner, and/or that the conditions and activities surrounding the marketing thereof are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); *In re International Telephone & Telephone Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers

would confuse the goods and services, but rather whether there is a likelihood of confusion as to the source thereof. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

Here, Applicant's services are identified as "On-line retail consignment stores featuring women's, men's and children's square dancing apparel and accessories, namely, children's square dancing petticoats; On-line retail store services featuring women's, men's and children's square dancing apparel and accessories, namely, children's square dancing petticoats." Although Applicant, during prosecution of its application, was adamant that the identification include the language "women's, men's and children's square dancing apparel and accessories," given the limitation inherent in the term "namely," we note that Applicant's services essentially are:

On-line retail consignment stores featuring children's square dancing petticoats; On-line retail store services featuring children's square dancing petticoats.

It is those services that we compare to the cited "Ballet shoes; Ballet slippers; Footwear for women; Insoles for footwear."

In support of her position that Applicant's services are related to the services recited in the cited registration, the Examining Attorney made of record with her January 2, 2014 Office Action webpages from the websites of six companies,⁸ in addition to Applicant's, purportedly showing that the same entity commonly manufacturers and provides "relevant goods and services and markets the goods and services under the same mark." A review of this evidence reveals, however,

⁸ The websites are <http://www.revolutiondance.com/intor-jt--products-93.php?page id=70>, <http://www.leosdancewear.com/product/stretch-split-sole-ballet-shoes>, <http://www.capezio.com/women's/shoes/pointe-shoes/>, <http://blochworld.com/product/bloch-ladies-rayze-jaxx-shoe>, <http://www.freedshop.com/Products1.aspx?catid=8>, and <http://www.dancer.com/gmpointe.php>, Attachments to Office Action issued January 2, 2014.

that while the Examining Attorney is correct in that the evidence “show[s] that many companies make ballet shoes and offer them for sale under the same mark,” it fails to show that the goods of the cited registrant, i.e., ballet shoes and slippers or other footwear and insoles, and the services of Applicant, i.e., on-line retail and retail consignments stores featuring children’s petticoats, are offered under the same mark. With particular regard to the evidence, although the web page of Revolution Dancewear features a drop down menu with headings including “Ballet,” “Skirts, Dresses + Sweaters,” and “Foundations,” the Examining Attorney did not include the web pages featuring these items. Nor is there any other indication of the specific items sold under these categories or whether the items sold are offered under a single mark. The web pages of Freed of London have similar shortcomings. Further, the web pages of Leo USA 1924, Capezio, Bloch and dancer.com feature only ballet slippers or other dance shoes.

With her March 15 2014, Office Action, the Examining Attorney made of record webpages from various websites which she argues show companies that offer for sale dance shoes and dance apparel, including petticoats. We find this evidence unpersuasive. First, the evidence from the websites⁹ of Carrie B’s (<http://www.carriebs.com>), Ali Express (<http://www.aliexpress.com>), Lebos (<http://www.lebos.com>) and Discount Dance Supply (<http://www.discountdance.com>) fail to show that a single entity offers both ballet or other dance shoes and children’s square dancing petticoats. While Carrie B’s and Discount Dance Supply

⁹ Full urls for the referenced websites can be found on unnumbered pages 4 and 5 on the Office Action.

offer both dance shoes and children's tutus, they do not offer both ballet shoes and petticoats. Similarly, although Ali Express offers both ballet and dance shoes and square dancing petticoats, the petticoats appear to be bridal foundation garments.

The Examining Attorney also made of record excerpts from the following websites,

- <http://secondactdancewear.com/shoes/ballet-shoes/>
- <http://consignmentcolorado.com/consignment-shops-stores-denver-baby-childrens-maternity-clothing/>¹⁰
- http://www.snickerpoodles.biz/consign_design.php, and
- <http://uptownkidsconsignment.com/>

showing that ballet shoes are sold second hand or through consignment shops, and not strictly by specialty stores. While that may be so, this evidence has limited probative value because it also shows that consignment and or other resale shops sell a wide variety of goods, including strollers, baby monitors, magazines, linens, equipment, furniture and toys.

Last, although the website of Petticoat Junction Dance Shop (<http://www.petticoatjct.com/mm5/merchant.mvc?...>) offers both women's ballet shoes and other dance footwear and square dancing petticoats, there is no indication that these goods are offered under the same mark and evidence from a single website does not persuade us that the cited goods and Applicant's identified services are sufficiently related.

¹⁰ The webpages list various consignment shops in the Colorado area.

For the reasons discussed above, the evidence falls far short of convincing us that consumers would encounter ballet shoes and other women's footwear and insoles, and online retail store and online retail consignment store services featuring children's square dancing petticoats under circumstances that would lead to the mistaken belief that they emanate from a common source.

We accordingly find Applicant's services and Registrant's goods unrelated for purposes of our likelihood of confusion of analysis and this *du Pont* factor weighs against a finding of likelihood of confusion.

Channels of Trade

In the absence of any limitations in the identification as to channels of trade in the cited registration, we must presume that the identified goods will be purchased in the usual channels of trade for ballet shoes and other footwear, including online sales – the trade channel through which Applicant offers its services. Thus, to the extent Registrant's goods and Applicant's services are offered online the channels of trade overlap. However, the record does not support a finding that the respective items, ballet shoes and square dancing petticoats, are commonly sold on the same website, let alone the same web page.

Sophistication of the Purchasers

Applicant argues that its customers would not easily be confused because they are sophisticated and will exercise a reasonable degree of care, inasmuch as many of Applicant's goods sell for more than \$100. First of all, we are concerned only with the children's petticoats, many of which cost less than \$100, featured in Applicant's

online retail store and retail consignment store services. Moreover, even assuming consumers who avail themselves of Applicant's services exercise some degree of care in their purchasing decisions, even careful purchasers can be confused as the trademarks. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970).

Actual Confusion

The final argument made by Applicant is that both its applied-for mark and the cited mark have been in use for six years without any actual confusion. We point out, however, that it is not necessary to show actual confusion in order to establish likelihood of confusion. *See Weiss Associates Inc. v. HRL Associates Inc.* 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990). Particularly in an *ex parte* proceeding, Applicant's assertion of the absence of actual confusion is of little probative value in our determination on the issue of likelihood of confusion because the Board cannot readily determine whether there has been a significant opportunity for actual confusion to have occurred, such that the absence of confusion is meaningful. *See In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001); *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984). In those situations where the Board has recognized the absence of actual confusion as probative in an *ex parte* setting, there existed a "confluence of facts" which together strongly suggested that the absence of confusion was meaningful and should be given probative weight. *See In re Opus One Inc., supra*. Such a "confluence of facts" is not present in this record.

In conclusion, while Applicant's mark RESASHAY has some similarity to Registrant's mark MYSASHAY to the extent that both marks include the highly suggestive word SASHAY, they have distinct connotations and commercial impressions and we are not persuaded, on this record, that purchasers of Registrant's ballet shoes; ballet slippers; footwear for women and insoles for footwear would encounter Applicant's on-line retail consignment stores featuring women's, men's and children's square dancing apparel and accessories, namely, children's square dancing petticoats and on-line retail store services featuring women's, men's and children's square dancing apparel and accessories, namely, children's square dancing petticoats under circumstances that would lead them to believe that they emanate from a common source.

Decision: The refusal to register under Section 2(d) of the Trademark Act is reversed.