

<p>This Opinion is Not a Precedent of the TTAB</p>

Mailed: August 20, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lin

Serial No. 86329057

Gene Bolmarcich of Law Offices of Gene Bolmarcich, for Wei Lin.

Tiffany Y. Chiang, Trademark Examining Attorney, Law Office 113,
Odette Bonnet, Managing Attorney.

Before Wolfson, Kuczma and Masiello,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Wei Lin (“Applicant”) seeks registration on the Principal Register of the mark depicted below for “Men’s and women’s jackets, coats, trousers, vests; Pants; Sweaters; Women’s clothing, namely, shirts, dresses, skirts, blouses” in International Class 25.¹

¹ Application Serial No. 86329057 was filed on July 5, 2014, based on Chinese Reg. No. 8459855, registered April 7, 2013, under Section 44(e), 15 U.S.C. § 1126(e).



The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that Applicant's mark so resembles the mark PH:FIVE that, when used in connection with Applicant's goods, confusion, mistake or deception among purchasers is likely. The mark PH:FIVE is registered for, *inter alia*, "Footwear, headwear, hosiery, jackets, pajamas, pants, pullovers, jumpers, sweaters, shirts, skirts, t-shirts, jerseys, trousers, uniforms, vests, camisoles, denims, denim shirts, denim jackets and denim skirts; knitwear, namely, sweaters, jackets and vests, sportswear, namely, jogging suits, belts" in International Class 25 and "Retail store services featuring clothing, footwear, headwear, wallets, purses and belts," in International Class 35.²

The Examining Attorney further refused to accept the amended description of the mark as being inaccurate under Trademark Rule 2.37. The current description of the mark reads: "The mark consists of stylized letters 'P', 'H', '5' in color black." Applicant proposes amending the description to "The mark consists of the characters '215' in stylized form."

Following the Examining Attorney's final Office Action, Applicant filed a request for reconsideration of the refusals under Section 2(d) and Trademark Rule 2.37.

² Reg. No. 4223650 issued October 16, 2012, on the basis of Hong Kong Reg. Nos. 2003B07186, 2003B07187 and 2003B07188, dated March 4, 2002.

Upon denial of the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

I. Applicable Law – Section 2(d)

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). *See also Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). 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 re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

A. The Goods

We turn first to a comparison of the similarity or dissimilarity and nature of the goods as they are identified in the registration and application. *See Dixie Restaurants* 41 USPQ2d at 1534; *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Applicant seeks to register its mark for, *inter*

alia, “pants; sweaters.” Registrant’s identification of goods also includes “pants” and “sweaters” without any limitations as to type or restrictions as to trade channels or classes of purchaser. The goods are therefore identical in part, which weighs heavily in favor of a 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 with respect to a class of goods or services in an application if there is likely to be confusion with respect to any item that comes within the identification of the goods or services in that class). The goods are also legally identical, in that the cited registration lists “jackets,” “trousers,” “vests,” “shirts,” and “skirts” without any limitation, encompassing Applicant’s more narrowly worded “men’s and women’s jackets, trousers and vests” and “women’s shirts and skirts.”

Registrant’s remaining clothing items are highly related to Applicant’s clothing, as evidenced by the website printouts submitted by the Examining Attorney from JCrew, Banana Republic and Levi’s, showing that companies offer clothing of the type offered by both Registrant and Applicant under a single trademark.³ It is also well settled that confusion is likely when similar marks are used for both goods and the service of providing those goods (here, “retail store services featuring clothing”). The webpages submitted by the Examining Attorney demonstrate several businesses offering retail store services featuring clothing and various clothing

³ At <https://www.jcrew.com>, <http://bananarepublic.gap.com>, and <http://us.levi.com>, attached to the first Office Action dated October 22, 2014.

items under the same mark.⁴ *See In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (same mark used for both furniture and retail general merchandise store services held likely to cause confusion); *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992) (use of nearly identical marks for coats, and for retail outlets featuring camping and mountain climbing equipment, including coats, was likely to cause confusion).

Additionally, the Examining Attorney attached copies of a number of use-based, third-party registrations for a single mark for the same goods and services as are listed in Registrant's and Applicant's identifications.⁵ While the registrations are not evidence of use, they serve to suggest that the goods of Applicant and Registrant and the goods of Applicant and the services of Registrant are of a type which may emanate from a single source, which supports the showing made by the website evidence. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993).

The legal identity and proximity of the goods heavily favor a finding of likelihood of confusion.

⁴ See webpages attached to final Office Action, showing America Eagle Outfitters, Forever 21, and H&M offering, under a single mark, clothing and retail store services that are similar to those offered by Registrant and Applicant under their respective marks.

⁵ See Registration Nos. 2820510, 2787681, 2974436, and 2907346 attached to the first Office Action dated October 22, 2014. *See also* (attached to final Office Action) Registration Nos. 4566752, 4502659, 4261957, 4261956, 3098239, 3053930, and 3075828 (showing various clothing items offered by a single entity) and Registration Nos. 4655247, 4642249, 2382073, 2664972, 2577380, 3199241, and 3812414 (showing clothing items and retail store services featuring clothing items offered by a single entity).

B. Trade Channels; Purchasers

Because the goods in the application and the cited registration include identical and legally identical goods, we must presume that the channels of trade and classes of purchasers are the same for those goods. *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *Hewlett-Packard* 62 USPQ2d at 1005 (“absent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers”). We may presume that the respective goods will be marketed to the same potential consumers, namely, any member of the general public in the market for men’s or women’s clothing.

Thus, the third *du Pont* factor also favors a finding of likelihood of confusion.

C. The Marks

When comparing the marks, we consider them in their entirety as to appearance, sound, connotation and commercial impression, to determine the similarity or dissimilarity between them. *Viterra*, 101 USPQ2d at 1908 (quoting *du Pont*); *Palm Bay*, 73 USPQ2d at 1692. The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather “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). Because Applicant’s and Registrant’s goods and services are in-part identical, legally identical, and/or closely related, 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. *In re Microsoft Corporation*, 68 USPQ2d 1195, 1198 (TTAB 2003) (“[W]hen marks appear on or in connection with virtually identical or closely related goods, the degree of similarity of the marks necessary to support a conclusion of likely confusion is not as great as when the goods are different.”). *See also Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (virtually identical goods or services); *Skincode AG v. Skin Concept AG*, 109 USPQ2d 1325, 1329 (TTAB 2013) (“Because some of the goods are legally identical, the degree of similarity of the marks necessary to find likelihood of confusion need not be as great as where there are recognizable differences between the goods”); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987) (closely related goods).

Applicant initially described his mark as consisting of the “stylized letters ‘P’, ‘H’, [and] ‘5’ in color black.” Applicant noted that PH5 has no meaning in the relevant trade or industry and as applied to the goods is without significance, including geographical significance. Applicant later amended the description of the mark to: “the mark consists of an illegible depiction of ‘PH5.’” We also note that the

translation of the Chinese registration submitted with the application presented the mark as “PH5.” With his request for reconsideration, Applicant amended the description of the mark to “The mark consists of the characters ‘215’ in stylized form.”

Because Applicant’s mark is not in standard characters, a description of the mark is required. Trademark Rule 2.37, 37 C.F.R. § 2.37; TMEP § 808.01. A mark description “should state clearly and accurately what the mark comprises, and should not create a misleading impression by either positive statement or omission.”

TMEP § 808.02.

A description cannot be used to restrict the likely public perception of a mark. A mark’s meaning is based on the impression actually created by the mark in the minds of consumers, not on the impression that the applicant states the mark is intended to convey.

Id.

Applicant argues that its mark will be perceived as a pure design mark and not as the letters PH and number 5, despite the description of the mark in the record, because consumers are not aware of statements made in the record or printed on registration certificates. Rather, the mark must be taken as it is, and not as the equivalent of the standard character mark PH5. According to Applicant, it may just as readily be perceived as “215.” The Examining Attorney, on the other hand, argues that Applicant’s mark will be perceived as PH5 and that it is reasonable to presume that Applicant markets its mark as PH5, on the basis of Applicant’s repeated characterization of its mark as PH5 in the application. The Examining

Attorney argues that Applicant's proposed amendment of the description of its mark to 215 was submitted in an effort to circumvent the Section 2(d) refusal.

We are not persuaded by Applicant's argument that its mark would be perceived as "215" by a substantial number of relevant consumers. We agree with the Examining Attorney's contention that the mark "more closely resembles a stylized 'PH5.'"⁶ We note that Applicant described the mark as PH5 in its initial application, in its amended description of the mark, and in its statement of the significance of the mark; and that the translator of the Chinese registration upon which the application herein is based presented the mark as "PH5." Applicant argues that "the middle symbol in its mark would never be seen as a 'H' where half of an 'H' is missing from the symbol,"⁷ and that the mark can reasonably be perceived as any of several combinations, such as 215, ?15, P15, etc. Applicant suggests that the mark is best described as "215." We disagree. We find it less likely that consumers would perceive the mark as 215, as the extraneous "line" added to the middle character is inconsistent with a perception of the middle element as a "1." We also find the initial character of the mark to be, at best, a highly abstracted rendition of the numeral 2 and not likely be so perceived. In sum, we find that relevant customers would perceive Applicant's mark as a stylized presentation of PH5.

⁶ Denial of request for reconsideration dated January 12, 2015.

⁷ 4 TTABVue 7.

The literal element PH5 and PH:FIVE are identical in pronunciation; would be seen as having the same meaning, if any;⁸ and convey the same overall commercial impressions. Courts and this Board have often held that consumers have more difficulty recalling differences in what appear to be arbitrary letter strings; therefore, the cited mark would be more susceptible of confusion or mistake. *See Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); *Alberto-Culver Co. v. F.D.C. Wholesale Corp.*, 16 USPQ2d 1597 (TTAB 1990) and cases cited therein. The difference between the numeral 5 in Applicant's mark and the word FIVE in Registrant's mark creates a difference in the appearance of the two marks, but we find that difference to be relatively insignificant; FIVE and 5 are equivalents in sound and meaning and the colon in Registrant's mark is unpronounceable. Accordingly, Applicant's mark is similar in pronunciation, connotation and overall commercial impression to the cited mark PH:FIVE. "[T]aking into account all of the relevant facts of a particular case, similarity as to one factor (sight, sound, or meaning) alone may be sufficient to support a holding that the marks are confusingly similar." *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031 (TTAB 2010) (*citing Trak Inc. v. Traq Inc.*, 212 USPQ 846, 850 (TTAB 1981) ("Where the marks in conflict possess a marked similarity in sound, this factor alone may be sufficient to support a holding that the marks are confusingly similar."); *see also Chaussures Bally Societe Anonyme De*

⁸ In the final Office Action, the Examining Attorney suggests that "PH" could be viewed as pH, the scale in chemistry that indicates the level of acidity or basicity of an aqueous solution. While we make no determination whether this meaning attaches here, we note that, if it does, it attaches equally to both marks.

Fabrication v. Dial Shoe Co., 345 F.2d 216, 217 (CCPA 1965) (“Applicant’s ‘VALLI’ and opposer’s ‘BALLY’ are virtually indistinguishable in sound and similarity in this factor alone is sufficient to support a finding of a likelihood of confusion”).

“The nature of stylized letter marks is that they partake of both visual and oral indicia, and both indicia must be weighed in the context in which they occur.” *In re Electrolyte Labs., Inc.*, 929 F.2d 645, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (stylized “K+” mark unlikely to cause confusion with “K+EFF”). The court in that case cited to *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 614 F.2d 757, 204 USPQ 697, 699 (CCPA 1980) as follows:


It must be remembered that [registrant’s] trademark consists of highly stylized letters and is therefore in the gray region between pure design marks which cannot be vocalized and word marks which are clearly intended to be.


Applicant’s mark likewise is in the “gray region.” Weighing the mark in the context in which it occurs yields little in the way of marketplace information, as the mark has not yet been in use, but our determination is assisted by placing the mark in the context of the application itself. In other words, we are guided by Applicant’s repeated characterization of the mark as PH5, as well as the fact that the translator of the foreign registration upon which it was based likewise characterized the mark as PH5 (and was issued in April 2013, more than one year before the subject application was filed). Upon encountering the mark, a prospective consumer must form his or her own impression of the mark, drawing upon their own design sense and familiarity with letters, numerals, and abstract designs. Although there is no direct evidence in the record as to how buyers will perceive the mark, based on the

record and our analysis we reach the conclusion that the mark more closely resembles “PH5” than “215” and would be perceived as such by the relevant public. For the reasons discussed above, we find that PH5 is similar to PH:FIVE.

The first *du Pont* factor favors a finding of likelihood of confusion.

II. Conclusion

We find that a substantial number of the relevant purchasing public would perceive Applicant’s mark, , as a stylized rendition of the letter/number combination PH5. We find it sufficiently similar to the cited mark PH:FIVE in pronunciation, connotation and commercial impression that when used in connection with identical, legally identical, and closely related goods and services, confusion, mistake or deception among purchasers is likely.

Decision: The refusal to register Applicant’s mark  under Section 2(d) on the ground that the mark is likely to cause confusion with the registered mark PH:FIVE is affirmed. In view of our finding that the mark must be refused registration, we need not reach the refusal on the ground that the proposed amendment to the description of the mark is unacceptable.