

This Opinion is not a
Precedent of the TTAB

Mailed: July 19, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re America Directo Corporation

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Serial No. 86406889

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Matthew H. Swyers of the Trademark Company PLLC
for America Directo Corporation.

Howard Smiga, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.

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Before Wolfson, Lykos and Pologeorgis,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On September 26, 2014, America Directo Corporation (“Applicant”) filed an application to register on the Principal Register the mark SMARTSOCKS in standard characters for “[h]osiery; [s]ocks” in International Class 25.¹

The Trademark Examining Attorney 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 following two registered marks, each owned by

¹ Application Serial No. 86406889, filed under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a *bona fide* intent to use the mark in commerce.

different individuals, that when used on or in connection with Applicant's identified goods, it is likely to cause confusion or mistake or to deceive:²

Registration No. 2734333 for the mark SMART SOCKS SOCKS THAT THINK ON YOUR FEET displayed below for "Hosiery, namely socks" in International Class 25:³



Registration No. 4649441 for the mark, "HEEL 2 HEAL SMARTSOCKS" displayed below for "socks" in International Class 25:⁴



² The Examining Attorney also initially refused registration on the ground that the mark is merely descriptive within the meaning of Trademark Act Section (2)(e)(1), 15 U.S.C. § 1052(e)(1). This refusal was later withdrawn.

³ Issued July 8, 2003 on the Principal Register with a disclaimer of SMART SOCKS; renewed. The description of the mark is as follows: "The mark consists of the words 'smart socks' with the word 'smart' being the color gold and the word 'socks' being the color white. The words 'socks that think on your feet' are the color gold. The design element is in white and the background color upon which the mark is displayed is black."

⁴ Issued December 2, 2014 on the Principal Register with a disclaimer of SMARTSOCKS. The description of the mark is as follows: "The mark consists of the wording 'HEEL 2 HEAL' with the number '2' stylized to look like the shape of a person's foot or a heeled shoe with toes showing; the wording 'SMARTSOCKS' appears beneath the term 'HEAL'. Color is not claimed as a feature of the mark."

Applicant has appealed the final refusal to register the mark, and the appeal is now briefed.

Likelihood of Confusion Analysis

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors and others are discussed below. *See M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944 (Fed. Cir. 2006) (even within *du Pont* list, only factors that are “relevant and of record” need be considered).

The Goods and Channels of Trade

We turn first to the goods. It is undisputed, and Applicant concedes, that the application and cited registrations each share the common product of “socks.” *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Given the identity of the goods in part and absence of restrictions, we must also presume that these goods travel in the same ordinary trade and distribution channels and will be marketed to

the same potential consumers. *See 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); *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); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011). Accordingly, with respect to both of the cited registrations, the *du Pont* factors regarding the relatedness of the goods as described in the application and registration as well as the similarity of established, likely to continue trade channels both weigh in favor of finding a likelihood of confusion.

The Marks

We now turn to the *du Pont* likelihood of confusion factor which involves an analysis of the similarity or dissimilarity of the marks 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). “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) (quoting *Leading Jewelers Guild*,

Inc. v. LJOW Holdings, LLC, 82 USPQ2d, 1901, 1905 (TTAB 2007)). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Binion*, 93 USPQ2d 1531 (TTAB 2009); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). That being said, our analysis cannot be predicated on dissection of the involved marks. *Stone Lion*, 110 USPQ2d at 1161. Rather, we are obliged to consider the marks in their entireties. *Id.* See also, *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). Nonetheless, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1161.

Commencing first with Registration No. 2734333 for the mark SMART SOCKS THAT THINK ON YOUR FEET and design, we find this cited mark to be similar in appearance, sound, connotation and commercial impression when compared to Applicant’s mark. The dominant portion of the registered mark is “SMART SOCKS” because it appears in relatively larger sized, bold lettering. The tag line SOCKS THAT THINK ON YOUR FEET appears in significantly smaller lettering, and given its meaning, merely serves to reinforce the dominance of the term SMART SOCKS. In addition, the presence of the circular design element in the cited mark fails to mitigate the similarities. When a mark consists of a literal portion and a design

portion, the literal portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods and/or services; therefore, the literal portion is normally accorded greater weight in determining whether marks are confusingly similar. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999). *See also CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267-68 (TTAB 2011). The circular design in the mark of this cited registration merely serves as a carrier for the wording and is not a distinctive design element with strong source-identifying characteristics. Thus, when compared to Applicant's mark SMART SOCKS, both marks engender highly similar meanings and commercial impressions.

We reach a different result, however, as to Registration No. 4649441 for the mark, displayed below:



The dominant portion of this cited mark is the much visually larger phrase "Heel 2 Heal" while the term "SMARTSOCKS" is relegated to the right bottom corner and is proportionally smaller. Consumers are much more likely to remember the phrase "Heel 2 Heal" in calling for the goods because it appears first. *Palm Bay Imports*, 73 USPQ2d at 1692 ("VEUVE nevertheless remains a 'prominent feature' as the first word in the mark"). The phrase "Heel 2 Heal" is also a play on words engendering its

own distinct connotation and meaning and is sufficiently distinct from Applicant's mark in its overall appearance and pronunciation. Thus, both the content and pattern of the words are sufficiently dissimilar such that consumers would readily distinguish the marks on this basis. We therefore find that the marks are distinct in appearance, sound, connotation and commercial impression.

Conclusion

We have carefully considered all of the evidence of record and arguments pertaining to the *du Pont* likelihood of confusion factors, including any evidence and arguments not specifically addressed in this opinion. We treat as neutral any *du Pont* factors for which there is no evidence or argument of record. With regard to Registration No. 2734333, each of the *du Pont* factors discussed above favor a finding of likelihood of confusion. However, with regard to Registration No. 4649441, despite the fact that the goods are identical and the trade channels are presumed identical due to the legal presumptions we are entitled to make, we find the differences in the marks to be dispositive. *See Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991).

Decision: The Section 2(d) refusal to register Applicant's mark is affirmed as to Registration No. 2734333 but reversed as to Registration No. 4649441.