

This Opinion is not a
Precedent of the TTAB

Oral Hearing: August 15, 2018

Mailed: September 25, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re ERB Industries, Inc.
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Serial No. 86826889
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Erik M. Pelton for ERB Industries, Inc.

Michael Ebaugh, Examining Attorney, Law Office 108,
Steven R. Berk, Acting Managing Attorney.

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Before Kuhlke, Wolfson and Hightower,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

ERB Industries, Inc. (“Applicant”) seeks registration on the Principal Register of the mark COOLERZ in standard characters for goods ultimately identified as “Bandanas, hat liners, neck bands and headbands,” 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

¹ Application Serial No. 86826889 was filed on November 20, 2015, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a bona fide intention to use the mark in commerce.

Applicant's mark, when used in connection with the identified goods, so resembles the mark COOLER in standard characters, registered on the Principal Register for "Clothing, namely, shirts, knitwear, namely, knit tops, knit bottoms, knit jackets, pants, jeans, trousers, chinos, skirts, coats, dresses; footwear; headgear, namely, hats, caps, berets," in International Class 25,² as to be likely to cause confusion, mistake or deception.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration the Board resumed the appeal and briefs were filed. We affirm the refusal to register.

I. Likelihood of Confusion

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*du Pont*") (cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015)). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). Even within the *du Pont* list, only factors that are "relevant and of record" need be considered. *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) ("While we have considered each factor for which we have evidence, we focus

² Registration No. 5005476, issued on July 26, 2016. The Registration also includes "Leather and imitations of leather, and goods made of these materials and not included in other classes, namely, wallets, briefcases, luggage, belt bags, animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks," in International Class 18, and "business management; business administration; providing office functions," in International Class 35, but the Examining Attorney does not rely on these goods or services for the refusal.

our analysis on those factors we find to be relevant.”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 303 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

A. *Similarity of the Goods/Channels of Trade/Consumers*

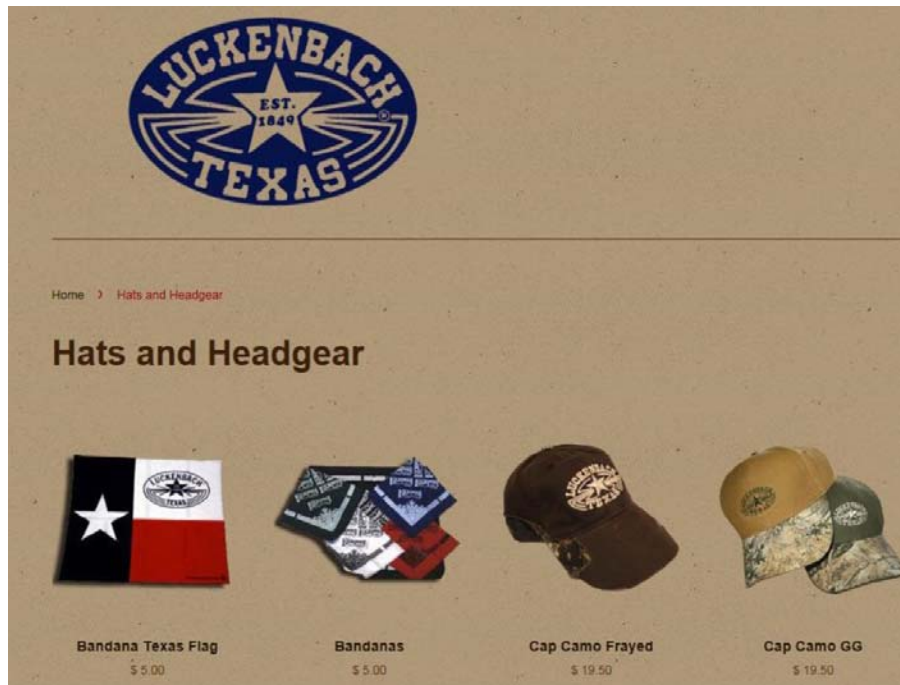
With regard to the goods, channels of trade, and classes of consumers, we must make our determinations based on the goods as they are identified in the application and cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Goods need not be identical or even competitive to find a likelihood of confusion. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1368 (TTAB 2009). “This factor considers whether ‘the consuming public may perceive [the respective goods of the parties] as

related enough to cause confusion about the source or origin of the goods and services.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett-Packard Co. v. Packard Press Inc.*, 62 USPQ2d at 1004).

Applicant’s identified goods, “Bandanas, hat liners, neck bands and headbands” and Registrant’s goods, “Clothing, namely, shirts, knitwear, namely, knit tops, knit bottoms, knit jackets, pants, jeans, trousers, chinos, skirts, coats, dresses; footwear; headgear, namely, hats, caps, berets” are not limited in any manner. In its brief, Applicant argues that the difference between Applicant’s and Registrant’s goods is “demonstrated by the fact that the cited registration is also for ‘business management; business administration; providing office functions’ services in Class 38.” 10 TTABVUE 20. While the registration includes other identified goods and services, each class in a registration stands separately and they do not serve to limit each other in terms of, for example, a trade channel restriction. *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1588 n.1 (TTAB 2011), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (“Each International Class stands on its own for all practical purposes like a separate application, and we must make determinations for each separate class.”) (citing *G&W Laboratories, Inc. v. G W Pharma Limited*, 89 USPQ2d 1571, 1574 (TTAB 2009)).

To show the relationship between Applicant’s and Registrant’s types of clothing items, the Examining Attorney submitted printouts from various websites displaying such items, in particular, bandanas, hat liners, hats and caps, under the same mark


and in some cases on the same webpage. A few representative examples are shown below:









Luckenbach Texas (<https://shop.luckenbachtexas.com>) May 30, 2017 Office Action at

2.

OFFICIAL SITE OF BUFF® USA

 [women](#) | [men](#) | [junior](#) | [dog](#) | [activity](#) | [custom buff](#) | [buff life](#) | [sale](#)

Search For:

 KETTEN BANDANA REGGAE \$29.00 \$20.30	 KETTEN BANDANA JAX \$29.00 \$20.30	 KETTEN BANDANA SKELETOR \$29.00 \$20.30
 KETTEN BANDANA N/A \$29.00 \$20.30	 MERINO WOOL HAT BLACK \$27.00 \$18.90	 MERINO WOOL HAT CEDAR \$27.00 \$18.90

Buff (<http://buffusa.com>) *id.* at 4.



CAPS



Hard Climb Cap
\$24.99

HEADBANDS



ALL APPAREL



Men's Made In America T-Shirt
~~\$24.99~~ \$9.99

Junk Brands (<https://www.junbrands.com>) *id.* at 25-65.



[Home](#) [Why Bambooty?](#) [Contact Us](#) [Top Wear](#) [Bottom Wear](#) [Head Gear](#) [Gift Card](#)

Home / Head Gear

Head Gear



Bandanas (3)



Hats (1)



Headband (1)

Bambooty Bodygear (<https://bambootyheadgear.com>) *id.* at 68.

The header for the Galeton website features the brand name 'Galeton' in a bold, yellow, italicized font on a dark blue background. To the right is a search bar with a yellow 'Search' button. Below the header is a navigation menu with links for 'Gloves', 'Personal Safety', 'Spill & Containment', 'Maintenance', 'Clothing', and 'New Proc'. A promotional banner below the menu reads '10% Off Code MS7TEND Will Be Applied at Check'.

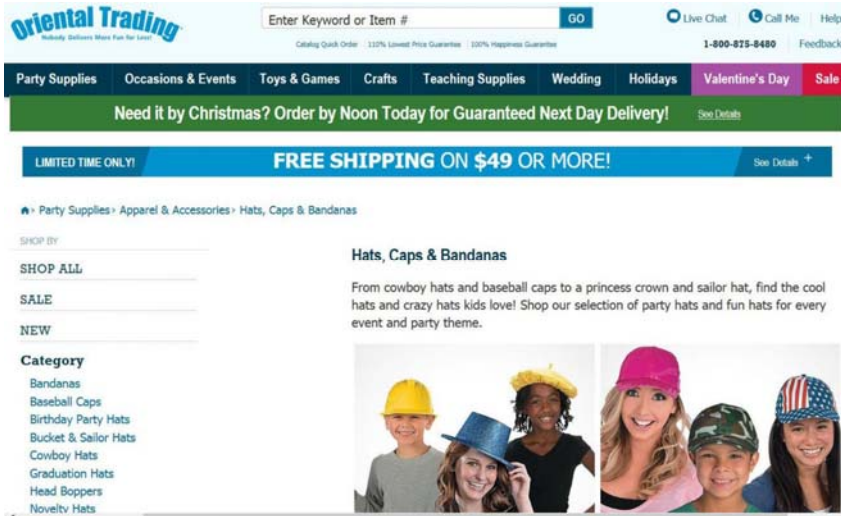
CLOTHING / Hats and Liners

Hats and Liners

Galeton has an assortment of hats and liners designed to keep your head warm as you work outside. Have a job that requires you to wear a hard hat? Check out our hard hat liners selection for that extra warmth you need in the cold winter months. Work outside year round? Shop our Winter Hats and Caps selections for those hats made to keep you warm in the winter or protect you from the sun during the summertime.

A dark blue hard hat liner. Hard Hat Liners Need some extra protection from the cold weather? Check out our hard hat liners and detachable ear muffs.	A dark blue winter hat. Winter Hats Galeton has Winter Hats to keep your head warm as winter rolls through. Choose from a variety of	A yellow high-visibility cap. Caps Galeton has a variety of caps including high visibility, welders caps, ranger hats and bump it protection
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Galeton (<http://www.galeton.com>) *id.* at 71.



Oriental Trading (www.orientaltrading.com) December 21, 2017 Reconsideration Letter at 2.



Paddlesports Warehouse (<https://paddlesportwarehouse.com>) *id.* at 27.

We further note that some of the third-party registrations submitted by Applicant to demonstrate weakness in Registrant's mark discussed below, include hats, caps, bandanas and headbands. *See, e.g.*, Reg. No. 4806534 (hats, caps, windproof headbands); Reg. No. 4317800 (head bands, brimmed hats); Reg. No. 4915712 (headbands, hats and caps); Reg. No. 3416236 (caps, hats, headbands, bandanas);

Reg. No. 2651581 (caps, hats, head bands); Reg. No. 1907779 (bandanas, hats); and Reg. No. 3734785 (headbands, caps and bandanas).³ *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (citing *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)) (third-party registrations may serve to suggest that the goods are of a type that may emanate from a single source).

Because there are no limitations as to channels of trade or classes of purchasers in either the application or cited registration, we must presume that Applicant's and Registrant's goods would move in all normal channels of trade and are available to all classes of purchasers for such goods. *See, e.g., Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638 (TTAB 2009) ("We have no authority to read any restrictions or limitations into the registrant's description of goods."). As shown by the examples discussed above, the ordinary channels of trade for Applicant's bandanas and Registrant's hats include online clothing retailers available to general consumers.⁴

In view of the above, these *du Pont* factors weigh heavily in favor of finding a likelihood of confusion.

B. Strength/Weakness of the Registered Mark

Applicant argues that the term COOLER "is both commercially and conceptually weak and thus entitled to a more narrow range [of] protection." 10 TTABVue 11.

³ See April 24, 2017 Response Exh. A at 11-42.

⁴ See May 30, 2017 Office Action; December 21, 2017 Reconsideration Letter.




Applicant asserts, based on a dictionary definition, that the term COOLER is conceptually weak in the field of clothing and fashion due to its meaning “to be cool or hip or trendy.” *Id.* (referencing Webster’s Dictionary (<http://www.merriam-webster.com>) attached to June 30, 2017 Response).

Applicant argues that the mark is commercially weak based on third-party registrations. However, third-party registrations are not evidence of use in the marketplace, such that we can infer the possible extent of consumer exposure. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) (“The existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive.”). Applicant cites to *Juice Generation* but in that case the evidence consisted of third-party registrations paired with evidence of use in the marketplace. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015). Reliance on *Jack Wolfskin* is also misplaced. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015). Citing *Jack Wolfskin*, Applicant argues that evidence of third-party use is relevant “even where the specific extent and impact of the usage has not been established.” *Id.* at 1136. Again, in *Jack Wolfskin* the record included evidence of use in the marketplace in the form of website printouts.

The third-party registrations may be used to show the conceptual weakness of a term. *Juice Generation*, 115 USPQ2d at 1675 (“Third party registrations are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” (quoting 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:90 (4th ed. 2015)). *See also In re i.am.symbolic*, 123 USPQ2d at 1751 (active third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976) (although third-party registrations are entitled to little weight on the question of likelihood of confusion where there is no evidence of actual use, they may be given some weight to show the meaning of a mark in the same way as dictionaries). Here, Applicant submitted several registrations that incorporate the term COOL in the mark for goods in class 25.⁵ However, many of the third-party registrations submitted by Applicant do not include examples of the actual marks COOLER or COOLERZ, but only the root term COOL, which diminishes their value in evaluating the strength or weakness of a mark consisting of COOLER or COOLERZ. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005) (emphasis added) (“Evidence of third-party use of **similar marks** on similar goods is relevant to show

⁵ April 24, 2017 Response and November 30, 2017 Request for Reconsideration.

that a mark is relatively weak and entitled to only a narrow scope of protection.”). The examples that do include COOLER contain other distinguishing elements (SWAMP COOLER BANDANAS, ...COOLER BY A MILE, BODY COOLER, A

COOLER WAY TO RIDE,  HOTTERCOOLER,  ,  , DON'T HATE ME JUST BECAUSE I'M A LITTLE COOLER, THE GREENER THE COOLER). The closest example is the mark COOLERA in Reg. No. 4380795 for headwear, hats, caps, knit hats, and baseball caps, but the addition of the A arguably creates a somewhat differing commercial impression by transforming it into a new word. Nonetheless, this record does tend to show that the root term COOL and the term COOLER have been registered by several different registrants. This fact coupled with the meanings for the word COOLER, namely, to be trendy or to be colder, which have a suggestive connotation for clothing items, including hats, caps, bandanas, hat liners, neck bands and headbands, indicates a weakness of the term COOLER in connection with these goods.

We find this *du Pont* factor weighs slightly in favor of no likely confusion.

That being said, even weak marks are entitled to protection and likely confusion may be found where the marks are very similar and the goods closely related. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010).

C. *Similarity/Dissimilarity of the Marks*

Under this factor, we compare Applicant's and Registrant's marks "in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay Imports v. Veuve Clicquot*, 73 USPQ2d at 1691 (quoting *du Pont*, 177 USPQ at 567). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). The average customer is an ordinary consumer of the respective goods.

In appearance and sound, the marks COOLER and COOLERZ differ only by the addition of the letter Z to the end of Applicant's mark. Marks may be confusingly similar in appearance despite the addition, deletion, or substitution of letters or words. *See, e.g., Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (finding TMM confusingly similar to TMS); *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (affirming Board's holding that source confusion is likely where COMMCASH and COMMUNICASH are used in connection with identical banking services); *In re Pix of Am., Inc.*, 225 USPQ 691 (TTAB 1985) (finding NEWPORTS and NEWPORT to be essentially identical in appearance). In addition, the Z makes Applicant's mark appear and sound like the plural of COOLER. "It is well established

that trademarks and/or service marks consisting of the singular and plural forms of the same term are essentially the same mark.” *Weider Publ’ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1355 (TTAB 2014) (citing *Wilson v. Delaunay*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) (finding no material difference between the singular and plural forms of ZOMBIE such that the marks were considered the same mark)). *See also In re Pix of Am.*, 225 USPQ at 692 (noting that the pluralization of NEWPORT is “almost totally insignificant” in terms of likelihood of confusion among purchasers); *In re Sarjanian*, 136 USPQ 307, 308 (TTAB 1962) (finding no material difference between the singular and plural forms of RED DEVIL).

Turning to connotation and commercial impression, Applicant argues:

Applicant’s mark conveys a commercial impression distinct from that of the registered mark because persons who encounter these marks are not likely to assume any connection between the parties. Specifically, the cited registration “COOLER” conveys the clear impression that its goods are like an ice cooler. Applicant’s COOLERZ mark, however, is different in sound and appearance due to the “Z” at the end of the mark. The added “Z” also changes the overall commercial impression of the mark – COOLERZ are fun, hip, playful. The impression attached to Applicant’s mark is that the goods are for more than just providing literal ‘cooler’ temperatures. Thus, the cited mark emphasizes the passive, adjective connotation of the mark, while Applicant’s mark emphasizes the active, effect [sic] qualities of its goods. Therefore, there is no likelihood that consumers would be confused as to whether the marks point toward the same source of goods. 14 TTABVUE 5.

We are not convinced that COOLER and COOLERZ would engender connotations or commercial impressions different from each other. Both may be viewed as an “ice cooler” or ice coolers, “fun, hip, playful” or providing “cooler temperatures.” Admittedly, as used with hat liners and neck bands that are specifically designed to

have such effect, the connotation of a cooling effect is stronger with such goods; however, other types of clothing that may have a cooling effect based on the cut or material evoke a similar connotation.

We find the marks, taken in their entirety, to be very similar in appearance, sound, connotation and commercial impression such that this *du Pont* factor weighs heavily in favor of finding a likelihood of confusion.

II. Balancing of Factors

When we consider that the goods are closely related, the channels of trade and consumers overlap, and the marks are very similar, despite the somewhat restricted scope of protection for the word COOLER in the clothing field, we find that confusion is likely.

Decision: The refusal to register Applicant's mark is affirmed.