

This Opinion is Not a
Precedent of the TTAB

Mailed: February 13, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re CID Resources, Inc.
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Serial No. 86829440
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Dyan M. House of Baker & McKenzie LLP,
for CID Resources, Inc.

Colleen Dombrow, Trademark Examining Attorney, Law Office 101,
Ronald R. Sussman, Managing Attorney.

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Before Lykos, Greenbaum and Coggins,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

CID Resources, Inc. (“Applicant”) seeks to register on the Principal Register the standard character mark GRACE for goods ultimately identified as:¹

Medical wearing apparel, namely, scrub tops and bottoms; medical wearing apparel, namely, pants for emergency medical personnel in International Class 10; and

Nurse’s apparel, namely, tops and bottoms, uniforms, lab coats; scrubs not for medical purposes in International Class 25.

¹ Application Serial No. 86829440, filed November 23, 2015 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.

Registration was refused as to both classes under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that Applicant's applied-for mark so resembles the registered mark GRACE in typed format² for "women's sportswear, namely, jackets, pants, skirts, blouses, dresses, shirts, and knit tops, but excluding pantyhose and hose" in International Class 25,³ that it is likely to cause confusion or mistake or to deceive.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Trademark Examining Attorney denied the request for reconsideration, the appeal was resumed and is now briefed. For the reasons explained below, we affirm the refusal to register as to both classes of goods.

I. Evidentiary Issue

Before discussing the substance of this appeal, we shall address the Examining Attorney's objection to Applicant's submission with its appeal brief of a list third-party applications and registrations, purportedly to show that the cited mark is weak in the clothing field. The Examining Attorney has objected on the ground of untimeliness. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), provides in relevant part "[t]he record in the application should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal." Insofar as the Examining Attorney has timely interposed an objection to Applicant's

² "Prior to November 2, 2003, 'standard character' drawings were known as 'typed' drawings. ... A typed mark is the legal equivalent of a standard character mark." TRADEMARK MANUAL OF EXAMINING PROCEDURE § 807.03(i) (Oct. 2017).

³ Registration No. 2781042, registered November 11, 2003; renewed.

late-filed evidence with her brief, the objection is sustained and the evidence submitted concurrently with Applicant's appeal brief has been given no consideration.⁴ *See e.g., In re Fiat Group Marketing & Corporate Commc'ns S.p.A.*, 109 USPQ2d 1593, 1596 (TTAB 2014).

II. Likelihood of Confusion

We turn now to the substantive refusal before us. Our determination under Section 2(d) is based 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 Co.*, 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 Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors, and the other relevant *du Pont* factors, are discussed below.

A. The Marks

Commencing with the first *du Pont* factor, it is undisputed that Applicant's and Registrant's marks are identical.⁵ And in our view, this is not a situation where the same marks are used to identify goods so dissimilar as to engender different

⁴ We add that Applicant's listing of third-party registrations and applications based on search results from USPTO records was not an appropriate manner of making this evidence of record. *See In re Hoeflin*, 97 USPQ2d 1174, 1177 (TTAB 2010). To make third-party registrations part of the record, an applicant must submit copies of the registrations, or the complete electronic equivalent from the USPTO's automated systems, prior to appeal. *See In re Jump Designs LLC*, 80 USPQ2d 1370, 1372-73 (TTAB 2006).

⁵ Indeed, Applicant presents no arguments regarding this factor in its brief.

connotations or commercial impressions. *See, e.g., In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (no likelihood of confusion found between BOTTOMS UP for ladies' and children's underwear and BOTTOMS UP for men's suits, coats and trousers). This first *du Pont* factor therefore weighs heavily in favor of finding a likelihood of confusion. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (the first *du Pont* likelihood of confusion factor involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression).

B. The Goods

Next, we compare the goods as they are identified in the involved 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); *Octocom Systems, Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) and *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). The goods need not be identical or even competitive to find a likelihood of confusion. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). They need only be "related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012)

(quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). Evidence of relatedness may include news articles and/or evidence from computer databases showing that the relevant goods are used together or used by the same purchasers; advertisements showing that the relevant goods are advertised together or sold by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both applicant's goods and the goods listed in the cited registration. *See, e.g., In re Davia*, 110 USPQ2d 1810, 1817 (TTAB 2014) (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the same recipes and thus consumers were likely to purchase the products at the same time and in the same stores). Likelihood of confusion must be found as to the entire class if there is likely to be confusion with respect to any good that comes within the identification of goods in that class. *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1355 (TTAB 2015) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)).

Where identical marks are involved, as is the case here, the degree of similarity between the goods that is required to support a finding of likelihood of confusion declines. *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017). Insofar as the Examining Attorney's refusal applies to both classes of goods, we shall analyze separately each individual class.

Applicant argues that the only similarity between the goods is that they fall under the broad category of apparel. Applicant makes a distinction between Registrant's

women’s “sportswear” which is defined as “(1) clothes that people wear for playing sports; and (2) comfortable clothes that people wear for informal activities”⁶ versus uniforms and scrubs for medical professionals defined as “loose-fitting clothing worn by hospital staff.”⁷ The implication of Applicant’s argument is that there can be no sweeping rule regarding the relatedness of apparel items. To that extent, Applicant is correct that “there can be no rule that certain goods (i.e. all clothing products) are per se related. . . .” *The H.D. Lee Co. Inc. v. Maidenform, Inc.*, 87 USPQ2d 1715, 1723 (TTAB 2008). The Examining Attorney, however, does not argue that the involved goods are “per se” related. Rather, the Examining Attorney has submitted evidence to show that Applicant’s and Registrant’s goods are commercially related. Furthermore, based on the identifications and evidence of record, it is clear that Applicant’s and Registrant’s goods are complementary items of clothing, which may be worn together by women working in the medical field.

Specifically, with regard to Applicant’s International Class 10 “[m]edical wearing apparel, namely, scrub tops and bottoms” and Registrant’s International Class 25 “women’s sportswear, namely, . . . shirts,” the Examining Attorney made of record the following third-party, use-based registration showing that the same entity has registered a single mark identifying both Applicant’s goods and the legal equivalent of Registrant’s: Reg. No. 4713824 for the mark SOULGUARD for “Medical wearing

⁶ Definition of “sportswear” from Merriam-Webster (www.merriam-webster.com) submitted with June 30, 2016 Response to Office Action, TSDR at 5.

⁷ Definition of “scrub” from Merriam-Webster (www.merriam-webster.com) submitted with June 30, 2016 Response to Office Action, TSDR at 6.

apparel, namely, caps; **Medical wearing apparel, namely, scrub pants; Medical wearing apparel, namely, scrub tops**” in International Class 10 and “**Athletic shirts; Bottoms; Briefs; Collared shirts; Dress shirts; Golf shirts; Ladies' underwear; Men's underwear; Polo shirts; Shirts; Socks; Sport shirts; T-shirts; Underwear**” in International Class 25.⁸ (Emphasis added). In addition, the record includes evidence that it is not uncommon for Applicant's International Class 10 goods and International Class 25 products to be sold under the same trademark as Registrant's International Class 25 women's sportswear apparel or by the same online retailer:

Carhartt (www.carhartt.com) offering via its direct-to-consumer sale website under the Carhartt brand name women's medical and non-medical scrub tops and bottoms (e.g., mock wrap two-pocket scrub top; fashion waist scrub top; multi-cargo scrub pant; flare leg scrub pant) and women's sportswear shirts (e.g., women's lightweight, slightly fitted shirt that wicks away sweat);⁹

Dickie's (www.dickies.com) offering via its direct-to-consumer sale website under the Dickie's brand name women's non-medical scrub tops (e.g., Beary Christmas to All, Happy Owl-o-ween) and women's sportswear jackets (e.g. women's performance full zip hoodie);¹⁰

Jockey (<http://jockey-scrubs.com>) and (www.jockey.com) offering via its direct-to-consumer sale website under the Jockey brand name women's medical and non-medical women's scrub tops and bottoms, and women's sportswear shirts and jackets (e.g., performance tee, windbreaker);¹¹

Urbane (www.urbanescrubs.com) offering via its direct-to-consumer sale website under the Urbane brand name women's non-medical scrub tops and women's sportswear shirt (energy tee, yoga inspired knit pant);¹² and

⁸ July 23, 2016 Office Action, TSDR at 23.

⁹ *Id.* at 34-39.

¹⁰ *Id.* at 40-43.

¹¹ *Id.* at 44-47.

¹² *Id.* at 57-61.

Allheart America's Medical Superstore (www.allheart.com) an online retailer offering a variety of brands of women's medical and non-medical scrub tops and bottoms (e.g., women's v-neck abstract print scrub top; women's elastic waist yoga scrub pant), lab coats, and women's sportswear jacket's and shirts (e.g., women's French terry jacket; women's long sleeve crew neck stretch t-shirt).¹³

This evidence also shows that consumers may not only expect to encounter such products under the same trademark but may also look for coordinating items. We acknowledge that some of the aforementioned evidence may involve house marks, but this is no surprise given the nature of the goods. The evidence still remains probative to the extent that it demonstrates that the involved goods may emanate from the same source and are designed to be used together.

In short, we can conclude, based on the record herein, that Applicant's and Registrant's goods are related, complementary clothing items that can be worn together by female professionals working in the medical field. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984) (“[C]omplementary use has long been recognized as a relevant consideration in determining a likelihood of confusion.”). As such, this *du Pont* factor also favors a finding of likelihood of confusion.

C. Established, likely-to-continue channels of trade

We direct our attention to the established, likely-to-continue channels of trade, the third *du Pont* factor. Applicant contends that Applicant's and Registrant's identified goods are sold in disparate, non-overlapping trade channels to different

¹³ *Id.* at 62-65.

consumers. As Applicant asserts, its goods are sold only through specialty retailers targeting medical professionals such as Scrubs & Beyond, Uniform City, and Uniform Advantage. In support thereof, Applicant has submitted excerpts from its own website and Registrant's to purportedly show that Applicant's medical apparel line is sold through brick-and-mortar and online retailers that sell uniforms for medical professionals either exclusively or in substantial part.¹⁴ By contrast, Applicant asserts that the evidence demonstrates that Registrant sells its women's sportswear through department stores such as Macy's, Belk and Lord & Taylor to the ordinary consumer.¹⁵

Applicant's argument is unpersuasive. Because the identifications in the application and cited registration have no restrictions on channels of trade, we must presume that the goods travel in all channels of trade appropriate for such goods. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). These trade channels include, as reflected in the record, retailers selling various brand name products as well as direct business-to-consumer (B2C) websites selling both medical apparel and women's sportswear. In addition, both parties' goods may be encountered by the same prospective consumers, namely female medical professionals. Hence, the third *du Pont* factor regarding the similarity or

¹⁴ June 30, 2016 Response to Office Action, TSDR at 15-22.

¹⁵ *Id.* at 8-14.

dissimilarity of established, likely to continue trade channels also favors a finding of likelihood of confusion.

D. The Number and Nature of Similar Marks in Use on Similar Goods

Lastly, we consider the number and nature of similar marks in use on similar goods, the sixth *du Pont* factor. In an *ex parte* appeal, “[t]he purpose of [an applicant] introducing third-party uses is to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different such marks on the bases of minute distinctions.” *Palm Bay*, 73 USPQ2d at 1694. *See also Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675-76 (Fed. Cir. 2015) (internal citations omitted). “[T]he strength of a mark is not a binary factor” and “varies along a spectrum from very strong to very weak.” *Juice Generation*, 115 USPQ2d at 1675-76 (internal citations omitted). “The weaker [the Registrant’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.” *Id.* at 1676 (internal citations omitted). *See also Palm Bay*, 73 USPQ2d at 1693 (“Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.”). “In determining the strength of a mark, we consider both its inherent strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark.”

American Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst., 101 USPQ2d 1022, 1028 (TTAB 2011) (citing *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) and *McCarthy on Trademarks and Unfair Competition* § 11:83 (4th ed. 2011) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”)).

Applicant maintains that the term GRACE is relatively weak and entitled to a narrow scope of protection as applied to apparel. In support thereof, Applicant has made of record three Principal Register third-party registrations for clothing:¹⁶ Registration No. 4722298 for the mark GRACE MMXIII; Registration No. 3681131 for the mark GRACE IN LOS ANGELES; and Registration No. 4420876 for the mark GRACE JEANS. 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 in a particular industry that the public will look to other elements to distinguish the source of the goods. *See Juice Generation*, 115 USPQ2d at 1674-75; *In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d

¹⁶ The third-party applications submitted by Applicant have little evidentiary value, if any. “Third-party applications, as opposed to registrations, have no probative value other than as evidence that the applications were filed.” TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 1208.02 (June 2017) (citing in Note 4 *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016); *In re Toshiba Medical Systems Corp.*, 91 USPQ2d 1266, 1270 n.8 (TTAB 2009); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366 n.7 (TTAB 2007); *In re 1st USA Realty Profls Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007); *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002)).

1910, 1911-12 (TTAB 1988); *Plus Prods. v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983). Applicant has not established with these relatively few registrations that GRACE is suggestive or descriptive or so commonly used in connection with clothing that the public will look to other elements to distinguish the source of the goods. *See Juice Generation*, 115 USPQ2d at 1674-75.

In addition, the record contains no evidence that the referenced third-party marks are in actual use or that consumers are aware of them. *See Palm Bay*, 73 USPQ2d at 1693 (“The probative value of third-party trademarks depends entirely upon their usage.”). Nor does the record include other examples of actual use of the trademarks consisting of or comprising the mark GRACE in the clothing field. Thus, the evidence before us falls short of a showing that would allow us to conclude that the cited mark is diluted and commercially weak for the relevant goods. *Compare Jack Wolfskin*, 116 USPQ2d at 1136 (“extensive” evidence not only of third-party registrations but also “of these marks being used in internet commerce” for the relevant goods); *Juice Generation*, 115 USPQ2d at 1671 (uncontradicted testimony of “a considerable number” of third party uses of similar marks, along with third-party registrations). We therefore deem this *du Pont* factor neutral.

III. Conclusion

We have carefully considered all of the evidence made of record, as well as all of the arguments related thereto, including any evidence and arguments not specifically discussed in this opinion. As indicated earlier, the identical nature of the marks weighs heavily in finding a likelihood of confusion. This, coupled with the related,

complementary nature of the goods which we must assume are offered in overlapping trade channels to consumers including female medical professionals, leads us to the conclusion that prospective consumers are likely to confuse the involved goods as originating from or associated with or sponsored by the same entity.

Decision: The Section 2(d) refusal to register Applicant's mark is affirmed as to International Classes 10 and 25.