

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: September 8, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*In re Mathis Ventures LLC*

Serial No. 86849413

Theodore R. Remaklus of Wood Herron & Evans LLP,  
for Mathis Ventures LLC.

Christine Martin, Trademark Examining Attorney, Law Office 104,  
Dayna Browne, Managing Attorney.

Before Cataldo, Bergsman and Masiello,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Mathis Ventures LLC (“Applicant”) seeks registration on the Principal Register of  
the mark GUILTY OF EVERYTHING GOE (in standard characters) for, *inter alia*,

Backpacks; waist packs; tote bags; carry-all bags; wallets in  
International Class 18,

T-shirts; tops; bottoms; jeans; sleepwear; swimwear; socks; gloves;  
mittens; hats; caps; footwear in International Class 25, and

Skateboard; surfboards; balls for sports; baseball bats in International  
Class 28.<sup>1</sup>

---

<sup>1</sup> Application Serial No. 86849413 was filed on December 15, 2015, based upon Applicant’s  
allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the

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 of likelihood of confusion with Registration No. 4773391 for the mark shown below ("SURF WEAR" disclaimed) for

Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; athletic pants; denims; hats; shoes; short-sleeved or long-sleeved T-shirts; shorts; surf wear; sweatpants; sweatshirts; swim wear; swimsuits; wetsuits in International Class 25.

The mark consists of "GOE SurfWear" in stylized letters in the shape of a diamond with a sparkle on the left corner and a wave on the right side.

Color is not claimed as a feature of the mark.<sup>2</sup>



When the refusal was made final, Applicant appealed. We reverse the refusal to register.

*Refusal of Registration under Section 2(d).*

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of

---

Trademark Act. The application identifies additional goods in International Classes 9, 10, 12, 14, 16, 18, 21, 25 and 28 that are not subject to the refusal of registration.

<sup>2</sup> Issued on July 14, 2015.

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 In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). We will address each of the *du Pont* factors for which Applicant and the Examining Attorney have submitted arguments and evidence.

*Relatedness of the goods.*

It is settled that in making our determination involving the similarity or dissimilarity of Applicant's goods and Registrant's goods, we must look to the goods as identified in the application vis-à-vis those recited in the cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Computers Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re Integrated Embedded*, 120 USPQ2d 1504, 1514 (TTAB 2016); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011). The respective goods 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 and/or services] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). *See also On-line Careline Inc. v. America Online*

*Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984). The issue here is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of these goods. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

Applicant's involved goods are identified as

Backpacks; waist packs; tote bags; carry-all bags; wallets in International Class 18,

T-shirts; tops; bottoms; jeans; sleepwear; swimwear; socks; gloves; mittens; hats; caps; footwear in International Class 25, and

Skateboard; surfboards; balls for sports; baseball bats in International Class 28.

The goods in the cited registration are identified as

Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; athletic pants; denims; hats; shoes; short-sleeved or long-sleeved T-shirts; shorts; surf wear; sweatpants; sweatshirts; swim wear; swimsuits; wetsuits in International Class 25.

The goods in the cited registration are identical in part to the goods in Class 25 of the involved application to the extent that both recite swimwear or swim wear, T-shirts or short-sleeved or long sleeved T-shirts, hats, caps and footwear. In addition, the Examining Attorney, in support of her contention that the goods at issue are commercially related, has made of record examples of web pages from third-party commercial internet sites offering for sale various items of athletic apparel identified

in the cited registration as well as goods identified in Applicant's application under the same mark.<sup>3</sup> Among these, we note the following:

ronjonsurfshop.com offers under the RON JON mark t-shirts, tops, short sleeved shirts, long sleeved shirts, bottoms, pants, athletic pants, surfboards, skateboards, tote bags, hats, caps, swimwear, surf wear;

mauiandsons.com offers under the MAUI AND SONS mark surfboards, swimwear, surf wear, shorts, tops, skateboards;

roxy.com offers under the ROXY mark wetsuits, bottoms, pants, tops, long sleeved shirts and short sleeved shirts, t-shirts, swimwear, jeans, denims, backpacks, footwear, shoes, hats and caps, wallets;

jackssurfboards.com offers under the JACKS SURFBOARDS mark surfboards, skateboards, denims, jeans, pants, t-shirts, long sleeved shirts, short sleeved shirts, shoes, footwear, hats and caps, tote bags, carry all bags, wallets;

billabong.com offers under the BILLABONG mark t-shirts, short sleeved shirts, wallets, hats and caps, backpacks, waist packs, jackets, swimwear, shoes and footwear.

These websites demonstrate that in the marketplace, third parties offer some of the goods in each of the three challenged classes of the application and the athletic wear identified in the cited registration under the same marks. We need not find similarity as to each and every product listed in the application and registration. For purposes of our analysis, it is sufficient that relatedness be established for any item encompassed by the identification of goods in a particular class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

---

<sup>3</sup> September 1, 2016 final Office action at 11-185.

As further evidence that Applicant's goods are related to those identified in the cited registration, the Examining Attorney has submitted copies of 15 use-based, third-party registrations listing, in their identifications, goods of a type identified in both Applicant's application and the cited registration.<sup>4</sup> The following examples are illustrative:

SO SO HAPPY and design for "Backpacks; Handbags; Tote bags; Wallets," "Belts for clothing; Footwear for men and women; Headwear; Hooded sweatshirts; Socks; Tee shirts," and "Plush toys; Skateboard decks" (U.S. Reg. No. 4164693);

LJ and design for "Backpacks, duffle bags, drawstring pouches," "Footwear; apparel, namely, jerseys, pants, shorts, t-shirts, shirts, sweatshirts, hooded sweatshirts, sweatpants, vests, tank tops, jackets, coats, socks, wrist bands, headbands, headwear, hats, caps, sweatbands, sweaters," and "Sports balls; basketballs" (U.S. Reg. No. 4254513);

JJ and design for "Backpacks; Schoolchildren's backpacks," "Athletic shoes; Baseball caps and hats; Hats; Sports shirts," and "Bags for skateboards; Bags specially adapted for sports equipment; Ball bearings for skateboards; Cases specially adapted for sports equipment; Protective padding for skateboarding; Skateboard decks; Skateboard grip tapes; Skateboard riser pads; Skateboard trucks; Skateboard wheels; Skateboards" (U.S. Reg. No. 4073985);

DESTROYER PROFESSIONAL SKATEBOARD EQUIPMENT and design for "Tote bags, backpacks, wallets," "Sweatshirts, t-shirts, jackets, headwear, footwear for skateboarding," and "Bags for skateboards; ball bearings for skateboards; nuts and bolts for skateboards; skateboard decks; skateboard grip tapes; skateboard rails; skateboard riser pads; skateboard trucks; skateboard wheels; skateboards; protective padding for skateboarding" (U.S. Reg. No. 4063925);

Design mark for "Leather bags, backpacks, luggage, wallets, leather key chains," "Clothing, namely, t-shirts, shirts, woven and knit shirts, tops, jackets, sweatshirts, sweaters, denim, namely, jeans, pants, board shorts, shorts, hats, belts, headwear, underwear, socks, gloves, footwear,

---

<sup>4</sup> *Id.* at 186-231.

work shoes and boots, motorcycle shoes and boots, automobile shoes and boots,” and “Skateboards.” (U.S. Reg. No. 4199858);

CONCORD in standard characters for “Shoulder bags, back packs, book bags, waist packs, school bags, all purpose sports bags, and tote bags,” “Clothing, namely, shirts, shorts, pants, jeans, t-shirts, jackets, pullovers, socks, hats, caps, gloves, and uniforms; footwear, namely, athletic shoes, soccer shoes, casual shoes, tennis shoes, sneakers, boots, sandals, and slippers” and “Sporting equipment, namely, athletic gloves for soccer, shin guards, and soccer balls” (U.S. Reg. No. 4834729);

A APACS and design for “All-purpose carrying bags; Bags for climbers in the nature of all-purpose carrying bags; Bags for sports; Carry-all bags; Hiking bags; Pocket wallets; Travelling bags; Waist bags; Waist pouches,” “Athletic footwear; Bottoms; Headbands; Inner soles; Shoes; Shorts; Slippers; Socks; Sport coats; Sports caps and hats; Tee shirts; Track jackets; Track pants; Track suits; Wrist bands,” and “Sport balls” (U.S. Reg. No. 4840514);

SUXESS in stylized form for “All-purpose athletic bags; Backpacks; Tote bags,” “Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Athletic shoes; Caps; Hats; Sandals and beach shoes; Shirts; Shoes; Socks; Swim suits; T-shirts,” and “Balls for games” (U.S. Reg. No. 4654077).

Third-party registrations that are based on use in commerce have some probative value to the extent that they suggest that the listed goods are of types which may emanate from the same source. *See In re Association of the United States Army*, 85 USPQ2d 1264, 1270 (TTAB 2007); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). Although such registrations do not prove that the registered marks are actually used in the marketplace on both Applicant’s goods and the goods identified in the cited registration, they at least demonstrate that a number of third parties have sought and obtained registrations of marks for use on both types of goods.

Applicant acknowledges: “It is undeniably true that both Applicant’s mark and the cited mark are used with some types of clothing, and that there may, as a result, be some overlap in the types of goods offered under each mark.”<sup>5</sup> Applicant does not otherwise argue or present evidence regarding the relatedness of the goods.

As discussed above, the evidence of record suggests that third parties use and register marks to indicate the source of both Applicant’s goods and Registrant’s goods. The Internet evidence in particular suggests that these goods are available to consumers on the same websites. In light of the foregoing evidence, we find that the goods of Applicant and Registrant are commercially related, and that the *du Pont* factor relating to the similarity or dissimilarity of the goods weighs in favor of a finding of likelihood of confusion.

*Trade channels.*

The only evidence relating to the trade channels through which the goods at issue travel is the third-party website evidence submitted by the Examining Attorney, discussed above. We recognize that a potentially infinite variety of goods are available on the internet. Nonetheless, this evidence shows that certain websites feature the goods of both Applicant and Registrant under the same marks. These are not retail aggregation or department store sites that offer a wide variety of goods, but rather websites devoted to clothing, athletic apparel and equipment, and packs and bags. We find the evidence sufficient to show that, in the virtual marketplace, goods of the types identified by Applicant and Registrant are offered by the same retailers.

---

<sup>5</sup> 4 TTABVue 8.



Accordingly, the *du Pont* factor relating to the similarity or dissimilarity of established, likely-to-continue trade channels favors a finding of likelihood of confusion.

*Similarity and dissimilarity of the marks.*

We turn then to the first *du Pont* factor, i.e., whether Applicant's GUILTY OF EVERYTHING GOE mark (in standard characters) and Registrant's



mark, are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 110 USPQ2d at 1160 (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)). The similarity or dissimilarity of the marks is determined based on the marks in their entireties, and the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *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”).

In comparing Applicant’s mark and the registered mark, we note that the marks are similar to the extent that the first word of the registered mark, “GOE,” is identical to the last word of Applicant’s mark in appearance and sound. The marks are dissimilar with respect to the wording “GUILTY OF EVERYTHING” preceding “GOE” in Applicant’s mark and the wording “SURF WEAR” and the design in the registered mark. The term “GOE” in Applicant’s mark appears to be an acronym or initialism of the preceding wording “GUILTY OF EVERYTHING,” while evidence of record indicates that the wording “GOE” in the registered mark is the surname of the registration’s owner.<sup>6</sup> However, there is no additional evidence by which we may determine whether or to what extent consumers would recognize the surname significance of “GOE” in the registered mark. On the other hand, there is no evidence to indicate that customers would perceive GOE, as used in Registrant’s mark, as an abbreviation for GUILTY OF EVERYTHING. There is no evidence of any third-party registration of a mark containing “GOE.”

We also observe that “SURF SHOP” is disclaimed in the registered mark and appears to be descriptive of the goods recited in the registration. We find, therefore, that the term “GOE” and diamond design in which the wording appears are the dominant portions of the registered mark, and accordingly they are entitled to more weight in our analysis. It is a well-established principle that, in articulating reasons

---

<sup>6</sup> September 1, 2016 final Office action at 232-5; April 6, 2016 first Office action at 29.

for reaching a conclusion on the issue of likelihood of confusion, 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. *In re National Data Corp.*, 224 USPQ at 751. However, the wording “GUILTY OF EVERYTHING” in the mark GUILTY OF EVERYTHING GOE also appears to be arbitrary and distinctive as applied to the identified goods, and thus is as at least as prominent as the term “GOE” in Applicant’s mark.

As a result, when the marks GUILTY OF EVERYTHING GOE and



presented in its very specific design format are viewed in their entireties, they are more dissimilar than similar in appearance and sound and convey different connotations, namely, that Applicant’s mark acknowledges and celebrates even disreputable actions while the registered mark indicates surf wear originating from an individual named Goe.

In view of the foregoing, we find that the similarities in the marks are outweighed by the differences, and that this *du Pont* factor weighs against a finding of likelihood of confusion.

*Balancing the factors.*

After considering all of the evidence of record and arguments pertaining to the *du Pont* likelihood of confusion factors, we find that while the goods are related and

appear to be offered in the same channels of trade, the purchasers of these goods will distinguish the marks which, as discussed above, are only somewhat similar. In view thereof, we find that Applicant's mark, if used in connection with the goods identified in the application, is not likely to cause confusion with the registered mark in connection with the goods recited in the registration.

***Decision:*** The likelihood of confusion refusal to register Applicant's marks is reversed.