

<p>This Opinion is not a Precedent of the TTAB</p>
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Hearing: February 15, 2022

Mailed: February 18, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sunrise Apparel Group, LLC

Serial No. 88571635

Jill M. Pietrini of Sheppard Mullin Richter & Hampton LLP for
Sunrise Apparel Group, LLC

Dominic Ferraiuolo, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.

Before Wellington, Heasley, and Johnson,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Applicant, Sunrise Apparel Group, LLC, seeks registration on the Principal Register of the mark **AMERICAN STAR** (in standard characters, with “AMERICAN” disclaimed) for “clothing, namely, jeans, bottoms, pants, shorts, skirts, shirts, vests, tops, blouses, dresses, coats, sweaters, t-shirts, jackets; headwear; and footwear” in International Class 25.¹

¹ Application Serial No. 88571635 was filed on August 8, 2019, based on a declared intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Citations to the prosecution file refer to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system and identify the documents by title, date, and page in the

The Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as used in connection with these goods, so resembles the registered mark **AMERICAN STAR** (in standard characters, with "AMERICAN" disclaimed) for "jewelry," in International Class 14, as to be likely to cause confusion, to cause mistake, or to deceive.²

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal proceeded. The appeal has been fully briefed, including a reply brief from Applicant. An oral hearing was held on February 15, 2022.

We affirm the refusal to register.

I. Likelihood of Confusion

Section 2(d) of the Trademark Act provides that an applied-for mark may be refused registration if it "[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive...." 15 U.S.C. § 1052(d).

To determine whether there is a likelihood of confusion between the marks under Section 2(d), we analyze the evidence and arguments under the *DuPont* factors. *In re*

downloadable .pdf version. References to the briefs and other materials in the appeal record refer to the Board's TTABVue online docketing system.

² Registration No. 4499123, issued on the Principal Register on March 18, 2014, renewed.

E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). We consider each *DuPont* factor for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. ... Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, *3 (Fed. Cir. 2020). “In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services.” *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, *29 (TTAB 2021) (citing *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)).

A. Similarity of the Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant’s and Registrant’s marks in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014).

The marks here are identical in all of these respects. See *In re Country Oven*, 2019 USPQ2d 443903, *3 (TTAB 2019). And since both are in standard characters, both could be displayed in the same lettering style or font. *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017).

For these reasons, the first *DuPont* factor weighs heavily in favor of finding a likelihood of confusion. *Id. cited in In re Embiid*, 2021 USPQ2d 577, *21-22 (TTAB 2021).

B. Relatedness of the Goods, Channels of Trade, and Classes of Customers

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration...,” and the third *DuPont* factor concerns the “similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567; *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1161. We must make our determinations under these factors based on the goods as they are identified in the application and cited registration. *Id.*; *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018). A proper comparison of the goods “considers whether ‘the consuming public may perceive [the respective goods or services 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.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002)). Because the marks are identical, the degree of similarity between the goods required for confusion to be likely declines. *DeVivo v. Ortiz*, 2020 USPQ2d 10153, *11 (TTAB 2020).

Applicant argues that the goods offered under the respective marks—Applicant’s “clothing, namely, jeans, bottoms, pants, shorts, skirts, shirts, vests, tops, blouses, dresses, coats, sweaters, t-shirts, jackets; headwear; and footwear” and Registrant’s “jewelry”—are not marketed in such a way that a mistaken belief of common source

would likely arise.³ “Applicant has not applied to register its mark for jewelry, and Registrant has not applied to register her mark for apparel in all this time,” Applicant notes.⁴ Applicant quotes the TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) for the proposition that there is no likelihood of confusion “if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source” TMEP § 1207.01(a)(i) (July 2021) (citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) and *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990)).⁵

That same section of the TMEP also observes, however, that:

The issue is not whether the goods and/or services will be confused with each other, but rather whether the public will be confused as to their source. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) “[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.”.... It is sufficient that the goods and/or services of the applicant and the registrant are related in some manner or that the conditions surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that, because of the marks used in connection therewith, would lead to the mistaken belief that they originate from the same source.

TMEP § 1207.01(a)(i). *See Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d

³ Applicant’s brief, 8 TTABVUE 15.

⁴ *Id.* at 16.

⁵ *Id.* at 15.

1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) *cited in Chutter, Inc. v. Great Mgmt. Grp.*, 2021 USPQ2d 1001, *42 (TTAB 2021).

In *Ritz* and *Handy Boys*, on which Applicant relies, the relatedness of the respective goods and services was not supported by substantial evidence: *Ritz* concerned cooking and wine selection classes versus kitchen textiles, and *Handy* concerned liquid drain opener versus advertising services in the plumbing field.

In this case, in contrast, the Examining Attorney has adduced substantial evidence showing that apparel and jewelry are not only related, but complementary. Seven use-based third-party registrations demonstrate that a single entity may offer clothing and jewelry under the same mark.⁶ For example:

Registration No.	Mark	Pertinent Goods
5831608	PINEDA COVALIN	Jewelry, costume jewelry IC 14 Shawls, scarves, dresses, shirts, jackets IC 25.
5911915	INNER JASMINE	Jewelry IC 14 Clothing, namely, shirts and pants IC 25
5802291	UNCLENCH	Jewelry IC 14 T-shirts; tops as clothing IC 25
5799190	KIEL JAMES PATRICK	Jewelry; necklaces; rings IC 14 Bandanas; dresses; hats; pants; shirts; skirts; socks; sweaters; sweatshirts IC 25

⁶ Nov. 22, 2019 Office Action at TSDR 7-26.

See Country Oven, 2019 USPQ2d 443903, at *8-9 (“As a general proposition, third-party registrations that cover goods and services from both the cited registration and an Applicant’s application are relevant to show that the goods and services are of a type that may emanate from a single source under one mark.”) (citing *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis”)).

The Examining Attorney adds eight third-party webpages showing that clothing and jewelry are not only offered under the same mark by the same retailers, such as Bloomingdale’s and Red Dress,⁷ but paired with one another. For example:



~ CLASSICS ~



~ MULTI-COLORED BANDS ~

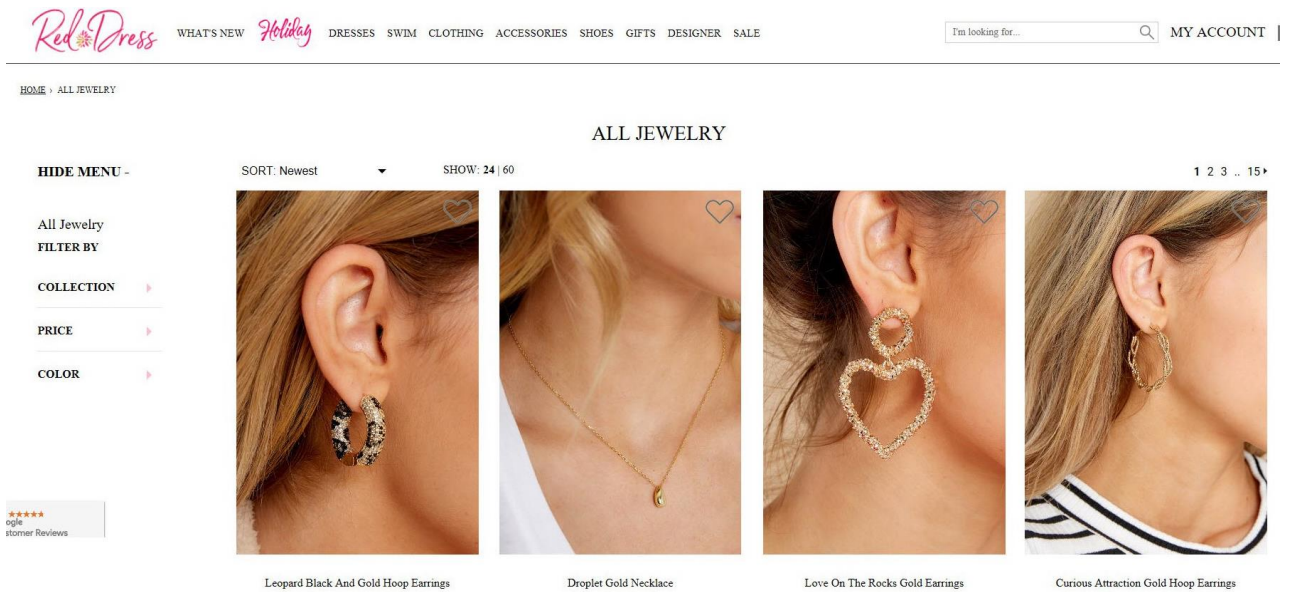


~ THE BELLA DRESS ~

8

⁷ Jan. 4, 2021 Office Action at 19-45; July 22, 2021 Office Action at 5-50.

⁸ VanessaMoney.com, Jan. 4, 2021 Office Action at 21.



9

How to Decide on What Jewelry to Pair with Your Outfit

Posted by Roam Often on November 14, 2020



10

⁹ RedDress.com, Jan. 4, 2021 Office Action at 38.

¹⁰ RoamOften.com, July 7, 2021 Office Action at 18.



11

1. What jewelry to wear with a V-neck dress:

A V-neck may be the most versatile neckline when it comes to necklace options. You can either mirror the V-shape with your necklace, or compliment it with a curve. For a short V-neck, a choker or short chain is the way to go. As the V-neck gets deeper, the options multiply! Chokers, chains, and short to medium pendant necklaces are all great for medium V-necks. Deep V-necks are great with a lariat or sautoir necklace, and also lend well to layers of necklaces. Above all, be sure to never choose a necklace that sits below the V.



12

¹¹ PrettyDesigns.com, *id.* at 31.

¹² MerionCage.com, *id.* at 45.

November 18, 2020

How to Accessorize: How to Pick Jewelry to Match Any Outfit

By Laura Janelle 1

[Leave a Comment](#)



13

This third-party evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both clothing and jewelry. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018). It shows, moreover, that the goods are complementary, as they can be paired together. In that respect, it resembles *In re Melville*, in which the Board considered the complementary nature of women's clothing and shoes:

A woman's ensemble, which may consist of a coordinated set of pants, a blouse and a jacket, is incomplete without a pair of shoes which match or contrast therewith. Such goods are frequently purchased in a single shopping expedition. When shopping for shoes, a purchaser is usually looking for a shoe style or color to wear with a particular outfit. The items sold by applicant and registrant are considered to be complementary goods.

In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991).

¹³ LauraJanelle.com, *id.* at 13.

Here, as in *Melville*, clothing and jewelry may be purchased from the same retailer by the same consumers as part of a coordinated outfit. “[J]ewelry and women’s wearing apparel are sold and promoted through the same channels of trade to the same classes of purchasers, they are displayed and worn together, they may be purchased at the same time for coordinated wardrobes....” *David Crystal, Inc. v. Dawson*, 156 USPQ 573, 574 (TTAB 1967). And since there are no limitations as to channels of trade or classes of purchasers in the Application or the cited Registration, we must presume that the identified goods move in all channels of trade normal for such goods and are available to all potential classes of ordinary consumers of such goods. *In re I-Coat Company, LLC*, 126 USPQ2d 1730, 1737 (TTAB 2018).

We find accordingly that the second and third *DuPont* factors weigh in favor of finding a likelihood of confusion.

C. The Strength or Weakness of the Cited Registered Mark

Under the fifth and sixth *DuPont* factors, we consider the strength of the cited registered mark, and the degree to which that strength may be attenuated by “[t]he number and nature of similar marks in use on similar goods.” *DuPont*, 177 USPQ at 567.

These factors address the strength of a mark with respect to both its inherent strength, based on the nature of the term itself, and its commercial strength, based on the marketplace recognition value of the term as a mark. *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014) (citing *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010)

(“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength”)).

Applicant contends that the cited mark, **AMERICAN STAR**, is conceptually and commercially weak, and thus is not entitled to a wide scope of protection.

1. Conceptually

“First,” Applicant contends, “both Applicant and Registrant have disclaimed “AMERICAN” in their respective marks, which is a concession that the term AMERICAN is not entitled to a wide scope of protection.”¹⁴ If an applied-for mark contains “AMERICAN”, Applicant points out, the Trademark Manual of Examining Procedure requires the examining attorney to evaluate the entire mark to determine whether it is merely descriptive as laudatory or even incapable.¹⁵ TMEP § 1209.03(n). “Therefore,” Applicant concludes, “the Cited Mark is not conceptually strong....”¹⁶

But because the cited mark, **AMERICAN STAR**, is registered on the Principal Register, it is entitled to all Section 7(b) presumptions, including the presumption that it is distinctive. 15 U.S.C. § 1057(b). *See Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1889 (TTAB 2006). So even though “AMERICAN” is disclaimed as geographically descriptive, we must presume that the mark as a whole is at least suggestive. *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007) (citing *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997)) *cited in*

¹⁴ Applicant’s brief, 8 TTABVUE 13.

¹⁵ Applicant’s reply brief, 11 TTABVUE 5.

¹⁶ *Id.*

In re Fat Boys Water Sports LLC, 118 USPQ2d 1511, 1517 (TTAB 2016). It may not be “strong,” as the Examining Attorney states,¹⁷ but it is distinctive.

Applicant points to five third-party registered marks incorporating AMERICAN and STAR in Classes 14 or 25¹⁸—AMERICA’S FINEST SILVER STAR CASTING COMPANY & Design,¹⁹ AMERICA’S STARSPANGLED KIDS,²⁰ STARS OF AMERICAN BALLET,²¹ STARS OF AMERICAN BALLET & Design,²² and AMERICAN GOLD STAR MOTHERS²³—to show that “the words AMERICAN and STAR in the Cited Mark are diluted through use by many apparel manufacturers and accessories manufacturers and are consequently weak marks for such goods.”²⁴

We agree with the Examining Attorney, however, that these third-party registrations are entitled to little weight.²⁵ The first, AMERICA’S FINEST SILVER STAR CASTING COMPANY & Design, is cancelled.²⁶ *In re Embiid*, 2021 USPQ2d 577, at *35 n. 48 (“The existence of a cancelled registration—particularly one

¹⁷ Examining Attorney’s brief, 10 TTABVUE 4.

¹⁸ June 30, 2021 Response to Office Action (request for reconsideration) ex. C, at 261-393.

¹⁹ Reg. No. 2278745 cancelled, (formerly for “jewelry and watches made in whole or part of silver” in Class 14).

²⁰ Reg. No. 2709705, formerly for “watches” in Class 14 and “hats, sweat shirts and T-shirts” in Class 25, although the identified goods in both classes have been deleted (“AMERICA’S” and “KIDS” disclaimed).

²¹ Reg. No. 4561071 for “hats, shirts” in Class 25 (“AMERICAN BALLET” disclaimed).

²² Reg. No. 4561072 for “hats; shirts” in Class 25 (“AMERICAN BALLET” disclaimed).

²³ Reg. No. 4754625 for, inter alia, “jewelry, namely, commemorative challenge coins, pins and pendants; grave markers of precious metal” in Class 14 and “clothing, namely, jackets, polo shirts, hooded sweatshirts, hats, caps” in Class 25 (“AMERICAN” and “MOTHERS” disclaimed).

²⁴ Applicant’s reply brief, 11 TTABVUE 5.

²⁵ Examining Attorney’s brief, 10 TTABVUE 5.

²⁶ Reg. No. 2278745 cancelled.

cancelled for failure to provide a declaration of continued use—does not tend to show that the cited mark is weak due to third-party use.”). The second, AMERICA’S STARSPANGLED KIDS, deleted the clothing and jewelry goods.²⁷ The third and fourth, STARS OF AMERICAN BALLET,²⁸ and STARS OF AMERICAN BALLET & Design,²⁹ are owned by the same registrant and, by their wording, directed to a narrow audience of ballet followers. And the fifth, by its wording, AMERICAN GOLD STAR MOTHERS, is devoted to commemorative goods directed to mothers of deceased service members.³⁰

“The probative value of Applicant’s evidence is further diminished inasmuch as many of the third-party registrations ... include additional wording and design elements not found in the cited registration or involved application, that engender a different commercial impression from either mark.” *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016). None is as similar to the cited registered mark as Applicant’s mark. *See Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, *25 (TTAB 2021). Accordingly, we find that these few third-party registrations “do not

²⁷ Reg. No. 2709705 for “watches” in Class 14 and “hats, sweat shirts and T-shirts” in Class 25, although the identified goods in both classes have been deleted.

²⁸ Reg. No. 4561071 for “hats, shirts” in Class 25 as well as “entertainment services in the nature of dance performances” in Class 41 (“AMERICAN BALLET” disclaimed). June 30, 2021 Response to Office Action (request for reconsideration) ex. C, at 295-309.

²⁹ Reg. No. 4561072 for “hats; shirts” in Class 25 as well as “entertainment services in the nature of dance performances” in Class 41 (“AMERICAN BALLET” disclaimed). June 30, 2021 Response to Office Action (request for reconsideration) ex. C, at 310-323.

³⁰ Reg. No. 4754625 for, inter alia, “jewelry, namely, commemorative challenge coins, pins and pendants; grave markers of precious metal” in Class 14 and “clothing, namely, jackets, polo shirts, hooded sweatshirts, hats, caps” in Class 25 (“AMERICAN” and “MOTHERS” disclaimed). June 30, 2021 Response to Office Action (request for reconsideration) ex. C, at 324-345.

diminish the distinctiveness of the cited mark or its entitlement to protection against Applicant's mark." *In re Information Builders Inc.*, 2020 USPQ2d 10444, *8 (TTAB 2020) (citing *Palisades Pageants, Inc. v. Miss Am. Pageant*, 442 F.2d 1385, 169 USPQ 790, 793 (CCPA 1971) (discounting the probative value of third-party registrations where "appellant's mark is closer to appellee's than even the closest of the third-party registrations"))).

2. Commercially

Commercially, the marketplace strength or "fame" of the cited mark, **AMERICAN STAR**, is presumptively treated as neutral, since the owner of the cited registration is not a party to this *ex parte* appeal, and the Examining Attorney, with his somewhat limited resources, is not expected to submit evidence of commercial strength. *See, e.g., In re Pacer Tech.*, 338 F.3d 1348, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1086-88 (TTAB 2016) (citing *In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006)). *See generally* TMEP § 1207.01(d)(ix).

Applicant attempts to attenuate the cited mark's commercial strength by pointing to approximately a dozen third-party websites using "AMERICAN" with "STAR":

- AMERICAN STAR CLOTHING – second hand clothes dealer at <americanstarclothing.com>
- THE AMERICAN STAR COMPANY – flag products built with reclaimed wood and cast iron stars at <americanstarcompany.com>;
- AMERICAN STAR women's Bismark boot cut jeans at <tractorsupply.com>;
- AMERICAN STAR men's cotton boxer shorts underwear at <sears.com>;
- ART'S STAR AMERICAN leather men's two pocket jacket at <amazon.ca>;
- AMERICAN STAR branding iron gift box at <patriotpostshop.com>;
- EVERGREEN STAR OF AMERICA jewelry company at <yelp.com>;
- AMERICAN STAR APPAREL t-shirts at <americanstarapparel.com>;
- STAR AMERICA, INC. hosiery at <industry.net>;
- TOMMY HILFINGER AMERICAN STAR fragrance gift set at <usa.tommy.com>;

- AMERICAN STAR clothing brand at <americanstar-ltd.com>;
- AMERICAN STAR t-shirt at <store.countryrebel.com>³¹

Applicant submits that this evidence is even more compelling than its third-party registration evidence because “evidence of third-party use of similar marks on similar goods can show that customers have been educated to distinguish between different marks on the basis of minute distinctions.”³² *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) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (quoting 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:88) (quoting in turn *Standard Brands, Inc. v. RJR Foods, Inc.*, 192 USPQ 383, 385-86 (TTAB 1976)))).

Applicant contends that this case resembles *In re FabFitFun, Inc.*, 127 USPQ2d 1670 (TTAB 2018) where the Board held that the mark **I'M SMOKING HOT** for cosmetics was not likely to be confused with the registered mark **SMOKIN' HOT SHOWTIME** for cosmetics. The Board found the shared component **SMOKIN' HOT** “somewhat weak,” in light of its dictionary definition, “attractive, sexy looking, very hot,” which is highly suggestive of the purpose of cosmetics, plus evidence of ten third-party uses of **SMOKIN' HOT** formative marks for cosmetics products, all of which “tend to show consumer exposure to third-party use of the term on similar goods.” *Id.* at 1673-75.³³

³¹ Applicant's reply brief, 11 TTABVUE 6; Applicant's June 30, 2021 Response to Office Action (request for reconsideration) ex. D, 346-393.

³² *Id.*

³³ Applicant's brief, 8 TTABVUE 14.

We find Applicant's reliance on *FabFitFun* unavailing. In *FabFitFun*, the Board found the applicant's ten third-party uses were "a more modest amount of evidence" and was not "as persuasive as that in either *Juice Generation* or *Jack Wolfskin*." *Id.* at 1674-75. It concluded that the third-party evidence weakened part of the cited registered mark, but not the entire mark:

The registered mark, **SMOKIN' HOT SHOW TIME**, on the other hand, has not been shown to be either particularly strong or particularly weak. On balance, we do not believe that, on this record, the relative strength of the cited mark in its entirety weighs significantly one way or the other. Rather, the relative weakness of the component term **SMOKIN' HOT** common to both marks weighs somewhat in favor of a finding of no likelihood of confusion.

Id. at 1675.

In other words, the common element **SMOKIN'[G] HOT** was "weak as a source identifier in the field of cosmetics," *id.* at 1673, so consumers could distinguish between the two marks—**I'M SMOKING HOT** and **SMOKIN' HOT SHOW TIME**—on the basis of "minute distinctions," *Jack Wolfskin*, 116 USPQ2d at 1136.

Here, we have about the same 'modest amount of evidence' that the Board found not "as persuasive as that in either *Juice Generation* or *Jack Wolfskin*." *FabFitFun*, 127 USPQ2d at 1674-75. In *Jack Wolfskin*, the applicant adduced evidence of 87 third-party registrations of paw logos and 28 web page excerpts of the use of paw logos on clothing; the Federal Circuit characterized this as "voluminous evidence of paw print design elements that have been registered and used in connection with clothing..." *Jack Wolfskin*, 116 USPQ2d at 1136. And in *Juice Generation*, there were at least twenty-six relevant third-party uses or registrations of record, supported by testimony of Juice Generation's founder that a considerable number of third parties

used similar marks. *Juice Generation*, 115 USPQ2d at 1673 n.1.

Here, Applicant presents a handful of third-party registrations of questionable pertinence. To this it adds about a dozen Internet webpages showing third-party uses. Of those, we may discount three third-party uses with unrelated goods: THE AMERICAN STAR COMPANY – flag products built with reclaimed wood and cast iron stars; AMERICAN STAR branding iron gift box; and TOMMY HILFIGER AMERICAN STAR fragrance gift set. See *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1694 (Fed. Cir. 2018) (“It is less relevant that [the mark] is used on unrelated goods or services....”) (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)). That leaves some examples of AMERICAN STAR’s use on clothing items, but virtually none on jewelry, aside from EVERGREEN STAR OF AMERICA, which, to say the least, does not convey the same commercial impression. Taken together, Applicant’s evidence “is a far cry from the large quantum of evidence of third-party use and third-party registrations that was held to be significant in both *Jack Wolfskin* and *Juice Generation*.” *Sabhnani v. Mirage Brands*, 2021 USPQ2d at *25-26 (quoting *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) *aff’d* 777 Fed. Appx. 516 (Fed. Cir. 2019)).

As in *FabFitFun*, the component AMERICAN may be weak, but the entire mark, AMERICAN STAR, has not been shown to be either particularly strong or particularly weak. *Id.* at 1675. And unlike *FabFitFun*, consumers cannot distinguish Applicant’s and Registrant’s **AMERICAN STAR** marks “on the basis of minute distinctions” because the two marks are identical, with no other distinguishing

features.

In sum, Applicant's third-party evidence does little to attenuate the conceptual or commercial strength of the cited registered mark. Without any demonstrated meaningful weakness, the fifth and sixth *DuPont* factors are neutral in our likelihood of confusion analysis. Accordingly, we accord Registrant's AMERICAN STAR mark the normal scope of protection to which a distinctive mark is entitled. 15 U.S.C. § 1057(b); see *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (stating that likelihood of confusion fame varies along a spectrum from very strong to very weak).

D. Applicant's Prior Registration

The thirteenth *DuPont* factor pertains to "any other established fact probative of the effect of use," *DuPont*, 177 USPQ at 567, and "accommodates the need for flexibility in assessing each unique set of facts...." *Country Oven*, 2019 USPQ2d 443903, at *15.

Applicant argues that the Examining Attorney's refusal to register is illogical and inconsistent. Applicant owned a prior registration, No. 3276146 (the "Prior Registration"), for AMERICAN STAR for "clothing, namely, jeans, bottoms, pants, shorts, skirts, skorts, shirts, t-shirts, vests, tops, blouses, dresses, jumpsuits, coats, sweaters, jackets; footwear and headwear," which issued in 2007 and was assigned to Applicant in 2013. The Office did not cite the Prior Registration as a bar to registration of the Cited Mark, AMERICAN STAR for "jewelry," even though the underlying application for the Cited Mark was filed in 2012 and its registration issued in 2014. The two registrations—Applicant's for clothing and Registrant's for

jewelry—coexisted for four years, until Applicant’s Prior Registration was cancelled on March 9, 2018 for failure to file an Affidavit of Use.³⁴

Over a year after its Prior Registration was cancelled, Applicant filed the subject Application to re-register the identical mark for the same goods. It contends that “[i]t is illogical and contrary for the Office to cite the Cited Mark against Applicant’s mark **now** when the Office did not cite Applicant’s Prior Registration against the Cited Mark during the prosecution of the Cited Mark.”³⁵ Given that Applicant’s Prior Registration and Registrant’s Cited Mark coexisted on the Principal Register for four years, Applicant maintains, “there is no harm in re-registration of Applicant’s identical mark for the same goods.” It cites *In re Thomas Nelson Inc.*, 97 USPQ2d 1712 (TTAB 2011) (finding the Examining Attorney’s refusal to register the acronym NKJV for “New King James Bible” on the basis of no acquired distinctiveness under Section 2(f) “illogical” when the applicant already had two prior registrations for the acronym NJKV & Design and for the acronym used alongside its full verbal equivalent, NJKV NEW KING JAMES VERSION, for the same goods, under Section 2(f)).

“Simply put,” Applicant concludes, “if there were no likelihood of confusion between the Prior Registration and the Cited Mark from November 11, 2012 (filing date for the Cited Mark) to March 9, 2018 (cancellation date for the Prior

³⁴ Applicant’s brief, 8 TTABVUE 6. May 22, 2020 Response to Office Action, ex. C at 22-29; June 30, 2021 Response to Office Action (request for reconsideration) exs. A, B at 32-260.

³⁵ Applicant’s brief, 8 TTABVUE 11-12.

Registration), there certainly is no likelihood of confusion now.”³⁶ “At the very least, the Office should strive to be consistent in its examination, and instituted the Consistency Initiative to assist in achieving consistent examination of trademark applications.”³⁷

Although we sympathize with Applicant, we find its argument unpersuasive. In *Thomas Nelson*, on which it relies, the applicant still owned the two prior registrations for similar marks. *Id.* at 1713, 1718. “Where an applicant **owns** a prior registration and the mark is ‘substantially the same’ as in the applied-for application, this can weigh against finding that there is a likelihood of confusion.” *In re Embiid*, 2021 USPQ2d 577, *42 (TTAB 2021) (emphasis added) (quoting *In re Strategic Partners Inc.*, 102 USPQ2d 1397, 1399 (TTAB 2012)). But “there is no rule that a prior registration entitles a party to another registration.” *Country Oven*, 2019 USPQ2d 443903, at *18.

Unlike *Thomas Nelson* and *Strategic Partners*, Applicant’s prior registration has been cancelled. The cancelled registration is not entitled to any of the presumptions of Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). *Embiid*, 2021 USPQ2d 577 at *35n.48. *See Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 178 USPQ 46, 47 (CCPA 1973) (“Whatever benefits a registration conferred upon appellee were lost by him when he negligently allowed his registration to become canceled.”); *In re Hunter Publ’g Co.*, 204 USPQ 957, 963 (TTAB 1979) (cancellation “destroys the Section [7(b)] presumptions and makes the question of registrability ‘a new ball game’ which must

³⁶ *Id.* at 12.

³⁷ Applicant’s reply brief, 11 TTABVUE 3.

be predicated on current thought.”).

While we recognize that consistency is highly desirable, “consistency in examination is not itself a substantive rule of trademark law, and a desire for consistency with the decisions of prior examining attorneys must yield to proper determinations under the Trademark Act and rules.” *In re Am. Furniture Warehouse CO*, 126 USPQ2d 1400, 1407 (TTAB 2018). “The fact that, whether because of administrative error or otherwise, some marks have been registered even though they may be in violation of the governing statutory standard does not mean that the agency must forgo applying that standard in all other cases.” *In re Boulevard Entm’t Inc.*, 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003); *accord In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) (“The PTO is required to examine all trademark applications for compliance with each and every eligibility requirement . . . even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect.”).

Ultimately, the Board must decide each case on its own merits; the Office’s allowance of prior registrations does not bind it. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). “While it must consider each factor for which it has evidence, the Board may focus its analysis on dispositive factors, such as similarity of the marks and relatedness of the goods.” *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001). In this case, we focus our analysis on the identical nature of the marks and the complementary relatedness of the goods. The thirteenth *DuPont* factor is neutral, and does not affect our balancing of the other *DuPont* factors.

II. Conclusion

When we consider the record and the relevant likelihood of confusion factors, and all of Applicant's arguments relating thereto, we conclude that consumers familiar with Registrant's jewelry goods offered under its mark would be likely to believe, upon encountering clothing goods offered under Applicant's mark, that the goods originated with or are associated with or sponsored by the same entity. There is therefore a likelihood of confusion under Section 2(d) of the Trademark Act. 15 U.S.C. § 1052(d).

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