

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: September 29, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re American Branding Agency, Corporation
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Serial No. 88683570
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Pablo Meles of Pablo Meles, PA,
for American Branding Agency, Corporation.

Won T. Oh, Trademark Examining Attorney, Law Office 114,
Laurie Kaufman, Managing Attorney.

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Before Bergsman, Goodman, and Coggins,
Administrative Trademark Judges.

Opinion by Coggins, Administrative Trademark Judge:

American Branding Agency, Corporation (“Applicant”) seeks registration on the Principal Register of the stylized mark ICY shown at right  for “sunglasses,” in International Class 9; and, as amended, “footwear; headbands; hoodies; jerseys; pants; sneakers; sweat pants; hooded sweat shirts,” in International Class 25.¹ According to the application, “[t]he

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¹ Application Serial No. 88683570 was filed on November 7, 2019, 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.

mark consists of [t]he literal term ICY with multilayered shading patterns,” and “[c]olor is not claimed as a feature of the mark.”

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as applied to the Class 25 clothing goods identified in the application,² so resembles the mark ICEE (in typed form) on the Principal Register for “t-shirts, hats, sweatshirts and jackets” in International Class 25,³ as to be likely to cause confusion, to cause mistake, or to deceive.

When the refusal was made final Applicant requested reconsideration twice and was denied each time. Applicant then appealed to this Board and requested suspension of the appeal claiming it had filed a request for reconsideration of the refusal to register.⁴ Although no new request for reconsideration was filed and there was no outstanding request pending, the Examining Attorney nonetheless issued an action denying reconsideration and noting that Applicant had not raised a new issue,

² Applicant’s Class 9 sunglasses were not refused registration and are not subject to this appeal.

³ Registration No. 1942417, issued December 19, 1995; renewed. The registration identifies goods and services in seven other classes, but they were not cited against Applicant’s Class 25 goods.

⁴ 1 TTABVUE. When an applicant files an appeal through ESTTA and checks the “request for reconsideration” box on the ESTTA form, the system automatically generates an order instituting the appeal, suspending further proceedings with respect to the appeal, and remanding the application to the examining attorney for consideration of the request. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1204 (June 2020). In this appeal, Applicant checked the box but did not file a new request for reconsideration.

Citations to the filings and briefs in the appeal record refer to the TTABVUE docket system. Citations to the prosecution file refer to the .pdf version of the TSDR system record. *In re Consumer Protection Firm*, 2021 USPQ2d 238, *3 n.3 (TTAB 2021).

provided any new evidence, or shed new light on the refusal. The appeal was then resumed and briefed. We reverse the refusal to register.

I. Preliminary Issues

The Examining Attorney submitted for the first time with his brief the definition of “icy” from MERRIAM-WEBSTER.COM DICTIONARY with an implied request that the Board take judicial notice thereof.⁵ Applicant did not file a reply brief or otherwise object to this evidence. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 710.01(c) (July 2021). While the better practice would have been for the Examining Attorney to ensure that the relevant entry was included in the record prior to appeal, it is well-established that the “Board may take judicial notice of definitions . . . that were not made of record prior to appeal, and may do so either sua sponte or upon request of the . . . examining attorney.” *Id. See also In re Premiere Distillery LLC*, 103 USPQ2d 1483, 1484 n.2 (TTAB 2012) (judicial notice taken of definition submitted with examining attorney’s brief after appeal filed); TBMP § 1208.04. In view of this established practice we grant the implied request and will consider the definition of “icy.”

“The examining attorney’s appeal brief should be concise and contain a complete statement of reasons for the refusal(s) or requirement(s) and supporting facts.” TMEP § 1501.02(b). The “argument presented in [the brief] should be complete.” TMEP Appendix A. In this case, the Examining Attorney’s appeal brief did not include the registration number for the cited mark, the identification of the goods at issue in the

⁵ 8 TTABVUE 6-7 (implied request) and 13-20 (merriam-webster.com/dictionary/icy).

cited registration, the amended identification of goods at issue in the application, a description of the stylized mark in the application, or a statement that the refusal is based on only one class of goods in the registration and applies only to one class of the application. Nonetheless, with the aid of Applicant's brief and the underlying record we have pieced together important missing facts, and we are reminded of the humorous statement that "[j]udges are not like pigs, hunting for truffles buried in briefs." *RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1803 (TTAB 2018) (quoting *United States v. Dunkel*, 927 F.2d 955, 956 (7th Cir. 1991)). We appreciate complete, concise briefs and encourage their use pursuant to TMEP § 1501.02(b) and Appendix A.

II. Applicable Law

Our determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as "*DuPont* factors"); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). The Board considers those *DuPont* factors for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *see also Stratus Networks, Inc. v. UBTA-UBET Commc'ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, *3 (Fed. Cir. 2020) ("Not all *DuPont* factors are relevant in each case . . .").

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities of the goods. *See In re Chatam Int'l Inc.*, 380

F.3d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004); *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.”); *see also 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 [services].’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)). Another factor to be considered when there is evidence of record is the number and nature of similar marks in use with similar goods, reflecting on the strength of the cited mark. *DuPont*, 177 USPQ at 567; *see also Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015).

A. Similarity of the Goods, Trade Channels, and Consumers

The second *DuPont* factor “considers ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567), while the third *DuPont* factor considers “the similarity or dissimilarity of established, likely-to-continue trade channels.” *Id.* at 1052 (quoting *DuPont*, 177 USPQ at 567). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-63 (Fed. Cir. 2014).

We must make our determination based on the goods as they are identified in the application and cited registration. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). *See also Stone Lion*, 110 USPQ2d at 1161; *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The application and registration themselves may provide evidence of the relationship between the goods. *Hewlett-Packard v. Packard Press*, 62 USPQ2d at 1005.

As indicated above, the amended Class 25 goods in the application are “footwear; headbands; hoodies; jerseys; pants; sneakers; sweat pants; hooded sweat shirts;” and the goods at issue in the cited registration are “t-shirts, hats, sweatshirts and jackets.” Because Applicant’s “hooded sweat shirts” are encompassed by Registrant’s “sweatshirts,” the goods are literally and legally identical, in part. *See In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). Applicant presents no arguments regarding the relatedness of the goods. Furthermore, because the goods discussed above in the application and cited registration are in-part identical, there is no need for us to consider the relatedness of Applicant’s goods with the other goods identified in the cited registration. *See SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 938-39 (Fed. Cir. 1983) (holding that a single good from among several may sustain a finding of likelihood of confusion); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there

is likely to be confusion with respect to any item that comes within the identification of goods or services in the application).

Where, as here, the goods are in part identical or legally identical because one listed item encompasses another, we presume that the channels of trade and classes of purchasers for those identical goods are also the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods or services, the channels of trade and classes of purchasers are considered to be the same); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011). Applicant presents no arguments regarding the channels of trade or classes of consumers.

Accordingly, the second and third *DuPont* factors weigh in favor of finding likelihood of confusion.


B. The Strength of the Cited Mark

Before reaching the degree of similarity of the marks, we address Applicant's arguments, presumably under the fifth and sixth *DuPont* factors which consider the conceptual strength of the cited registered mark and the extent 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, which undergird Applicant's entire brief. *See generally* 6 TTABVUE 11-19. The strength of a mark may be assessed based on its conceptual strength arising out of the nature of the mark itself and its commercial

strength, derived from the marketplace recognition of the mark. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010). For likelihood of confusion purposes, a mark's strength "varies along a spectrum from very strong to very weak." *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)). Evidence of extensive registration and use of similar marks by others in the field can be powerful evidence of a mark's weakness. *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation*, 115 USPQ2d at 1674.

In its Response to Office Action, Applicant submitted two lists from the USPTO's Trademark Electronic Search System database (TESS) comprising what it described as use-based third-party registrations and applications, and intent-to-use-based applications, for the term ICY or a variant thereof "in Class 25 (some including the very same goods as listed [in the cited registration])." July 9, 2020 Response to Office Action at 2. Because the Examining Attorney did not advise Applicant that the listing of registrations and applications was insufficient to make them of record, as well as discussed the list in his Final Office Action, the Examining Attorney waived any objection to the list. *In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2010), *aff'd*, 731 F.3d 1326 (Fed. Cir. 2013). *See also* TMEP § 710.03 ("If the applicant's response includes improper evidence of third-party registrations, the examining attorney must

object to the evidence in the first Office action following the response.”). We consider the list but only insofar as the information provided by Applicant. *City of Houston*, 101 USPQ2d at 1536. The list of applications, however, have no probative value other than as evidence that the applications were filed. *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1270 n.8 (TTAB 2009).

With its first Request for Reconsideration, Applicant submitted excerpts of five of the eight use-based registrations from one of the earlier TESS lists. *See* August 17, 2020 Request for Reconsideration at 21-26. The five registrations are for the standard character marks ICY FASHION (Registration No. 5742595), ICY WAVES (Registration No. 2771717), MRICY (Registration No. 5506516), and ICY RABBIT (Registration No. 5710849), and the composite mark ICY ZONE  (Registration No. 5080984), all identifying various clothing goods in Class 25.

With its first and second Requests for Reconsideration, Applicant submitted Internet evidence⁶ demonstrating mostly ornamental and print-on-demand third-party uses of ICY and ICY-formative terms for clothing, including:

⁶ Applicant’s Internet evidence does not include the required URL addresses and/or dates, *In re I-Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018), but the Examining Attorney did not inform Applicant of this deficiency and treated Applicant’s Internet evidence as of record. *In re Mueller Sports Meds., Inc.*, 126 USPQ2d 1584, 1586 (TTAB 2018) (objection may be deemed waived if examining attorney fails to object and advise applicant of the proper way to make Internet evidence of record). *See also* TMEP § 710.01(b) (“[I]f an applicant’s internet evidence does not comply with the above requirements, the examining attorney must object to the evidence in the first Office action following the submission of the evidence and advise the applicant how to properly make the Internet evidence of record.”).



⁷ August 17, 2020 Request for Reconsideration at 7 (Amazon: “#ICY – Hashtag Men’s Funny Soft Adult Tee T-Shirt.” “These are printed with care upon ordering.”).

⁸ *Id.* at 8 (Zazzle: “Designed for you.” “Edit Design.” “[D]esign is previewed with RealView™ technology; content may not match model.”).

⁹ *Id.* at 9 (PrettyLittleThing: “[C]rop top[f]eaturing . . . contrasting icy slogan”).

¹⁰ *Id.* at 11 (ICY Clothing: although the price for this shirt is listed in pounds sterling, the Examining Attorney did not object).

¹¹ *Id.* at 12 (Poshmark).

¹² *Id.* at 13 (spreadshirt: “Create Custom Products.” “Get this design on other products.” “Customize.”).

¹³ *Id.* at 15 (Ultrabasic: “Get your new custom clothing designs.” “Create Now.” “PRINT LOCATION: FRONT [or] BACK. PRINT COLOR: AS ON THE PICTURE.”)

¹⁴ *Id.* at 16 (Teepublic: “icy” art available on “More ICY Products.”).

¹⁵ *Id.* at 18 (cafe press: “Create.”).

Applicant also submitted a Google search image results page for “icy’ shirts” showing approximately 100 images of shirts.¹⁶ Although we have no information as to the algorithms used to provide the search results, the results do show several shirts with ICY or ICY-formative slogans, including some of the shirt images introduced separately and shown above. The results also contain images of shirts with wording or designs that are difficult to see or have no apparent connection to the word “icy.” As with Applicant’s other evidence, the Examining Attorney made no objection to this search result evidence, so it is of record and we accord it whatever limited probative value it may have as such a truncated result with very little information or context accompanying each image. *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2062 n.4 (TTAB 2013); *In re Int’l Bus. Machines Corp.*, 81 USPQ2d 1677, 1679 n.3 (TTAB 2006).

Under the fifth and sixth *DuPont* factors, we are concerned with the strength of the cited mark, not Applicant’s mark. *See Juice Generation*, 115 USPQ2d at 1674. *See also DuPont*, 177 USPQ at 567 (“The fame of the **prior** mark” (emphasis added)). The third-party registrations and uses of ICY provide little help in our analysis of the conceptual and commercial strength of ICEE when applied to clothing because the registered mark is ICEE, not ICY. Indeed, [t]he [E]xamining [A]ttorney contests any notion that the registered mark is weak [because t]he evidence of record warrants no such conclusion” 8 TTABVUE 8-9.

¹⁶ *See* August 17, 2020 Request for Reconsideration at 20.

The only evidence of record that aids our analysis is the dictionary definition of the noun suffix –EE made of record by the Examining Attorney and defining the suffix as, inter alia, “one resembling or suggestive of // goatee,”¹⁷ combined with definition of ICY of which we have taken judicial notice (i.e., “covered with ice” and “very cold.”)¹⁸ When the word ICY and suffix –EE are combined, we find that ICEE likely has a meaning approximating “resembling or suggestive of ice or something intensely cold.” This goes to conceptual strength, and indicates that ICEE is arbitrary for clothing.

Applicant has not demonstrated any meaning or weakness of the term ICEE, and because it is registered without a claim to acquired distinctiveness on the Principal Register, it is entitled to a presumption of validity under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), including that it is inherently distinctive for the goods at issue. *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006). In view thereof, we find that ICEE falls at least in the middle of the spectrum of strength. *Joseph Phelps Vineyards*, 122 USPQ2d at 1734. Accordingly, the fifth and sixth *DuPont* factors are neutral.

C. Similarity or Dissimilarity of the Marks

Finally, we turn to the first *DuPont* factor which considers the “similarities or dissimilarities of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Detroit Athletic*, 128 USPQ2d at 1051 (quoting *DuPont*,

¹⁷ See August 1, 2020 Final Office Action at 5 (merriam-webster.com).

¹⁸ 8 TTABVUE 17 (merriam-webster.com).

177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Inn at St. John’s*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)). The emphasis of our analysis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014). Since the relevant goods include sweatshirts without any restrictions or limitations, the average purchaser is an ordinary consumer. Such consumers may not necessarily encounter the marks in close proximity and must rely upon their recollections thereof over time. *In re Mucky Duck Mustard*, 6 USPQ2d 1467, 1468 (TTAB 1988).

The Examining Attorney argues that “[t]he marks are essentially phonetic equivalents” and “have the same meaning.” 8 TTABVUE 6. Applicant agrees that the marks “share[] a possible similar sound,” 6 TTABVUE 14, and so do we. But in this case that is not the end of the story. Applicant argues that its “ICY stylized mark has a very different commercial impression and connotation than the [cited m]ark,” 6 TTABVUE 10, due in part to the “overall unique design.” *Id.* at 17. Applicant’s evidence of several third-party registrations and ornamental uses of ICY on clothing, discussed above under the fifth and sixth *DuPont* factors, suggests that ICY may have a different commercial impression than ICEE when applied to clothing.

Given the multiple registrations and multiple custom or print-on-demand ornamental uses of ICY on shirts and hats (the record demonstrates that it may be printed on other goods as well), we infer that the literal term ICY of Applicant’s mark

may be weak, and there must be a draw or significance to purchasers of clothing displaying this term. As the Examining Attorney notes,

[the] placement of the wording [ICY] on the T-shirts and hats clearly show[s] that the term is merely being used ornamentally and not as a source indicator. Hence consumers are not purchasing these T-shirts or hats because they think they originate from a particular company, but merely appreciate the novel manner and usage of the wording 'ICY' on the respective T[-]shirts and hats.

8 TTABVUE 9. We take judicial notice that “ice” is a slang term for “diamonds” and broadly means “jewelry.”¹⁹ With these meanings, we find it likely that ICY may connote someone covered with diamonds and jewelry: a lot of bling. Indeed, many of the third-party ornamental uses of ICY give this impression. In the following examples, reproduced from above, one t-shirt is shown with a round brilliant diamond design thereon; one cropped t-shirt is worn by a model with flashy sunglasses, dangling earrings, and a large necklace, and the term ICY on her shirt is printed in a shiny, stippled font resembling pavé diamonds; one shirt displays an anthropomorphized rabbit with a diamond bracelet, and large diamond neck chain from which he conspicuously displays a large diamond in the shape of a carrot (i.e., a

¹⁹ MERRIAM-WEBSTER DICTIONARY.COM ([merriam-webster.com/dictionary/ice](https://www.merriam-webster.com/dictionary/ice)), accessed September 26, 2021. As discussed above, the Board may sua sponte take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including from online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).

multi-carat carrot); one shirt displays a tiara-like banner design; one shirt displays a stylized geometric diamond; and one t-shirt displays the “funny” message #icy.²⁰



The stylization of Applicant’s mark creates a similar commercial impression of ICY. As can be seen from the display of the mark at right,



Applicant’s special form drawing displays a stylization of ICY in faceted letters resembling baguette cut diamonds. While the cited mark ICEE may convey a meaning of resembling literal ice or something intensely cold, the commercial impression of Applicant’s stylized ICY mark is atmospheric bling or swag glamour. We therefore find Applicant’s mark suggests a meaning in a way that the cited mark does not.²¹ The marks impart different overall commercial impressions, and this difference in commercial impression is significant on the record as it was presented to us. *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47

²⁰ August 17, 2020 Request for Reconsideration at 11, 9, 12, 18, 13, and 7, respectively.

²¹ Because the application was filed as intent-to-use under § 1(b), we do not know how Applicant will use the mark. Given the multiple ornamental uses of ICY that appear to convey an atmospheric message of bling and swag glamour, we are left to wonder whether Applicant will be able to demonstrate trademark use when, and if, it files evidence of use. *See, e.g., Univ. of Ky. v. 40-0, LLC*, 2021 USPQ2d 253, at *25 (TTAB 2021) (“The critical inquiry in determining whether a proposed mark functions as a trademark is how the relevant public perceives it.”) (citing *In re Greenwood*, 2020 USPQ2d 11439, at *2 (TTAB 2020)). *See also*, TMEP §§ 1202.03 (Refusal on Basis of Ornamentation) and 1202.03(f)(i) (Slogans or Words Used on the Goods).

USPQ2d 1459, 1460 (Fed. Cir. 1998) (“[O]ne *DuPont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks.”) (citing *Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991); and *Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989) (agreeing with the Board “that the more important fact for resolving the issue of likelihood of confusion in this case is the dissimilarity in commercial impression between the marks”)).

The Examining Attorney’s arguments tend to agree with our observation. While disputing the significance of the third-party registrations as evidence of conceptual weakness, the Examining Attorney observes that “[t]he term ‘ICY’ in these third party registrations operates as an adjective that merely modifies the dominant term that follows.” 8 TTABVUE 9. The registration of the mark ICY FASHION (Registration No. 5742595) for clothing demonstrates the point. If, as the Examining Attorney argues, FASHION is the dominant portion of that mark, then ICY must have a meaning that makes it conceptually weak. We believe it is the meaning of atmospheric bling and swag glamour.

We find that the dissimilarity of the marks, which engender different commercial impressions, weighs against a finding of likelihood of confusion.

D. Summary

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d

1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”). Here, although the goods are identical in part and travel in the same trade channels to the same classes of consumers, the record as it was presented to us reveals that Applicant’s mark conveys a different commercial impression from the cited mark. As demonstrated by the third-party registration of ICY-formative marks and third-party ornamental use of ICY on clothing, when Applicant’s stylized mark is used on the identified clothing goods it will convey the humorous impression of swag glamour. The significantly differing commercial impressions thus outweighs the identity of the goods. Accordingly, we

find there is no likelihood of confusion between Applicant’s mark

and the mark ICEE in the cited registration.



III. Decision

The refusal to register Applicant’s mark under Section 2(d) of the Trademark Act is reversed.