

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: April 3, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re MB1 Enterprises, LLC
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Serial Nos. 97268667 and 97422929 (Consolidated)
—

William A. Wooten of Wooten Law Office,
for MB1 Enterprises, LLC.

Andrew Janson, Trademark Examining Attorney, Law Office 105,¹
Jennifer Williston, Managing Attorney.

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Before Pologeorgis, Allard, and Brock,
Administrative Trademark Judges.

Opinion by Allard, Administrative Trademark Judge:²

¹ A different Trademark Examining Attorney examined the involved applications and issued the first Office Action. Both applications were then subsequently assigned to Examining Attorney Janson. In this opinion, we refer to both Examining Attorney Janson and his predecessor as the “Examining Attorney.”

² This opinion is issued as part of an internal Board pilot citation program on broadening acceptable forms of legal citation in Board cases. This opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the pages on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board, this opinion cites to the LEXIS legal database and cites only precedential decisions, unless otherwise indicated. See TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 101.03(a)(2) (June 2024) for acceptable citation forms to TTAB cases.

MB1 Enterprises, LLC (“Applicant”) seeks registration on the Principal Register of the two marks shown below:



Ser. No. 97268667³
 (“the ’667 Application”)



Ser. No. 97422929⁴
 (“the ’929 Application”)

each for:

Clothing, apparel, and athletic apparel, namely, t-shirts, shorts, hoodies, caps being headwear, hats, shoes, swimwear, sandals, jackets, coats, vests, scarves, wraps, sweaters, socks, shirts, tops, pants, leggings, and undergarments; Sportswear, namely, shirts, shorts, socks, pants, jackets, footwear, hats, and caps, athletic uniforms, in International Class 25.

³ Application Serial No. 97268667 was filed on February 15, 2022. As to the International Class 25 goods, the application was filed under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use anywhere and use in commerce since October 2021. The mark is described as “consist[ing] of the stylized wording ‘1 of 1.’” Color is not claimed as a feature of the mark. The application also includes goods and services in International Classes 9 and 41, which are not subject to the refusal.

⁴ Application Serial No. 97422929 was filed on May 22, 2022 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce. The mark is described as “consist[ing] of stylized wording ‘1 of 1’ that includes the literal element 1 OF 1, in all caps and in a dripping font.” Color is not claimed as a feature of the mark. The application also includes goods and services in International Classes 9 and 41, which are not subject to the refusal.

The Examining Attorney also refused registration of the mark in the ’929 Application under Section 2(d) based on likelihood of confusion with the marks of two other registrations (Reg. Nos. 5287051 and 5552024), but the refusal as to these registrations was subsequently withdrawn. *See* December 1, 2023 Office Action at TSDR 2 for the ’929 Application; 10 TTABVUE 3 in each proceeding. However, the refusal to register the mark of the ’929 Application in International Classes 14 and 25 based on Reg. No. 5723013 was made final and is the subject of this decision.

Additionally, the '929 Application seeks registration for “jewelry,” in International Class 14.

Registration of each mark has been partially refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that each mark, when used on the goods identified above (in both International Classes 14 and 25), so resembles the mark ONE OF ONE (in standard characters) registered on the Principal Register for “Clothing, namely, shirts, shorts, sweatshirts, hooded sweatshirts, sweatpants, jackets, beanies, hats, jerseys, socks, gloves,” in International Class 25,⁵ that it is likely to cause confusion, to cause mistake, or to deceive.⁶

After the refusals were made final, Applicant appealed and requested reconsideration. After each request was denied, the appeals resumed. Applicant filed a brief in each proceeding.⁷ These appeals were consolidated by Order of the Board, dated October 25, 2024, upon motion by the Examining Attorney,⁸ after entry of

⁵ Registration No. 5723013, issued on April 9, 2019.

⁶ Regarding the '667 Application, the partial refusal pertains to the goods in International Class 25 only; the goods and services in International Classes 9 and 41, respectively, are not subject to the refusal. *See* December 1, 2023 Final Office Action at TSDR 2 for the '667 Application. *See also* 10 TTABVUE 2 in each proceeding.

Regarding the '929 Application, the partial refusal pertains to the goods in International Classes 14 and 25 only; the goods and services in International Class 9 and 41, respectively, are not subject to the refusal. *See* December 1, 2023 Final Office Action at TSDR 2 for the '929 Application. *See also* 10 TTABVUE 3 in each proceeding.

⁷ 6 TTABVUE in each proceeding.

References to the briefs on appeal refer to TTABVUE, the Board's online docketing system. The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry.

⁸ 8, 9 TTABVUE in each proceeding.

which the Examining Attorney filed a consolidated brief.⁹ We now decide them in this single opinion. *See In re Mr. Recipe, LLC*, Ser. No. 86040643, 2016 TTAB LEXIS 80, at *2 (TTAB 2016) (Board consolidated appeals in two applications on Examining Attorney’s request and issued a single opinion). For the reasons discussed below, we affirm.

I. Evidentiary Matters

Before proceeding to the merits of the refusals, we address two evidentiary matters.

A. Evidence Attached to Applicant’s Briefs

Applicant attached to each brief copies of third-party registrations, all of which were properly made of record during examination.¹⁰ We discourage the practice of attaching materials in the record to briefs for the reasons discussed in *In re Michalko*, Ser. No. 85584271, 2014 TTAB LEXIS 215, at *2-3 (TTAB 2014) (“Parties to Board cases occasionally seem to be under the impression that attaching previously-filed evidence to a brief and citing to the attachments, rather than to the original submission is a courtesy or a convenience to the Board. It is neither.”).

⁹ 10 TTABVUE in each proceeding.

¹⁰ 6 TTABVUE 14-22 in the ’667 Application proceeding; 6 TTABVUE 15-23 in the ’929 Application proceeding; March 1, 2024 Request for Reconsideration at TSDR 8-16 in the ’667 Application; March 1, 2024 Request for Reconsideration at TSDR 9-17 in the ’929 Application.

B. Hyperlinks in Brief

Applicant embeds in each brief certain hyperlinks as evidence of (1) the purported usage of the cited mark, and (2) the fame of LaMelo Ball, a player with the National Basketball Association and founder of Applicant.¹¹ There are two problems with these attempted submissions. First, they were not timely filed. Evidence filed in an ex parte proceeding must be filed prior to the filing of the appeal, not afterwards. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). *See also In re ADCO Indus.*, Ser. No. 87545258, 2020 TTAB LEXIS 7, at *3-4 (TTAB 2020). Second, Applicant provided only the web addresses and not a copy of the webpages. “Web addresses or hyperlinks are not sufficient to make the underlying webpages of record.” *ADCO Indus.*, 2020 TTAB LEXIS 7, at *4. *See also* TBMP § 1208.03 and cases cited therein. Thus, we have given no consideration to these hyperlinks.

II. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits the registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office ... as to be likely, when used on or in connection with the goods [or services] of the applicant, to cause confusion, or to cause mistake, or to deceive” 15 U.S.C. § 1052(d). 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, 1361 (CCPA 1973) (“*DuPont*”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 1314 (Fed. Cir. 2003). We consider each

¹¹ 6 TTABVUE 9, 10 in both proceedings.

DuPont factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019). Varying weight may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 637 F.3d 1344, 1356 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”).

In every Section 2(d) case, two key factors are the similarity or dissimilarity of the marks and the goods or services. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 1322 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976). These two factors, together with others, namely, the third, part of the fourth (i.e., classes of consumers), and the sixth, are addressed in this decision.

A. Similarity or Dissimilarity and Nature of the Goods, Similarity or Dissimilarity of Established and Likely-to-Continue Channels of Trade, and Classes of Purchasers

The second *DuPont* factor considers the “similarity or dissimilarity and nature of the goods or services as described in an application or registration ...” while the third *DuPont* factor considers the “similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 476 F.2d at 1361. The relevant inquiry in an ex parte proceeding focuses on the goods as identified in the application and the cited registration. *In re Charger Ventures LLC*, 64 F.4th 1375, 1383 (Fed. Cir. 2023).

It is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class.

Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc., 648 F.2d 1335, 1336 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, Opp. No. 91196527, 2014 TTAB LEXIS 166, at *37 (TTAB 2014).

Applicant, for its part, does not address the second or third *DuPont* factors in either of its briefs, apparently conceding the issue. *In re Morinaga Nyugyo K.K.*, Ser. No. 86338392, 2016 TTAB LEXIS 448, at *3 (TTAB 2016). Therefore, we offer a brief explanation of findings.

1. The International Class 25 Goods of Both Applications

Both applications identify “Clothing, apparel, and athletic apparel, namely, t-shirts, shorts, hoodies, caps being headwear, hats, shoes, swimwear, sandals, jackets, coats, vests, scarves, wraps, sweaters, socks, shirts, tops, pants, leggings, and undergarments; Sportswear, namely, shirts, shorts, socks, pants, jackets, footwear, hats, and caps, athletic uniforms,” while the cited registration identifies “Clothing, namely, shirts, shorts, sweatshirts, hooded sweatshirts, sweatpants, jackets, beanies, hats, jerseys, socks, gloves.” Thus, the identifications are identical as to shorts, hats, jackets, and socks.

Additionally, “shirts” of the cited registration is broad enough to encompass “t-shirts” identified in the involved applications. Similarly, because Applicant’s “hoodie” is defined as “A hooded garment, especially a hooded sweatshirt,”¹² it is broad enough

¹² The Board may take judicial notice of dictionary definitions. THE AMERICAN HERITAGE DICTIONARY, <https://ahdictionary.com/word/search.html?q=hoodie>, accessed on March 28, 2025. *Monster Energy*, 2023 TTAB LEXIS 14, at *27 n.41 (“The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions.”) (citing *In re Cordua Rests. LP*, Ser. No. 85214191, 2014 TTAB LEXIS 94, at *6 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594 (Fed. Cir. 2016)).

to encompass “hooded sweatshirts” of the cited registration. Thus, Applicant’s goods and the goods of the cited registration are also legally identical in part. *See, e.g., Look Cycle Int’l v. Kunshan Qiyue Outdoor Sports Goods Co.*, Can. No. 92079409, 2024 TTAB LEXIS 289, at *11 (TTAB 2024); *Conopco, Inc. v. Transom Symphony OpCo, LLC*, Opp. No. 91256368, 2022 TTAB LEXIS 194, at *17-18 (TTAB 2022) (quoting *In re Hughes Furniture Indus., Inc.*, Ser. No. 85627379, 2015 TTAB LEXIS 65, at *10 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”)).

Further, where, as here, the goods are in part identical and legally identical and there are no limitations as to channels of trade or classes of purchasers in either Applicant’s or the cited registration’s identifications of goods, we must presume that the in part identical and legally identical goods will be sold in the same channels of trade and bought by the same classes of purchasers. *See In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012).

2. The International Class 14 Goods of the ’929 Application

In addition to the clothing items previously discussed, the ’929 Application also identifies “jewelry” in International Class 14. The Examining Attorney argues that Applicant’s “jewelry” is related to clothing for purposes of finding a likelihood of confusion.¹³ Applicant, for its part, does not address this issue in its brief.

¹³ 10 TTABVUE 7 in the ’667 Application; 10 TTABVUE 7-8 in the ’929 Application.

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, 1086 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000). The 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 they emanate from the same source.” See *Coach Serv. v. Triumph Learning LLC*, 668 F.3d 1356, 1369 (Fed. Cir. 2012) (quoting *7-Eleven, Inc. v. Wechsler*, Opp. No. 91117739, 2007 TTAB LEXIS 58, at *28-29 (TTAB 2007)).

“Evidence of relatedness may include news articles 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; or copies of prior use-based registrations of the same mark for both applicant’s goods and the goods listed in the cited registration.” *In re Embiid*, Ser. No. 88202890, 2021 TTAB LEXIS 168, at *30 (TTAB 2021).

To support his argument, the Examining Attorney made of record evidence in the form of printouts from seven third-party websites showing that the goods identified in the cited registration, i.e., “Clothing, namely, shirts, shorts, sweatshirts, hooded sweatshirts, sweatpants, jackets, beanies, hats, jerseys, socks, gloves” and Applicant’s identified “jewelry” are commonly offered under the same mark:

- American Eagle offers shirts, sweatpants, hooded sweatshirts, hats, and socks together with earrings, necklaces and rings.¹⁴

¹⁴ December 1, 2023 Final Office Action at TSDR 11-17 in the '929 Application.

- Guccio offers jackets, sweatpants and shorts together with rings and necklaces.¹⁵
- Tommy Hilfiger offers shorts, sweatshirts, sweatpants, and jackets together with bracelets, necklaces and earrings.¹⁶
- Michael Kors offers shirts and jackets together with necklaces, bracelets, rings and earrings.¹⁷
- Kate Spade offers shirts and jackets together with earrings, rings and bracelets.¹⁸
- H&M offers shirts together with necklaces and earrings.¹⁹
- Zara offers shirts together with necklaces and earrings.²⁰

This evidence shows that it is commonplace in the industry for a single entity to offer Applicant’s identified “jewelry” as well as the Registrant’s identified clothing items under the same mark. As such, consumers are familiar with these goods being offered through a single source under a single mark. *See, e.g., In re Detroit Athletic Co.*, 903 F.3d 1297, 1306 (Fed. Cir. 2018) (crediting relatedness evidence that third parties use the same mark for the goods and services at issue because “[t]his evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both”); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261,

¹⁵ *Id.* at TSDR 18-22.

¹⁶ *Id.* at TSDR 23-45.

¹⁷ *Id.* at TSDR 46-64.

¹⁸ *Id.* at TSDR 65-72.

¹⁹ *Id.* at TSDR 73-81.

²⁰ *Id.* at TSDR 82-99.

1267 (Fed. Cir. 2002) (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis”).

Further, because there are no restrictions regarding channels of trade, classes of consumers or prices in the identifications of the application or the cited registration, we must presume that the identified goods are sold in the ordinary or normal trade channels for such goods, to all consumers for such goods, and without any price limitation. *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1361 (Fed. Cir. 2000) (“When the registration does not contain limitations describing a particular channel of trade or class of customer, the goods or services are assumed to travel in all normal channels of trade.”); *SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 1042-43 (Fed. Cir. 1983). Here, the Internet evidence demonstrating that the goods are related, i.e., American Eagle,²¹ Guccio,²² and Tommy Hilfiger,²³ also supports a finding that the identified goods move in the same channels of trade to the same class of purchasers, namely, members of the general public. *See, e.g., Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1322-23 (Fed. Cir. 2014); *In re Anderson*, Ser. No. 76511652, 2012 TTAB LEXIS 42, at *30 (TTAB 2012).

In sum, Applicant’s and Registrant’s goods in International Class 25 are identical and legally identical in part and the channels of trade and classes of consumers are

²¹ December 1, 2023 Final Office Action at TSDR 11-17 in the ’929 Application.

²² *Id.* at TSDR 18-22.

²³ *Id.* at TSDR 23-45.

presumed to be the same. Applicant's "jewelry" in International Class 14 is related to the goods identified in the cited registration and the trade channels overlap.

B. Strength or Weakness of the Cited Mark

As an initial matter, the Examining Attorney is not expected to adduce evidence of the strength or fame of the cited registered mark. *Mr. Recipe*, 2016 TTAB LEXIS 80, at *4-5. Additionally, to the extent that Applicant argues that its marks are famous due to their usage by LaMelo Ball, who plays for the National Basketball Association,²⁴ these arguments are irrelevant in this context. *See DuPont*, 476 F.2d at 1361 ("the fame of the **prior** mark") (emphasis added).

More relevant, however, are Applicant's arguments that the term ONE when used with clothing is diluted and that, as a result, Applicant's mark can be simultaneously registered.²⁵ Here, Applicant attempts to adduce evidence of "[t]he number and nature of similar marks in use on similar goods" under the sixth *DuPont* factor to show that the cited mark is comparatively weak, conceptually or commercially, and has a "comparatively narrower range of protection." *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338 (Fed. Cir. 2015).

Conceptual or inherent strength is a measure of a mark's distinctiveness. *In re Chippendales, USA, Inc.*, 622 F.2d 1346, 1353-54 (Fed. Cir. 2010). Distinctiveness is "often classified in categories of generally increasing distinctiveness[:] ... (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful." *Two Pesos, Inc. v. Taco*

²⁴ 6 TTABVUE 10 in both proceedings.

²⁵ 6 TTABVUE 11-12 in both proceedings.

Cabana, Inc., 505 U.S. 763, 768 (1992). “Marks that are descriptive or highly suggestive are entitled to a narrower scope of protection, i.e., are less likely to generate confusion over source identification, than their more fanciful counterparts.” *Spireon, Inc. v. Flex LTD*, 71 F.4th 1355, 1362-63 (Fed. Cir. 2023) (quoting *Juice Generation*, 794 F.3d at 1339); see also *Jack Wolfskin Ausrustung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1373 (Fed. Cir. 2015) (“The weaker an opposer’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.”).

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*, 794 F.3d at 1338-39; see also *Jack Wolfskin*, 797 F.3d at 1373-74 (“[E]vidence of third-party registrations is relevant to ‘show the sense in which . . . a mark is used in ordinary parlance[.]’”).

Considering Applicant’s evidence in detail, we agree with the Examining Attorney that the registration for the mark ONE GOAL. ONE VISION. (Reg. No. 5754169)²⁶ has no probative value because it is not based on use in commerce but rather issued under Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e) and there is no evidence

²⁶ March 1, 2024 Request for Reconsideration after Final at TSDR 9 in the ’667 Application; March 1, 2024 Request for Reconsideration after Final at TSDR 10 in the ’929 Application.

that evidence of use has been filed to date. *Made in Nature, LLC v. Pharmavite LLC*, Opp. No. 91223352, 2022 TTAB LEXIS 251, at *30-31 (TTAB 2022);

Applicant’s remaining evidence consists of eight third-party registrations, all of which are summarized in the chart below:

No.	Mark	Reg. No.	Pertinent Goods
1	ONE FIVE ONE	3628034	Bermuda shorts; Blouses; hats; jackets; jeans; knit shirts; polos shirts; shirts; shorts; sweatshirts; t-shirts ²⁷
2	ONE 5 ONE	3705038	Bermuda shorts; blouses; hats; jackets; knit shirts; polo shirts; shirts; shorts; sweatshirts; t-shirts. ²⁸
3	ONE WORLD ONE SOCK	5450238	Socks; socks and stockings ²⁹
4	ONE FAMILY ONE LOVE	6699444	Socks; bottoms as clothing; tops as clothing ³⁰
5	ONE FOR ONE	4204485	Clothing, namely, hats, sweatshirts, and hooded sweatshirts ³¹
6	ONE POINT ONE	5587500	Blouses; jackets; knit shirts; pants; shorts; sweaters; woven shirts ³²

²⁷ March 1, 2024 Request for Reconsideration at TSDR 13 in the ’667 Application; March 1, 2024 Request for Reconsideration at TSDR 14 in the ’929 Application. It is possible that the registered marks ONE FIVE ONE and ONE 5 ONE, listed as Nos. 1 and 2 above, are owned by the same entity given the similarity in the marks and the identifications. However, Applicant did not include the ownership information in its screen capture of the TSDR printouts and, as a result, there is no evidence upon which to find that the marks are co-owned.

²⁸ March 1, 2024 Request for Reconsideration at TSDR 16 in the ’667 Application; March 1, 2024 Request for Reconsideration at TSDR 17 in the ’929 Application.

²⁹ March 1, 2024 Request for Reconsideration at TSDR 8 in the ’667 Application; March 1, 2024 Request for Reconsideration at TSDR 9 in the ’929 Application.

³⁰ March 1, 2024 Request for Reconsideration at TSDR 10 in the ’667 Application; March 1, 2024 Request for Reconsideration at TSDR 11 in the ’929 Application.

³¹ March 1, 2024 Request for Reconsideration at TSDR 11 in the ’667 Application; March 1, 2024 Request for Reconsideration at TSDR 12 in the ’929 Application.

³² March 1, 2024 Request for Reconsideration at TSDR 14 in the ’667 Application; March 1, 2024 Request for Reconsideration at TSDR 15 in the ’929 Application.

7	ONE O ONE	4489296	Coats; denims; jackets; pants; shirts; skirts; sweaters; sweatshirts ³³
8	ONE O ONE	3306550	shoes ³⁴

While all of the third-party marks listed above contain the element “ONE,” all of them are of low probative value because they have a different overall commercial impression and are, as a result, quite dissimilar from the cited ONE OF ONE mark. *Made in Nature*, 2022 TTAB LEXIS 251, at *29-30; *In re Inn at St. John’s, LLC*, Ser. No. 87075988, 2018 TTAB LEXIS 170, at *10 (TTAB 2018) (discounting probative value of third-party registrations “contain[ing] the non-identical term ‘Fifth’” in showing that the cited registered mark 5IVESTEAK was weak), *aff’d per curiam*, 777 F. App’x 516 (Fed. Cir. 2019). Considering the above-charted marks, the first two marks listed – ONE FIVE ONE and ONE 5 ONE – convey the impression of number 151. The mark ONE WORLD ONE SOCK conveys the impression of uniting the world around one sock, while the mark ONE FAMILY ONE LOVE conveys the impression of uniting a family around one love.

Similarly, the ONE FOR ONE mark conveys a different commercial impression, i.e., that of a one-to-one correspondence between items. ONE POINT ONE connotes the number “1.1” and could indicate the next version of something originally denoted 1.0. Lastly, the mark ONE O ONE (shown as Nos. 7 and 8 above) is likely to be

³³ March 1, 2024 Request for Reconsideration at TSDR 12 in the ’667 Application; March 1, 2024 Request for Reconsideration at TSDR 13 in the ’929 Application.

³⁴ March 1, 2024 Request for Reconsideration after Final at TSDR 15 in the ’667 Application; March 1, 2024 Request for Reconsideration after Final at TSDR 16 in the ’929 Application.

perceived as 101 (pronounced “1 OH 1”) and, as a result, connotes something basic or elementary, as in an introductory level college class – English Literature 101.

In short, none of these third-party marks are as similar to the cited mark as Applicant’s marks, both 1 OF 1 (stylized), which connote that there is only one of the person or item and engenders the impression of someone or something that is unique. *See, e.g., Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 675 (Fed. Cir. 1984) (“Applicant introduced evidence of eight third-party registrations for tea which contain the word ‘SPICE’, five of which are shown to be in use. None of these marks has a ‘SPICE (place)’ format or conveys a commercial impression similar to that projected by the SPICE ISLANDS mark, and these third-party registrations are of significantly greater difference from SPICE VALLEY and SPICE ISLANDS than either of these two marks from each other.”).

Even when we consider these eight third-party registrations together, we find that Applicant’s third-party registration evidence shows at best some suggestiveness of the term ONE but does not detract from the overall conceptual strength of the cited ONE OF ONE mark. Therefore, we accord Registrant’s mark “the normal scope of protection to which inherently distinctive marks are entitled.” *Bell’s Brewery, Inc. v. Innovation Brewing*, Opp. No. 91215896, 2017 TTAB LEXIS 452, at *20 (TTAB 2017); *see also In re Info. Builders Inc.*, Ser. No. 87753964, 2020 TTAB LEXIS 20, 2020 TTAB LEXIS 20, at *26 (TTAB 2020).

C. Similarity or Dissimilarity of the Marks



Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant's and Registrant's marks in their entireties, considering their appearance, sound, meaning and commercial impression. *DuPont*, 476 F.2d at 1361. *See also Detroit Athletic*, 903 F.3d at 1303. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *Inn at St. John's*, 2018 TTAB LEXIS 170, at *13 (quoting *In re Davia*, Ser. No. 85497617, 2014 TTAB LEXIS 214, at *3-4 (TTAB 2014)).

The test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053 (Fed. Cir. 2012). "The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks." *In re i.am.symbolic, llc*, Ser. No. 85916778, 2018 TTAB LEXIS 281, at *11 (TTAB 2018). The average customers here are consumers of clothing and jewelry, which includes members of the general public.

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, our analysis cannot be predicated on dissecting the marks into their various components. *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). *See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007 (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.”).

At least with regard to Applicant’s goods in International Class 25, we note that “when the goods at issue are identical, ‘the degree of similarity necessary to support a conclusion of likely confusion declines.” *Viterra*, 671 F.3d at 1362-63 (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir. 1992)).

Recall that Applicant seeks to register the marks  and  while the cited mark is ONE OF ONE (in standard characters). In this case, we have no hesitation finding both of Applicant’s marks to be identical in sound, meaning and commercial impression to the cited mark, each differing from the cited mark only in appearance. The fact that Applicant’s marks incorporate the numerical version “1” and Registrant’s mark incorporates the spelled-out version “ONE” has little if any impact on the marks’ similarity, since they are pronounced the same, have the same meaning and engender the same commercial impression. Each of Applicant’s marks will be understood as representing the expression “1 of 1” and, because the goods are identical (as to the International Class 25 goods) and related (as to International Class 14 goods), any perceived connotation and commercial impression would be the same.

Applicant argues that “Applicant’s mark is an extension of Applicant’s brand presence, the LaFrancé lifestyle brand owned by professional NBA player LaMelo

Ball” and that this distinguishes the marks.³⁵ Applicant’s arguments are not persuasive. In comparing the marks, we are confined to comparing the marks as they appear on the drawing page, not as they are actually used in the marketplace. *In re Aquitaine Wine USA, LLC*, Ser. No. 86928469, 2018 TTAB LEXIS 108, at *11 (TTAB 2018) (“We must compare the marks as they appear in the drawings, and not on any labels that may have additional wording or information.”). Moreover, there is nothing about either of Applicant’s marks or their applications’ respective identifications that suggests that Applicant’s marks are somehow affiliated with LaMelo Ball in any manner at all much less in a manner sufficient to distinguish the marks.

To the extent that Applicant argues that the cited mark is used “in an ornamental manner on one of its pieces,”³⁶ this argument is not persuasive as, again, the marks are compared as they appear on the drawing page and not as they are actually used in the marketplace. *Id.* Moreover, inasmuch as Applicant implies that this ornamental usage may render the cited registration invalid, we cannot entertain such arguments in this proceeding. *In re Fat Boys Water Sports LLC*, Ser. No. 86490930, 2016 TTAB LEXIS 150, at *21 (TTAB 2016) (“[T]he validity of a cited registration cannot be challenged in an *ex parte* proceeding.”).

³⁵ 6 TTABVUE 9-10 in the ’667 Application; 6 TTABVUE 10 in the ’929 Application.

³⁶ 6 TTABVUE 9 in both proceedings.

Applicant takes issue with the Examining Attorney's arguments made during examination that the stylization of Applicant's marks does not obviate the likelihood of confusion.³⁷ Applicant argues that:

The registered mark uses the word "ONE", while Applicant's mark utilizes the numeral "1". The registrant's rights to utilize the registered mark "in any lettering style" apply only to the literal element of the mark, which would not include the use of the numeral "1", just as Applicant's mark would not grant Applicant the full right to utilize the word "ONE".³⁸

The Examining Attorney counters that the cited mark in standard characters is capable of being displayed in a manner substantially similar to Applicant's marks:

For example, the registrant would be within its trademark rights to display its mark ONE OF ONE in a Gothic-style typeface, as in the '8667 Mark, or in a typeface with a more brushstroke-like appearance as in the '2929 Mark. The stylization in the applicant's marks therefore has a minimal effect, if any, on the comparison of these marks with the registered mark.³⁹

We agree with Applicant to the extent that it argues that Registrant's rights to utilize the registered mark "in any lettering style" apply only to the literal element of the mark, i.e., ONE, and does not include the use of the numeral "1". And we agree that registration of Applicant's marks 1 OF 1 (stylized) would not cover the display of the term 1 as "ONE". However, inasmuch as the cited mark is registered in standard characters, it could be displayed in a Gothic-style typeface in a manner similar to the mark shown in the '667 Application or in a dripping-like typeface in a

³⁷ 6 TTABVUE 10 in both proceedings.

³⁸ 6 TTABVUE 10 in both proceedings.

³⁹ 10 TTABVUE 4 in both proceedings.

manner similar to the mark shown in the '929 Application. Regardless, even if the stylization of the marks is different, the fact that the marks are pronounced the same, have the same connotation and engender the same commercial impression is sufficient to support a finding of likelihood of confusion. *Inn at St. John's*, 2018 TTAB LEXIS 170, at *13 (“Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” quoting *Davia*, 2014 TTAB LEXIS 214, at *4).

D. Balancing the Factors and Conclusion as to Likelihood of Confusion

We have carefully considered all of the evidence made of record, as well as all of the arguments related thereto and now weigh the *DuPont* factors for which there is evidence and argument. *Charger Ventures*, 64 F.4th at 1384.

1. Applicant's International Class 25 Goods

With regard to the goods in International Class 25, Applicant's and Registrant's goods are identical and legally identical in part, and their channels of trade and classes of consumers are presumed to overlap. Thus, the second and third factors and part of the fourth factor weigh in favor of a likelihood of confusion, the second heavily so. Where some of Applicant's goods are identical to Registrant's goods, the degree of similarity between the marks that is required to support a finding of likely confusion is less than it would be if the goods were not identical. Here, however, Applicant's marks are identical to the cited mark in sound, meaning and commercial impression, so the first factor also weighs heavily in favor of a likelihood of confusion. The fame of the cited mark under the fifth factor is neutral and the evidence Applicant submitted to demonstrate weakness of the cited mark was insufficient to diminish

the scope of enforcement of the cited mark under the sixth *DuPont* factor, thus, the sixth factor is also neutral. Because all factors weigh in favor of a likelihood of confusion, the first and second heavily so, and none weigh against it, we find that Applicant's mark is likely to cause confusion with the mark of the cited registration.

2. Applicant's International Class 14 Goods

With regard to the "jewelry" in International Class 14, Applicant's goods are related to the goods identified in the cited registration, so the second factor weighs in favor of a likelihood of confusion. The channels of trade also overlap. Applicant's mark is identical to the cited mark in sound, meaning and commercial impression, so the first factor weighs heavily in favor of a likelihood of confusion. The fifth and sixth factors are neutral. Because all factors weigh in favor of a likelihood of confusion, the first heavily so, and none weigh against it, we find that Applicant's mark is likely to cause confusion with the mark of the cited registration.

Decision

With regard to Applicant's mark (Ser. No. 97268667), the refusal under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), is affirmed as to the goods in International Class 25. The application will proceed, however, for Classes 9 and 41.

With regard to Applicant's mark (Ser. No. 97422929), the refusal under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), is affirmed as to the goods in International Classes 14 and 25. The application will proceed, however, for Classes 9 and 41.