

This Opinion is Not a  
Precedent of the TTAB

Mailed: July 9, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re SERO Innovation, LLC*

Serial Nos. 97436057 and 97570427  
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Daniel H. Bliss of Howard & Howard Attorneys PLLC,  
for SERO Innovation, LLC.

Deirdre Robertson, Trademark Examining Attorney, Law Office 111,  
Chris Doninger, Managing Attorney.

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Before Taylor, Heasley and English,  
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

SERO Innovation, LLC (“Applicant”) seeks registration on the Principal Register of the standard-character mark SOL<sup>1</sup> and the composite word and design mark

 ,<sup>2</sup> both for “sailboats,” in International Class 12.

<sup>1</sup> Application Serial No. 97436057 was filed on May 31, 2022 based on an allegation of an intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The identification of goods in this application is “sail boats” with a space between “sail” and “boats.”

<sup>2</sup> Application Serial No. 97570427 was filed on August 30, 2022 based on an allegation of an intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The application includes the following description of the mark: The mark consists

The Examining Attorney refused registration of Applicant's marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the standard-character mark SOLGEAR registered on the Principal Register for:

retail store services featuring outdoor sports equipment and river gear, namely, paddles, boats, canoes, kayaks, life jackets, floatation vests, camping equipment, first aid and safety gear, rescue throw bags, boating equipment, flip lines, camping kitchen gear, dish nets, utensil rolls, mountain climbing and rock climbing gear, fishing gear, fishing equipment, hiking equipment, outerwear, clothing; on-line retail store services featuring outdoor sports equipment and river gear, namely, paddles, boats, canoes, kayaks, life jackets, floatation vests, camping equipment, first aid and safety gear, rescue throw bags, boating equipment, flip lines, camping kitchen gear, dish nets, utensil rolls, mountain climbing and rock climbing gear, fishing gear, fishing equipment, hiking equipment, outerwear, clothing; on-line retail store services featuring a wide variety of consumer goods of others; retail store services featuring a wide variety of consumer goods of others, in International Class 35 (the "Cited Mark" or "Cited Registration").<sup>3</sup>

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of the wording 'SOL' with a sunburst in the center of the letter 'O.'" Color is not claimed as a feature of the mark.

<sup>3</sup> Registration No. 5919063 was issued on November 26, 2019. The registration also covers goods in International Classes 18 and 22, but the Section 2(d) refusal is based solely on the services in International Class 35. *See* March 16, 2023 Office Action, TSDR 2 ("Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 5919062 (SOLGEAR for 'Retail store services featuring outdoor sports equipment and river gear, namely, ... boats; On-line retail store services featuring outdoor sports equipment and river gear, namely, ... boats'. Trademark Act Section 2(d), 15 U.S.C. §1052(d)[.]").

When the refusals were made final, Applicant appealed and requested reconsideration.<sup>4</sup> The requests for reconsideration were denied and the appeals proceeded. The appeals are fully briefed.<sup>5</sup>

For the reasons explained, we affirm the refusal to register as to each of Applicant's marks.

### **I. Judicial Notice Request**

The Examining Attorney has attached to her brief a definition of the word “sol” from THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE and asks that we take judicial notice that the term means “sun.”<sup>6</sup> Applicant treats this definition as “in evidence”<sup>7</sup> and the Board routinely takes judicial notice of dictionary definitions. *See, e.g., In re Omniome, Inc.*, Ser. No. 87661190, 2019 WL 7596207, at \*3 n.17 (TTAB 2019) (“The Board may take judicial notice of dictionary definitions, including online dictionaries ... that exist in printed format[.]”). Accordingly, the Examining Attorney's judicial notice request is granted; we have considered this definition.

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<sup>4</sup> The records in the proceedings are substantially identical. In this opinion, we cite to the record and briefs in application Serial No. 97436057. Citations to the record are to the downloadable .pdf versions of documents in the Trademark Status & Document Retrieval (TSDR) database. Citations to the briefs refer to TTABVUE, the Board's online docket system.

As explained in Section 101.03(a)(2) of the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) (2024), 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 only by the page(s) 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 Westlaw (WL) database. TBMP § 101.03(a)(2).

<sup>5</sup> The appeals were consolidated after Applicant filed its appeal briefs. Board Order dated January 18, 2024, 13 TTABVUE.

<sup>6</sup> Examining Attorney's Brief, 14 TTABVUE 15, 19.

<sup>7</sup> Reply Brief, 15 TTABVUE 4.

In its briefs, Applicant asserts that “sol” means “the fifth note of a major scale”<sup>8</sup> and indicates that its cited definition is “in evidence.”<sup>9</sup> No such definition is of record but we have exercised our discretion to take judicial notice of the MERRIAM-WEBSTER online dictionary entry for the term “sol” defining the word as meaning, among other things, “the fifth note of the major scale in solfège” and “sun.”<sup>10</sup>

## II. Analysis

“The Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion [or] mistake, or to deceive.” *In re Charger Ventures LLC*, 64 F.4th 1375, 1379 (Fed. Cir. 2023) (cleaned up). Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. *In re E. I. DuPont de Nemours & Co*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 575 U.S. 138, 144 (2015); *see also In re Charger Ventures*, 64 F.4th at 1381.

We consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019); *M2 Software, Inc. v. M2 Commc’ns., Inc.*, 450 F.3d 1378, 1381 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, Opp. Nos. 91194974 and 91196358, 2015 WL 1646447, at \*8 (TTAB

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<sup>8</sup> Appeal Brief, 6 TTABVUE 7.

<sup>9</sup> Reply Brief, 15 TTABVUE 4.

<sup>10</sup> <https://www.merriam-webster.com/dictionary/sol> (last visited July 5, 2024).

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2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). Varying weights, however, may be assigned to the *DuPont* factors depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 1355 (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”). Moreover, “each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 1199 (CCPA 1973).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods or services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 1341-42 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (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, 1322 (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 goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164 (Fed. Cir. 2002)). We address these two factors and other relevant *DuPont* factors below.

#### **A. Similarity or Dissimilarity of the Marks**

Under the first *DuPont* factor, we consider the “similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial

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impression.” *DuPont*, 476 F.2d at 1361; *see also Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1319 (Fed. Cir. 2014). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s LLC*, Ser. No. 87075988, 2018 WL 2734893, at \*5 (TTAB 2018) (citing *In re Davia*, Ser. No. 85497617, 2014 WL 2531200, at \*2 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019).

The issue is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression such that confusion as to the source of the goods and services offered under the respective marks is likely to result. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012). The focus is on the recollection of an ordinary consumer, who normally retains a general rather than specific impression of trademarks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 1007 (CCPA 1971); *L’Oreal S.A. v. Marcon*, Opp. No. 91184456, 2012 WL 1267956, at \*5 (TTAB 2004); *Sealed Air Corp. v. Scott Paper Co.*, Opp. No. 91055167, 1975 WL 20752, at \*3 (TTAB 1975).

We do not predicate our analysis on a dissection of the involved marks; we consider the marks in their entirety. *Stone Lion*, 746 F.3d at 1321; *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.”). But one feature of a mark may be more significant than another, and it is not improper, for rational reasons, to give

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more weight to a dominant feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *See, e.g., In re Charger Ventures*, 64 F.4th at 1382 (permissible for the Board “to focus on dominant portions of a mark”); *In re Detroit Athletic, Co.*, 903 F.3d 1297, 1305 (Fed. Cir. 2018) (it was not error for the Board to focus on dominant portions of the marks).

Applicant argues that its marks are “different in visual impact” and sound from the Cited Mark because of “the additional letters ‘GEAR’ at the end of the [Cited] [M]ark[.]”<sup>11</sup> The presence of the word “gear” in the Cited Mark does differentiate it somewhat from Applicant’s marks in appearance and sound, but we find that the marks are more similar than different.

The word SOL is the dominant element of the Cited Mark, and as such, it is entitled to greater weight in our analysis comparing the marks. *See, e.g., Stone Lion*, 746 F.3d at 1322; *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). We reach this conclusion because: (1) SOL is the first portion of the Cited Mark, *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, Opp. No. 91074797, 1988 WL 252340, at \*3 (TTAB 1988); and (2) the suffix GEAR in the Cited Mark, meaning “equipment, paraphernalia,”<sup>12</sup> is generic for the goods featured in Registrant’s retail and online

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<sup>11</sup> Appeal Brief, 6 TTABVUE 6.


<sup>12</sup> June 20, 2023 Final Office Action, TSDR 7 (MERRIAM-WEBSTER online dictionary). Applicant implicitly criticizes this evidence as “not attached to the first Office Action.” Appeal Brief, 6 TTABVUE 9. This criticism is without merit. The Examining Attorney properly introduced the dictionary definition for “gear” during prosecution of the applications.

We take judicial notice that one meaning of “paraphernalia” is “articles of equipment designed for a particular use or activity: apparatus,” e.g. “sports paraphernalia.” <https://www.merriam-webster.com/dictionary/paraphernalia> (last visited July 5, 2024).

retail store services, “featuring outdoor sports **equipment** and river **gear**, namely, ... boats.” *See, e.g., In re Detroit Athletic*, 903 F.3d at 1305 (“[N]on-source identifying nature of the words ‘Co.’ and Club’ and the disclaimers thereof constitute rational reasons for giving those terms less weight in the analysis.”); *In re Chatam*, 380 F.3d at 1342-43 (“Board properly accorded ... less weight” to generic term ALE because it had “nominal commercial significance”). Consumers with a general recollection are likely to focus on and remember the SOL portion of the Cited Mark.

Accordingly, while we do not ignore the suffix GEAR in the Cited Mark, we find this difference is not sufficient to alleviate the similarities in appearance and sound between the marks because the Cited Mark starts with the dominant word SOL, which comprises the whole of Applicant’s standard-character mark SOL and the

literal element of Applicant’s mark . *See In re Charger Ventures*, 64 F.4th at 1382 (recognizing that “an additional word or component may technically differentiate a mark but do little to alleviate confusion”). Moreover, the design

element in the mark  is not significant enough to create any meaningful distinction between the marks in appearance and, as to sound, the design element is not likely to be verbalized. *See, e.g., In re Viterra, Inc.*, 671 F.3d 1358, 1366 (Fed. Cir. 2012) (“[T]he verbal portion of a word and design mark likely will be the dominant portion ... given that the literal component of brand names likely will appear alone when used in text and will be spoken when requested by consumers.”); *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82 (Fed. Cir. 1983) (“[I]n a




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composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.”).

We further find that a likelihood of confusion is increased because Applicant’s standard-character mark SOL and the literal portion of Applicant’s mark



are subsumed within Registrant’s standard-character mark SOLGEAR as the dominant element. *Hunter Indus., Inc. v. Toro Co.*, Opp. No. 91203612, 2014 WL 1649332, at \*11 (TTAB 2014) (“Likelihood of confusion often has been found where the entirety of one mark is incorporated within another.”); *see also Stone Lion*, 746 F.3d at 1320-22 (affirming Board’s finding that the applicant’s mark STONE LION CAPITAL incorporated the entirety of the registered marks LION CAPITAL and LION); *Double Coin Holdings Ltd. v. Tru Dev.*, Can. No. 92063808, 2019 WL 4877349, at \*9 (TTAB 2019) (in finding “the parties’ marks are similar in their entireties,” the Board noted that “Tru’s junior mark, ROAD WARRIOR contains Double Coin’s entire mark WARRIOR”). It is foreseeable that consumers familiar with the Cited Mark upon encountering Applicant’s marks may mistakenly believe that Registrant has started selling its own branded “gear,” including sailboats, under the shortened marks SOL and . Alternatively, consumers may mistakenly believe that Applicant is using the SOLGEAR mark for the retail and online retail sale of its SOL sailboats and other outdoor gear.

As to meaning, Applicant argues that its marks connote “the fifth note of a major scale,” a connotation that the Cited Mark “lacks.”<sup>13</sup> As to commercial impression, however, Applicant asserts that the word SOL in its marks and the Cited Mark “is ‘the fifth note of a major scale.’”<sup>14</sup> Applicant further contends that its marks do not include the connotation or commercial impression of the word “gear” in the Cited Mark, meaning “one of a set of toothed wheels that work together to alter the relation between the speed of a driving mechanism (such as the engine of a vehicle or the crank of a bicycle) and the speed of the driven parts (the wheels).”<sup>15</sup>

It is unclear why Applicant contends that the Cited Mark does not connote “the fifth note of a major scale” but asserts that the Cited Mark conveys the commercial impression of “the fifth note of a major scale.”<sup>16</sup> In any event, we must consider the meaning of the marks in the context of the goods and services. *See, e.g., In re Giovanni Food Co.*, Ser. No. 77796257, 2011 WL 810217, at \*2 (TTAB 2011) (comparing meaning of the marks in “the context of the respective goods and services); *Presto Prods.*, 1988 WL 252340, at \*3 (“It is obvious [from the text of Section 2(d) of the Trademark Act] that the significance of a mark must be determined not in the abstract, but rather in relation to the goods or services to which it is applied, and the

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<sup>13</sup> Appeal Brief, 6 TTABVUE 7.

<sup>14</sup> *Id.*


<sup>15</sup> *Id.*

<sup>16</sup> More specifically, Applicant contends that the commercial impression of the Cited Mark, “considered in its entirety, is ‘the fifth note of a major scale for one of a set of toothed wheels that work together to alter the relation between the speed of a driving mechanism (such as the engine of a vehicle or the crank of a bicycle) and the speed of the driven parts (the wheels).’” *Id.*

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context in which it is used, because that is how the mark is encountered by purchasers.”).


We find that in the context of Applicant’s goods and Registrant’s services, consumers are not likely to perceive SOL as meaning “the fifth note of a major scale.” Because Applicant’s sailboats are for use outdoors and in typically good weather, we find that the Applicant’s marks are likely to connote and convey the commercial impression of the “sun,” which is one meaning of the word SOL. The sunburst design

in Applicant’s mark  reinforces this connotation and commercial impression. *See, e.g., Herbko v. Kappa Books*, 308 F.3d at 1165 (“This design connotes a crossword puzzle, which reinforces the connotation created by the words of the mark. Thus, the puzzle design does not convey any distinct or separate impression apart from the word portion of the mark. Rather, it serves only to strengthen the impact of the word portion in creating an association with crossword puzzles.”); *In re 1<sup>st</sup> USA Realty Profs. Inc.*, Ser. No. 78553715, 2007 WL 2315610, at \*5 (TTAB 2007) (“[B]ecause a stars motif is often associated with the United States, the stars design tends to simply reinforce the component USA in applicant’s mark, rather than having a separate connotation or making a separate impression”); *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, Opp. No. 91078134, 1994 WL 558831, at \*7 (TTAB 1994) (coat of arms design in opposer’s mark reinforced the meaning of the word portion of the mark referring to a duke).

In the context of Registrant’s retail and online retail store services “featuring outdoor sports equipment and river gear, namely, ... boats,” we find that consumers

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are similarly likely to perceive the word SOL in the Cited Mark as a reference to the “sun” and the word “gear,” as meaning “equipment, paraphernalia.” In its entirety, the Cited Mark SOLGEAR connotes and conveys the commercial impression of a retail and online retail store featuring equipment and gear for use outdoors in the sun.

In sum, based on the record before us, we find that Applicant’s marks SOL and  for “sailboats” have a connotation and commercial impression that is similar and related to that of the Cited Mark SOLGEAR for retail and online retail store services featuring outdoor equipment and river gear, including sailboats (the sun v. gear for use in the sun). Further, because the Cited Mark incorporates the prefix SOL as its dominant element, we find that the marks in their entirety are more similar than different in appearance and sound. The first *DuPont* factor weighs in favor of finding confusion likely.

**B. Similarity or Dissimilarity of the Goods and Services, Trade Channels and Consumers**

Under the second *DuPont* factor, we consider “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration” and under the third *DuPont* factor we consider “the similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 476 F.2d at 1361; *In re Detroit Athletic*, 903 F.3d at 1306, 1308; *Sabhnani*, 2021 WL 6072822, at \*8. We must base our comparisons under the second and third *DuPont* factors on the services identified in Cited Registration and the goods identified in the involved applications.

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*E.g., In re Charger Ventures*, 64 F.4th at 1383 (“The relevant inquiry in an ex parte proceeding focuses on the goods and services described in the application and registration.”) (emphasis omitted); *Sabhnani*, 2021 WL 6072822, at \*10 (“[A]s with the relatedness of the goods, the similarity or dissimilarity of the channels of trade must be determined based on the identifications of goods in the parties’ registrations rather than current real-world conditions.”).

It is well settled that the goods and services need not be identical or even competitive to support a finding of likelihood of confusion. Rather, it is sufficient that the goods and services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. *See Coach Servs.*, 668 F.3d at 1369 (quoting *7-Eleven Inc. v. Wechsler*, Opp. No. 91117739, 2007 WL 1431084, at \*6 (TTAB 2007)); *see also In re St. Helena Hosp.*, 774 F.3d 747, 752 (Fed. Cir. 2014) (A proper comparison of the goods and services “considers whether ‘the consuming public may perceive [the respective goods and services of the parties] as related enough to cause confusion about the source or origin of the ... [goods and] services.’”) (quoting *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267 (Fed. Cir. 2002)).

In considering whether the goods and services are related, the Examining Attorney focused on Registrant’s retail and online retail store services “featuring outdoor sports equipment and river gear, namely, ... boats” so we do too. “Boats” in

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Registrant's identification is broad, encompassing all types of boats, including sailboats. *See, e.g., Monster Energy Co. v. Lo*, Opp. No. 91225050, 2023 WL 417620, at \*7 (TTAB 2023) ("If an application or registration describes goods or services broadly, and there is no limitation as to their nature, it is presumed that the 'registration encompasses all goods or services of the type described.'") (quoting *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 1373 (Fed. Cir. 2013)); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 2015 WL 4464550, at \*17 (TTAB 2015) ("Where an applicant identifies its services broadly, we must presume that the services encompass all services of the type identified."), *aff'd mem.*, 652 F. App'x 971 (Fed. Cir. 2016); *see also In re AC Webconnecting Holding B.V.*, Ser. Nos. 85635277 and 85635287, 2020 WL 5544272, at \*13 (TTAB 2020).

Applicant attempts to distinguish its goods from Registrant's services based on "real world" conditions:

The goods sold by registrant's services are outdoor and river boats used in camping such as rafts and fishing boats and not sail boats. Contrary to the Examining Attorney, Applicant's goods are not the same type of goods that are offered at the registrant's retail store. The registrant does not sell all kinds of boats, but merely sells inflatable rafts and kayaks. The registrant does not produce boats such that they would be goods and is only an authorized Hyside & Rocky Mountain Rafts dealer to sell their boats branded with Hyside in Moab, Utah as evidenced by registrant's website Hyside & Rocky Mountain Rafts for Sale | Solgear | Moab, Utah previously submitted into evidence. The registrant does not sell boats with SOLGEAR marked or branded on them. Therefore, there is no evidence that the registrant's retail store services feature the same type of boats as Applicant.<sup>17</sup>

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<sup>17</sup> Appeal Brief, 6 TTABVUE 11.

This argument is unpersuasive. As we have explained in innumerable decisions, the Board may not consider arguments “about how the parties’ actual goods, services, customers, trade channels, and conditions of sale are narrower or different from the goods and services identified in the applications and registrations.” *In re FCA US LLC*, Ser. No. 85650654, 2018 WL 1756431, at \*4 n.18 (TTAB 2018); *see also, e.g., i.am.symbolic*, 866 F.3d at 1327 (“[T]he Board properly declined to import restrictions into the identification of goods based on alleged real world conditions.”); *Stone Lion*, 746 F.3d at 1321 (the Board must “give full sweep” to an identification of goods regardless of registrant’s actual business); *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 1373 (Fed. Cir. 2013) (“The PTO proceedings are “based on the content of the registration application” and not upon any specific use of the challenged mark in commerce.”); *In re Thor Tech, Inc.*, Ser. No. 78634024, 2009 WL 1098997, at \*5 (TTAB 2009) (“We have no authority to read any restrictions or limitations into the registrant’s description of goods.”).

Considering the goods and services as they are identified in Applicant’s applications and the Cited Registration, it is well established that confusion may be likely to occur where, as here, the registrant’s retail store services are broad enough to feature the applicant’s goods. *In re Detroit Athl.*, 903 F.3d at 1306 (“[W]hile the goods [clothing] and services [sports apparel retail services] are not identical, they substantially overlap, which weighs in favor of finding a likelihood of confusion.”); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464 (Fed. Cir. 1988) (finding likelihood of confusion where “applicant’s “general merchandise store services” would include

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the sale of furniture covered by the registered mark); *In re Country Oven, Inc.*, Ser. No. 87354443, 2019 WL 6170483, at \*3 (TTAB 2019) (finding bread buns and retail bakery shops, which identification was broad enough to include the retail sale of bread buns, related); *In re House Beer, LLC*, Ser. No. 85684754, 2015 WL 1646441, at \*6 (TTAB 2015) (holding the use of identical marks for beer and retail store services featuring beer likely to cause confusion; “As our principal reviewing court has noted, ‘trademarks for goods find their principal use in connection with selling the goods’ and accordingly marks for goods and marks for the service of selling such goods will have their impact on the purchasing public in the same marketplace.”); *Wet Seal, Inc. v. FD Mgmt., Inc.*, Opp. No. 91157022, 2007 WL 458529, at \*10 (TTAB 2007) (finding fragrances and women’s retail clothing stores related); *In re Thomas*, Ser. No. 78334625, 2006 WL 1258862, at \*2 (TTAB 2006) (finding confusion likely between similar marks for jewelry and retail jewelry store services); J. Thomas McCarthy, 3 MCCARTHY ON TRADEMARKS ON UNFAIR COMPETITION § 24:25 (5th ed. May 2024 update) (“Where the services consist of retail sales services, likelihood of confusion is found when another mark is used on goods which are commonly sold through such a retail outlet.”). We thus find that the identifications in the applications and Cited Registration themselves support that Applicant’s “sailboats” are inherently related to Registrant’s retail and online retail store services “featuring outdoor sports equipment and river gear, namely ... boats.” *In re Country Oven, Inc.*, 2019 WL 6170483, at \*3 (identifications themselves supported relatedness of goods and



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services); *Hewlett-Packard v. Packard Press*, 281 F.3d at 1267 (identifications themselves may support finding of relatedness).

Further, the Examining Attorney introduced evidence of third parties using a single mark, or variation thereof, for sailboats and online retail store services featuring sailboats:

- SUNFISHDIRECT online retail store selling SUNFISH sailboats;<sup>18</sup>
- MCLAUGHLIN online retail store selling MCLAUGHLIN OPTIMIST sailboats;<sup>19</sup>
- REVERSO online retail store selling REVERSO sailboats;<sup>20</sup> and
- TIWAL online retail store selling TIWAL sailboats.<sup>21</sup>

This evidence further supports a finding that Applicant’s sailboats and Registrant’s retail and online retail store services “featuring outdoor sports equipment and river gear, namely, ... boats” are related. *In re Country Oven*, 2019 WL 6170483, at \*6 (evidence that third parties used a single mark for retail bakery shops and bakery products “bloster[ed]” finding of relatedness); *Wet Seal*, 2007 WL 458529, at \*10 (finding fragrances related to women’s retail clothing stores where the

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<sup>18</sup> June 20, 2023 Final Office Action, TSDR 31-33; September 29, 2023 Denial of Request for Reconsideration, TSDR 7.

<sup>19</sup> June 20, 2023 Final Office Action, TSDR 39-43; September 29, 2023 Denial of Request for Reconsideration, TSDR 6.

<sup>20</sup> September 29, 2023 Denial of Request for Reconsideration, TSDR 9 (the pricing is in Euros but the website indicates that the entity ships to the U.S.: “Allow 6-8 weeks transit time with XPO Logistics USA”).

<sup>21</sup> *Id.* at TSDR 10.

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evidence showed clothing stores selling collateral products such as fragrances or other beauty care products “under either the same marks or variations of the store marks”).

Turning to trade channels and classes of purchasers, there are no restrictions in the Cited Registration or involved applications. Thus, we must reject Applicant’s arguments that Registrant: (1) “is only an authorized Hyside & Rocky Mountain Rafts dealer” and does not sell sailboats;<sup>22</sup> (2) Registrant’s brick and mortar store is in Moab, Utah whereas “Applicant’s trade channel is a brick and mortar location in Michigan”;<sup>23</sup> and (3) “Applicant’s customers are consumer who want to purchase sail boats” while “registrant’s customers are consumers who want to purchase retail store services featuring outdoor sports equipment and river gear such as boats used in camping like rafts and fishing boats.”<sup>24</sup> *See, e.g., Sabhnani*, 2021 WL 6072822, at \*10; *see also In re Detroit Athletic*, 903 F.3d at 1308 (“[T]he registration does not set forth any restrictions on use and therefore cannot be narrowed by testimony that the applicant’s use is, in fact, restricted to a particular class of purchasers”) (citation and internal quotation marks omitted). “Indeed, the owner of an unrestricted registration [like the Cited Registration] is entitled to change its current trade channels at any time.” *Id.* at 1308.

Applicant’s sailboats presumably move in all relevant trade channels – such as retail and online retail stores like Registrant’s that feature boats, including sailboats

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<sup>22</sup> Appeal Brief, 6 TTABVUE 11.

<sup>23</sup> *Id.* at 13. We also note that the Cited Registration is not geographically restricted and Applicant seeks geographically unrestricted registrations for its marks.

<sup>24</sup> *Id.* at 12-13.

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– to the same consumers that purchase sailboats through such retail and online retail stores. *In re Country Oven*, 2019 WL 6170483, at \*8. Where, as here, “one party uses its mark on goods that are sold in retail stores that customarily vend those goods, it is clear that the trade channels and customers overlap.” *Id.*; *Hyper Shoppes*, 837 F.2d at 464. This is consistent with the evidence of record consisting of the four third-party uses discussed above and nine additional examples in the record of third-party online retail stores selling boats, including sailboats.<sup>25</sup>

In view of the foregoing, the second and third *DuPont* factors favor finding a likelihood of confusion.

### **C. Sophistication of the Relevant Purchasers and Conditions under which Sales are Made**

The fourth *DuPont* factor concerns “[t]he conditions under which and buyers to whom sales are made, i.e. ‘impulse’ v. careful, sophisticated purchasing.” 476 F.2d at 1361. A heightened degree of care when making a purchasing decision may tend to

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<sup>25</sup> June 20, 2023 Final Office Action, TSDR 16-29, 34-38, 44-49; September 29, 2023 Denial of Request for Reconsideration, TSDR 8, 13, 16-18.

To the extent Applicant argues that retail stores that sell sailboats “do not sell outdoor and river boats such as rafts[, kayaks] or fishing boats” (6 TTABVUE 12), the evidence does not support this assertion. The record includes screenshots from seven third-party websites using a single mark to promote the sale of different types of boats or boats with multiple purposes and modes for movement. *See* September 29, 2023 Denial of Request for Reconsideration, TSDR 15 (WEST COAST SAILING featuring, inter alia, HOBIE sailboats and kayaks; one pictured kayak has a sail); *id.* at 16 (RED BEARD SAILING selling, inter alia, sailboats, a ROWONAIR AIRKAYAK, and a raft); *id.* at 17 (the DINGY SHOP selling sailboats and kayaks); *id.* at 21 (GIG HARBOR BOAT WORKS featuring, inter alia, fishing, crabbing and lobster boats as well as sailboats); *id.* at 22 (promoting the PORTLAND PUDGY as a boat “you can row, motor, sail, and even use as a lifeboat”); *id.* at 23 (WHITEHALL ROWING & SAIL featuring “All Water Rowing, Sculling and Sailing Rowboats”); *id.* at 24-25 (HOBIE selling kayaks, fishing boats, and sailboats, including “Hobie Mirage Island trimarans ... multi-mode performers: sail, fish, pedal, paddle”).

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minimize likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000 (Fed. Cir. 1985) (because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED). Conversely, impulse purchases of inexpensive goods or services may tend to have the opposite effect. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1376 (Fed. Cir. 2005).

Applicant argues that the average purchaser of sailboats and the consumers who will be making purchases through Registrant's retail and online retail stores are "experienced, knowledgeable purchasers" who "are not 'impulse' buyers" but rather are consumers who will exercise a high degree of care in making a purchase.<sup>26</sup> The record includes website printouts showing the price of sailboats ranging from \$2,000 to \$47,000. Because sailboats are a high cost item, we agree with Applicant that purchasers of its goods are likely to exercise some degree of care in making a purchase. We find consumers are similarly likely to exercise care in using Registrant's services that have been proven related to Applicant's sailboats, namely, retail and online retail store services "featuring outdoor sports equipment and river gear, namely, ... boats."

We must keep in mind, however, that even those purchasers who may be sophisticated or knowledgeable in a particular field are not necessarily sophisticated in the field of trademarks or immune from source confusion. *See, e.g., Stone Lion*, 746

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<sup>26</sup> Appeal Brief, 6 TTABVUE 13-14.

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F.3d at 1325; *see also In re Research and Trading Corp.*, 793 F.2d 1276, 1279 (Fed. Cir. 1986) (“That the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods [or services]. ‘Human memories even of discriminating purchasers ... are not infallible.’”) (quoting *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 1406 (CCPA 1970)); *Edom Labs. Inc. v. Lichter*, Opp. No. 91193427, 2012 WL 1267961, at \*8 (TTAB 2012) (“[E]ven consumers who exercise a higher degree of care are not necessarily knowledgeable regarding the trademarks at issue, and therefore immune from source confusion.”); *Top Tobacco LP v. N. Atl. Operating Co.*, Consol. Opp. No. 91157248, 2011 WL 6099691, at \*7 (TTAB 2011) (same).

On balance, we find that the fourth *DuPont* factor at best slightly favors finding no likelihood of confusion.

#### **D. Purported Absence of Actual Confusion**

The seventh and eighth *DuPont* factors are “[t]he nature and extent of any actual confusion” and “[t]he length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 177 USPQ at 567. Unlike the second, third, and fourth *DuPont* factors, the eighth *DuPont* factor “requires us to look at actual market conditions.” *In re Guild Mort. Co.*, Ser. No. 86709944, 2020 WL 1639916, at \*8 (TTAB 2020).

Applicant argues that “[i]n the present case, there is no actual confusion,”<sup>27</sup> but it did not introduce any evidence to support this assertion. Attorney argument is no

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<sup>27</sup> Appeal Brief, 6 TTABVUE 15.

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substitute for evidence. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1371 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen Probe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005)).

The Examining Attorney introduced website screenshots, dated September 28, 2023, showing Applicant's marks (subject to intent to use applications) in use for sailboats,<sup>28</sup> but the record does not reflect when Applicant started using its marks or the extent of such use. On the record before us, we cannot find that there has been any meaningful opportunity for actual confusion to have occurred. *See, e.g., Made in Nature, LLC v. Pharmavite LLC*, Consol. Opp. No. 91223352, 2022 WL 2188890, at \*30 ("for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred"). Even if the record were developed on this point, we do not know whether Registrant is aware of any instances of actual confusion. *See, e.g., In re Guild Mort.*, 2020 WL 1639916, at \*9 ("[I]n this ex parte context, there has been no opportunity to hear from Registrant about whether it is aware of any reported instances of confusion. We therefore are getting only half the story."); *In re Opus One Inc.*, Ser. No. 75722593, 2001 WL 1182924, at \*7 (TTAB 2001) (absence of actual confusion in ex parte cases "entitled to limited probative weight in the likelihood of confusion analysis" because the Board generally has no information regarding whether registrant is aware of any actual confusion and it is difficult to determine whether there has been a significant opportunity for confusion to have occurred).

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<sup>28</sup> September 29, 2023 Denial of Request for Reconsideration, TSDR 145-47.

### **E. Extent of Potential Confusion**

Under the twelfth *DuPont* factor, Applicant argues that “any potential confusion would be de minimis because the goods sold by registrant’s services are outdoor and river boats used in camping such as rafts and fishing boats and not sail boats.”<sup>29</sup> As discussed above, Applicant’s argument is misplaced, as Registrant’s retail store services feature boats without limitation on the types of boats sold. The twelfth *DuPont* factor is neutral.

### **F. Thirteenth *DuPont* Factor**

Under the thirteenth *DuPont* factor, “[a]ny other established fact probative of the effect of use,” *DuPont*, 177 USPQ at 567, we consider Applicant’s argument that “other cases favor” registration of Applicant’s marks.<sup>30</sup> Specifically, Applicant argues:

In the identical context of ex parte examination of a mark, the Federal Circuit in *In Re Mars, Inc.*, 741 F.2d 395, 222 U.S.P.Q. 938, ruled that there was no substantial doubt in the court’s mind that confusion is unlikely between the mark “Canyon” for fresh citrus fruits and the identical mark for another class of goods namely candy bars. In *Kiekhaefer Corp. v. Willys-Overland Motors, Inc.*, 236 F.2d 423, 111 U.S.P.Q. 105 (1956), the CCPA ruled that there was no likelihood of confusion for the identical mark ‘Hurricane’ in connection with the respective goods of outboard motors and auto engines. The mark “Mini Cinema” for erotic movie theaters was held not to be confusingly similar to the identical mark for family movie theaters in *Modular Cinemas of America, Inc. v. Mini Cinemas Corp.*, 348 F.Supp. 578, 175 U.S.P.Q. 355 (S.D.N.Y. 1972). The mark “Astra” was held not to be confusingly similar in association with the respective goods of a computerized blood analyzer machine and a local anesthetic preparation in *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 U.S.P.Q. 786 (1st Cir. 1983). The mark “Bravo’s” for crackers was held not to be confusingly similar to the mark “Bravos” for tortilla

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<sup>29</sup> Appeal Brief, 6 TTABVUE 15.


<sup>30</sup> *Id.*

chips in *Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960, 209 U.S.P.Q. 969 (2d Cir. 1981).<sup>31</sup>

Applicant has not explained how these cases, involving very different goods and services and marks from those at issue here, support registration of its marks. Moreover, as Applicant acknowledges<sup>32</sup> and we have explained repeatedly, we are bound to consider each case on its own merit and record. *See, e.g., In re Nett Designs, Inc.*, 236 F.3d 1339, 1342 (Fed. Cir. 2001); *see also In re Chatam*, 380 F.3d at 1344 (noting that likelihood of confusion cases are fact dependent in distinguishing case applicant “invoked” to support registration of its mark); *Indus. Nucleonics v. Hinde*, 475 F.2d at 1199 (explaining that each case must be decided on its own facts and “the differences are often subtle ones”).

The thirteenth *DuPont* factor is neutral.

### III. Conclusion

Applicant’s marks SOL (standard characters) and  have a similar connotation and commercial impression to the Cited Mark SOLGEAR and the marks are also more similar than different in appearance and sound, such that the first *DuPont* factor favors finding a likelihood of confusion. The second and third

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<sup>31</sup> *Id.* Applicant also cites *Zazu Designs v. L’oreal S.A.*, 979 F.2d 499 (7th Cir. 1992) asserting that: “In ruling that the defendant’s use of the mark Zazu in connection with hair cosmetics, i.e. hair coloring that is easily washed out, was not an infringement of plaintiff’s use of the mark Zazu in connection with hair salons, the 7th Circuit reasoned that ‘(plaintiff) made first use of ZAZU in connection with hair services in Illinois, but this does not translate to a protectable right to market hair products nationally.’” *Id.* The geographic scope of Registrant’s rights is not before us. In any event, as previously stated, neither the cited registration nor the involved applications are geographically restricted.

<sup>32</sup> Applicant’s Brief, 6 TTABVUE 16.



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*DuPont* factors also weigh in favor a finding confusion likely, as Applicant's goods, namely sailboats, are encompassed within the goods featured in Registrant's retail and online retail store services, and the trade channels and consumers overlap. Consumers of Applicant's goods and Registrant's services are likely to exercise some care in making a purchase, so the fourth *DuPont* factor weighs slightly against finding confusion likely, but this is far outweighed by the first, second and third *DuPont* factors supporting a finding that confusion is likely. The other *DuPont* factors discussed above are neutral.

Accordingly, we find that Applicant's marks SOL (standard characters) and , both for "sailboats," are likely to cause confusion with the Cited Mark SOLGEAR (standard characters) for retail and on-line retail store services "featuring outdoor sports equipment and river gear, namely, ... boats."

**Decision:** The refusal to register each of Applicant's marks under Section 2(d) of the Trademark Act is affirmed.