

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: September 9, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Oakley, Inc.

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Serial No. 97538932

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Justin D. Care and Michelle E. Tochtrop of Pearne & Gordon LLP,
for Oakley, Inc.

Michael Keating, Trademark Examining Attorney, Law Office 101,
Zachary Sparer, Managing Attorney.

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Before Coggins, English, and Allard,
Administrative Trademark Judges.

Opinion by Coggins, Administrative Trademark Judge:

Oakley, Inc. (“Applicant”) seeks registration on the Principal Register of the mark


OAKLEY KATO (in standard characters) for

Optical lenses; ophthalmic lenses; contact lenses; cases for contact lenses; eyeglasses; sunglasses; cases for eyeglasses and sunglasses; frames for eyeglasses; frames for sunglasses; frames for spectacles; chains for eyeglasses; chains for sunglasses; cords for spectacles; cords for eyeglasses; cords for sunglasses; parts for spectacles, namely, replacement lenses, frames, nose pads, bridge pads, spectacle temples, ear stems, eyeglass holders, adjustable grips, ear locks; goggles, namely, goggles for

swimming, snow, scuba, and for sports, in International Class 9.¹

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 goods identified in the application, so resembles the following three marks on the Principal Register, owned by the same registrant



-  for "sunglasses and eye glasses," in International Class 9;²
- CATO (standard characters) for "sunglasses," in International Class 9;³
- CATO (standard characters) for "sunglasses; eyeglasses" in International Class 9;⁴

as to be likely to cause confusion, to cause mistake, or to deceive.

When the refusal was made final, Applicant requested reconsideration. After the Examining Attorney denied the request for reconsideration, Applicant appealed to this Board. We reverse the refusal to register.

¹ Application Serial No. 97538932 was filed August 8, 2022, 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.

² Registration No. 5586795, issued October 16, 2018. This registration includes goods or services in Classes 14, 18, 25, 26, and 35 which are not at issue in the appeal.

³ Registration No. 4054848, issued November 15, 2011; renewed. This registration includes goods in Classes 14, 18, and 25 which are not at issue in the appeal.

⁴ Registration No. 5639861, issued December 25, 2018. This registration includes additional goods in Class 9 and other goods in Classes 14, 16, and 20 which are not at issue in the appeal.

I. Likelihood of Confusion

Section 2(d) of 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 of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Our determination under Section 2(d) involves an analysis of all probative facts in evidence that are relevant to the factors 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) (“*DuPont*,” setting forth factors to be considered and referred to as “*DuPont* factors”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003).

In any likelihood of confusion analysis, different *DuPont* factors may play a dominant role and some factors may not be relevant. *Naterra Int’l, Inc. v. Bensalem*, 92 F.4th 1113, 2024 USPQ2d 293, at *2 (Fed. Cir. 2024) (quoting *Tiger Lily Ventures Ltd. v. Barclays Cap. Inc.*, 35 F.4th 1352, 2022 USPQ2d 513, at *7 (Fed. Cir. 2022)). In addition, varying weight may be assigned to each factor depending on the evidence presented, and “any one of the factors may control a particular case.” *Id.*; see also *In re Charger Ventures LLC*, 64 F.4th 1375, 2023 USPQ2d 451, at *4 (Fed. Cir. 2023). While we consider each *DuPont* factor for which there is evidence and argument, *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019), two key considerations are the similarities between the marks and the similarities between the goods. *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747

(Fed. Cir. 2017) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)). These factors, and two others, are discussed below.

We focus our likelihood of confusion analysis on the registered standard-character mark CATO in Registration No. 4054848 which, as outlined above, identifies sunglasses. We consider this mark to be the most relevant of the cited registrations for our *DuPont* analysis because it is registered in standard characters and, therefore, can be depicted in any font style, size, or color. Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a). If we do not find a likelihood of confusion with respect to this registered mark and its goods, then there would be no likelihood of confusion with the other cited registrations. *See In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010) (confining likelihood of confusion analysis to one of two cited marks).

A. Similarity or Dissimilarity of the Goods, Trade Channels, and Classes of Consumers

“We begin with the second and third *DuPont* factors, which respectively consider ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,’ and ‘the similarity or dissimilarity of established, likely-to-continue trade channels.’” *Sabhani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *19 (TTAB 2021) (quoting *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051-52 (Fed. Cir. 2018) and *DuPont*, 177 USPQ at 567).

We compare the goods as they are identified in the involved application and cited registration. *In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at *3 (TTAB 2020) (citing, inter alia, *Detroit Athletic Co.*, 128 USPQ2d at 1052). 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 in the application. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018); *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).

The identification of goods in the application and cited registration each include “sunglasses.” The goods are, therefore, identical in part. Given the in-part legal identity of the identified goods, and the lack of restrictions or limitations in the application or cited registration as to their nature, channels of trade, or classes of consumers, we must presume that the channels of trade and classes of purchasers for these goods are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (Board entitled to rely on this legal presumption when determining likelihood of confusion even in absence of evidence regarding channels of trade and classes of consumers).

Applicant does not address relatedness of the goods or channels of trade in its brief, apparently conceding these points. *In re Morinaga Nyugyo K.K.*, 120 USPQ2d 1738, 1740 (TTAB 2016). We find the *DuPont* factors of the relatedness of goods, channels of trade, and classes of consumers weigh in favor of likelihood of confusion.

B. Consumer Sophistication and Care

The fourth *DuPont* factor considers the “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ v. careful, sophisticated purchasing.” *DuPont*, 177

USPQ at 567. Purchaser sophistication or degree of care may tend to minimize likelihood of confusion; conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005).

Applicant argues that its goods include “specialized goods that only sophisticated consumers exercising great care would purchase” after “multiple in-person meetings” with “a licensed ophthalmologist or optometrist and . . . an optician.”⁵ Applicant also argues that its sunglasses are expensive and “retail for around \$300.”⁶ These assertions are not universally true for all sunglasses. For example, sunglasses may be purchased by average consumers of varying degrees of sophistication, under a range of purchasing conditions (e.g., from over-the-counter at retail or simply via the Internet, to circumstances demonstrating careful selection). In addition, the record demonstrates that sunglasses may come in various price points, as low as \$3.99.⁷

There is nothing in the nature of “sunglasses,” without any limitation in the application or cited registration as to their type, price point, or intended consumers, to suggest the goods are necessarily expensive or that their purchasers are particularly sophisticated and careful. *See In re I-Coat Co.*, 126 USPQ2d 1730, 1739

⁵ 4 TTABVUE 9 (emphasis omitted). Citations to the briefs in the appeal record refer to the TTABVUE docket system; citations to the prosecution record refer to the .pdf version of the TSDR system. *See, e.g., In re Seminole Tribe of Fla.*, 2023 USPQ2d 631, at *1 n.1 (TTAB 2023).

⁶ 4 TTABVUE 10.

⁷ November 3, 2023 Denial of Reconsideration at 10, 14 (catofashions.com) (Pink Shield Sunglasses \$3.99; Tortoise Bling Oval Sunglasses \$3.99; Peach Pink Rimless Sunglasses \$3.99).

(TTAB 2018). In fact, the standard of care is that of the least sophisticated potential purchaser. *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014) (cited in *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018) (“Board precedent requires our decision to be based on the least sophisticated potential purchasers.”)). We must therefore presume that both Applicant’s and Registrant’s sunglasses include inexpensive sunglasses purchased by consumers who will not exercise any elevated degree of purchasing care.

The fourth *DuPont* factor is neutral.

C. Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, we compare the marks “in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps.*, 73 USPQ2d at 1691 (quoting *DuPont*, 177 USPQ at 567); *see also Stone Lion*, 110 USPQ2d at 1159. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019).

We assess not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods offered under the respective marks is likely to result. *Cai*, 127 USPQ2d at 1799; *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *see also Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012).

Registrant's mark is CATO. Applicant's mark is OAKLEY KATO. The Examining Attorney argues that these marks are confusingly similar, while Applicant argues they are dissimilar when viewed in their entirety.

The crux of the Examining Attorney's argument is that "CATO and KATO are phonetic equivalents," which "differ in spelling by only one letter" and "are very similar as to sound, meaning and overall commercial impression," and Applicant "has merely added its house[]mark OAKLEY to the term KATO" which "results in a textbook case of reverse confusion."⁸ Applicant contends it is improper to dissect its mark, which instead must be considered in its entirety with the distinctive and dominant first term OAKLEY given its due, and, when properly considered as a whole, the marks make different sounds, and have different appearances and commercial impressions.⁹

The first term in Applicant's mark is OAKLEY. While the first term in a mark is often dominant, *see, e.g., Palm Bay Imps.*, 73 USPQ2d at 1692, that is not always the case. *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1059 (TTAB 2017) ("there is no mechanical test to select the dominant element" of a mark). We find that both terms OAKLEY and KATO in Applicant's mark have equal impact because each word is, from a conceptual viewpoint, equally strong as neither word has any particular descriptive significance in connection with the goods for which Applicant seeks registration.

⁸ 6 TTABVUE 4-5.

⁹ 4 TTABVUE 4-8.

We acknowledge that CATO and KATO are phonetic equivalents and appear similar to the extent they contain three of the same letters. But there are also significant differences. Applicant submitted dictionary definitions of CATO and KATO demonstrating that these terms may carry different connotations to the extent a consumer might be familiar with either term. CATO may refer to the Roman statesman, soldier, and writer Marcus Porcius “the Elder” (a relentless opponent of Carthage), or to his great-grandson Marcus Porcius “the Younger” (also a Roman statesman and soldier, and opponent of Caesar).¹⁰ On the other hand, KATO may refer to a particular group of Native American people in northwestern California, or the language of that people, or to a Japanese surname that is present in the United States.¹¹ Because of the different connotations, CATO and KATO would not engender the same commercial impression to anyone who knows the meaning of either term. For those consumers unfamiliar with either term, KATO would still manifest a different commercial impression, with a more Japanese aura.

When we compare Applicant’s mark OAKLEY KATO in its entirety to Registrant’s mark CATO, we find they are overall more dissimilar than similar. Accordingly, the first *DuPont* factor weighs against finding a likelihood of confusion.

¹⁰ October 13, 2023 Request for Reconsideration at 53-55 (dictionary.com), 58 (merriam-webster.com).

¹¹ October 13, 2023 Request for Reconsideration at 61 (merriam-webster.com), 64 (wiktionary.org).

D. Balancing the *DuPont* Factors

Weighing the *DuPont* factors for which there has been evidence and argument in this appeal, *Charger Ventures*, 2023 USPQ2d 451, at *7, we find that even considering the in-part identical goods, which are presumed to travel in the same channels of trade to the same classes of purchasers, the first *DuPont* factor is dispositive. The dissimilarity of the marks outweighs the other factors. *See Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 119 USPQ2d 1286, 1290 (Fed. Cir. 2016) (“a single [*Du*]*Pont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks”); *Odom’s Tenn. Pride Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 93 USPQ2d 2030, 2032 (Fed. Cir. 2010) (“[E]ven if all other relevant *DuPont* factors were considered in [opposer’s] favor, as the board stated, the dissimilarity of the marks was a sufficient basis to conclude that no confusion was likely.”); *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460-61 (Fed. Cir. 1998) (Federal Circuit affirmed finding of no likelihood of confusion between mark CRYSTAL CREEK for wine and marks CRISTAL for wine and CRISTAL CHAMPAGNE for champagne, where Board relied solely on dissimilarity of marks); *Kellogg Co. v. Pack’em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single [*Du*]*Pont* factor may not be dispositive”). Accordingly, on the record as presented in this appeal, we find no likelihood of confusion.

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II. Decision

The Section 2(d) refusal to register Applicant's mark OAKLEY KATO is reversed.