

**This Opinion is Not a
Precedent of the TTAB**

Mailed: October 8, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Muhammad A Al-Ansari, Dallas W. Patterson and Gordon K. Skinner

Serial No. 97617649
—

Peter Loffler of Loffler Patent Law, for Muhammad A Al-Ansari, Dallas W.
Patterson and Gordon K. Skinner.

Cindy Nguyen, Trademark Examining Attorney, Law Office 106,
Mary Sparrow, Managing Attorney.

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Before Wellington, Greenbaum and O'Connor,
Administrative Trademark Judges.

Opinion by O'Connor, Administrative Trademark Judge:

Muhammad A Al-Ansari, Dallas W. Patterson and Gordon K. Skinner
("Applicants") seek registration on the Principal Register of the mark THANKS
SKATEBOARDING CLUB, in standard characters, for

Clothing, namely, t-shirts, hooded sweatshirts, crewnecks,
and shorts; socks, in Class 25, and

Skateboards, in Class 28.¹

¹ Application Serial No. 97617649 was filed on October 3, 2022 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicants' claim of first use of the mark anywhere and in commerce at least as early as February 11, 2022 for t-shirts, hooded

In response to the Examining Attorney's requirement of a disclaimer of SKATEBOARDING CLUB, Applicants disclaimed the word SKATEBOARDING but not the word CLUB.²

The Trademark Examining Attorney refused registration of the mark under (1) Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a), based on Applicants' failure to comply with the requirement to disclaim SKATEBOARDING CLUB on the ground that the wording is merely descriptive of Applicants' goods within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), and (2) under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that the mark, when used on or in connection with the identified goods, so resembles the standard character mark THANK YOU SKATEBOARDS, registered on the Principal Register for

Bottoms as clothing; footwear; headwear; jackets; short-sleeved or long-sleeved T-shirts; shorts; socks; sweaters; sweatpants; tops as clothing, in Class 25, and

Skateboard decks; skateboard grip tapes; skateboard trucks; skateboard wheels; skateboards; bags for skateboards, in Class 28³

sweatshirts, crewnecks and shorts in Class 25, and under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicants' allegation of a bona fide intent to use the mark in commerce for socks in Class 25 and skateboards in Class 28.

² July 26, 2023 Nonfinal Office Action, TSDR 5-6; Oct. 26, 2023 Response to Office Action, TSDR 1. References to the Application record refer to the online database of the USPTO's Trademark Status & Document Retrieval (TSDR) system. All citations to documents contained in the TSDR database are to the downloaded .pdf versions of the documents.

³ Reg. No. 5835623 (Class 25) and Reg. No. 5835624 (Class 28) both issued on Aug. 13, 2019 to Torey Pudwill ("Registrant"). Registrant disclaimed exclusive rights in the word SKATEBOARDS in both registrations.

as to be likely to cause confusion, mistake or deception. The Section 2(d) refusal and disclaimer requirement were made final, and Applicants appealed. The appeal is fully briefed. We affirm the refusals to register Applicants' mark in both classes absent the required disclaimer under Section 6(a) of the Trademark Act, and under Section 2(d) of the Trademark Act.

I. Evidentiary Issue

In their Brief, Applicants refer to a number of third-party registrations that were never made a part of the record during prosecution of the Application.⁴ The Examining Attorney objects to these references for failure to submit copies of the registrations and as untimely.⁵ We sustain the Examining Attorney's objection and do not consider these references or Applicants' corresponding arguments, as Applicants did not properly make the registrations of record and the listing was submitted for the first time with Applicants' Brief on appeal. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1208.02 (2024) (mere listings of registrations are not sufficient to make the registrations of record); Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d) (record "should be complete prior to the filing of an appeal"; proper procedure to introduce evidence after an appeal has been filed is to seek to suspend the appeal and remand the application for further examination); *see In re Midwest Gaming & Entm't LLC*, Serial No. 85111552, 2013 TTAB LEXIS 55, at

⁴ Applicants' Brief, 4 TTABVUE 6-7. Applicants did not properly make the registrations of record by submitting copies of the registrations as provided in TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 710.03 (May 2024).

⁵ Examining Attorney's Brief, 6 TTABVUE 8-9.

*5 n.3 (TTAB 2013) (new evidence submitted with brief is “untimely and therefore not part of the record for this case”).⁶

II. Disclaimer Requirement

A. Legal Standard

The Director of the USPTO “may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.” Trademark Act Section 6(a). Merely descriptive terms are unregistrable under Trademark Act Section 2(e)(1), and therefore are subject to disclaimer if the mark is otherwise registrable. *See, e.g., In re Omaha Nat’l Corp.*, 819 F.2d 1117, 1119-20 (Fed. Cir. 1987) (affirming disclaimer requirement for “first tier” in the mark FirstTier & Design for use in connection with banking services). Failure to comply with a disclaimer requirement is a ground for refusal of registration. *See In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 1335 (Fed. Cir. 2015) (USPTO can condition registration of a mark on disclaimer of unregistrable component).

A term “is merely descriptive if it immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought.” *In re N.C. Lottery*, 866 F.3d 1363, 1367 (Fed. Cir. 2017) (citing *In re Bayer A.G.*, 488 F.3d 960, 963 (Fed. Cir. 2007)). In contrast, a term is suggestive, and not

⁶ As part of an internal Board pilot program to broaden acceptable forms of legal citation in Board cases, citations in this opinion are in the form recommended in TBMP § 101.03. 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 opinions of the Board, this opinion uses citations to the Lexis legal database and cites only precedential decisions. Practitioners should also adhere to the practice set forth in TBMP § 101.03.

merely descriptive, if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods. *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 1332 (Fed. Cir. 2014) (citations omitted). Where a proposed mark consists of multiple words, the mere combination of descriptive words does not necessarily create a nondescriptive expression. *In re Phoseon Tech., Inc.*, Serial No. 77963815, 2012 TTAB LEXIS 306, at *3-4 (TTAB 2012) (SEMICONDUCTOR LIGHT MATRIX merely descriptive for light curing systems and UV curing systems). “If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive” and therefore unregistrable. *Id.*; *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1177 (Fed. Cir. 2004) (addition of “.com” to the term “patents” only strengthened the descriptiveness of the mark in light of the designation of goods).

Conversely, if a proposed mark comprising a combination of merely descriptive components creates a unitary phrase with a unique, nondescriptive meaning, or if the composite has an incongruous meaning as applied to the goods, the mark may be registrable. *See, e.g., In re Colonial Stores, Inc.*, 394 F.2d 549, 552-53 (CCPA 1968) (SUGAR & SPICE not merely descriptive of “bakery products” because it evokes traditional nursery rhyme); *In re Shutts*, Serial No. 73245440, 1983 TTAB LEXIS 150, at *6 (TTAB 1983) (SNO-RAKE not merely descriptive of snow removal tool without prongs due to incongruity and need for “mental pause” to understand nature of goods); *see also In re EBS Data Processing, Inc.*, 1981 TTAB LEXIS 110, at *4-5

(TTAB 1981) (explaining composite versus unitary mark in context of disclaimer requirement).

Descriptiveness is not considered in the abstract, but must be assessed “in relation to the particular goods for which registration is sought, the context in which [the term] is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use.” *Bayer*, 488 F.3d at 963-64 (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 813 (CCPA 1978)). The descriptiveness analysis concentrates on the identification of goods or services set forth in the application. *See In re Cordua Rests., Inc.*, 823 F.3d 594, 602 (Fed. Cir. 2016) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application”) (quoting *Octocom Sys., Inc. v. Hous. Comput. Servs., Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990)).

“Evidence that a term is merely descriptive to the relevant purchasing public ‘may be obtained from any competent source, such as dictionaries, newspapers, or surveys.’” *Bayer*, 488 F.3d at 964 (quoting *In re Bed & Breakfast Registry*, 791 F.2d 157, 160 (Fed. Cir. 1986)). “A mark need not immediately convey an idea of each and every specific feature of the goods in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the goods.” *In re Fat Boys Water Sports LLC*, Serial No. 86490930, 2016 TTAB LEXIS 150, at *4 (TTAB 2016) (citing *In re Gyulay*, 820 F.2d 1216, 1218 (Fed. Cir. 1987) (words APPLE PIE described key characteristic of potpourri, its scent)).

B. Disclaimer is Required for SKATEBOARDING CLUB.

As noted above, the Examining Attorney maintained the requirement that Applicants disclaim the words SKATEBOARDING CLUB on the ground that the words are merely descriptive of Applicants' goods. The Examining Attorney considered the identification of goods, namely, "skateboards" and "clothing, namely, t-shirts, hooded sweatshirts, crewnecks, and shorts; socks," which she deemed intended for wear by "those who skateboard or are part of a skateboarding club."⁷

According to the Examining Attorney, SKATEBOARDING CLUB

merely describes the intended audience of applicant's [sic] goods, specifically those who belong in a skateboarding club are the same type of consumers who would be interested in purchasing skateboards and clothing for skateboarding. This wording thus merely describes the intended audience of a club, who are "persons for some common object" and "a group identified by some common characteristic," in this case, an affinity for skateboarding.⁸

In support, the Examining Attorney pointed to the following definitions of "skateboarding" and "club" from the Merriam-Webster Dictionary:

- Skateboard (noun) defined as "a short board mounted on small wheels that is used for coasting and for performing athletic stunts" and skateboard (verb) defined as "to ride or perform stunts on a skateboard."⁹

⁷ July 26, 2023 Nonfinal Office Action, TDSR 5-6.

⁸ Examining Attorney's Brief, 6 TTABVUE 11.

⁹ Nov. 14, 2023 Final Office Action, TSDR 12-13.

- Club (noun) defined as “an association of persons for some common object usually jointly supported and meeting periodically”; “also : a group identified by some common characteristic.”¹⁰

The Examining Attorney also submitted printouts from two Internet websites describing a “skateboarding club,” namely:

- Shredlights, blog article entitled “How to start a Skateboarding Club at your University” with detailed discussion of this topic.¹¹
- Terplink.umd.edu, page for Skateboarding Club at the University of Maryland.¹²

On appeal, Applicants do not challenge this evidence or the basic legal standard that “disclaimer is required when the wording is merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of applicant’s [sic] goods and/or services.”¹³ Instead, the sum and substance of Applicants’ argument is that the disclaimer requirement is improper because the “[i]ntended audience of the wording is not on the enumerated list of qualities that require a disclaimer.”¹⁴ Yet neither of the statutory provisions cited by Applicants (Sections 2(e)(1) and 6(a) of the Trademark Act) enumerate any qualities that render a term descriptive.¹⁵

¹⁰ *Id.* at 17.

¹¹ July 26, 2023 Nonfinal Office Action, TSDR 25-31.

¹² *Id.* at 35-36.

¹³ Applicants’ Brief, 4 TTABVUE 8, citing 15 U.S.C. §§ 1052(e)(1), 1056(a).

¹⁴ 4 TTABVUE 8. Applicants’ Brief cites no caselaw, in support of this or their other arguments. *Id.* at 4, 8.

¹⁵ To the extent Applicants refer to the items listed in TMEP § 1209.01(b), we note that the TMEP “sets forth the guidelines and procedures followed by the examining attorneys” at the

Applicants' terse argument notwithstanding, caselaw dating back decades recognizes that the intended users of goods or services are among the characteristics that may be the basis of a descriptiveness finding. *In re Korn Ferry*, Serial No. 90890949, 2024 TTAB LEXIS 224, at *16-21 (TTAB 2024) (reviewing cases). "Taken together, these cases hold that a mark or term comprising part of a mark is merely descriptive of goods or services if it immediately identifies the consumers to which the identified goods or services, or an appreciable number of the goods or services, are at least primarily directed." *Id.* at *20. *See, e.g., In re Planalytics, Inc.*, Serial No. 76322156, 2004 TTAB LEXIS 198, at *11-12 (TTAB 2004) (GASBUYER merely descriptive of on-line risk management services in the field of pricing and purchasing decisions for natural gas); *In re Camel Mfg. Co.*, Serial No. 73355219, 1984 TTAB LEXIS 84, at *4-6 (TTAB 1984) (MOUNTAIN CAMPER merely descriptive of retail and mail order services in the field of outdoor equipment and apparel, given that an appreciable number of applicant's goods were directed toward this category of purchaser); *In re Hunter Publ. Co.*, 1979 TTAB LEXIS 87, at *15 (TTAB 1979) ("In connection with the interpretation of Section 2(e)(1) ... it has been consistently held that a mark which describes the intended users of a particular product is merely descriptive of such goods."); *see also In re MBNA Am. Bank, N.A.*, 340 F.3d 1328, 1331 (Fed. Cir. 2003) (affirming descriptiveness refusal of MONTANA SERIES and PHILADELPHIA CARD for use in connection with "regional affinity" credit card

USPTO, but does not have the force of law. *In re Ala. Tourism Dep't*, Serial No. 87599292, 2020 TTAB LEXIS 191, at *10 (TTAB 2020) (quoting *In re Int'l Flavors & Fragrances, Inc.*, 183 F.3d 1361, 1366 (Fed. Cir. 1999)).

services based in part on Board’s “[f]inding that the marks thus identified the community of intended users” of the identified services).

Here, the record supports a finding that the terms SKATEBOARDING CLUB immediately identify a class of consumers or users to whom Applicants’ goods are directed, namely a group of persons who share an affinity for skateboarding. *See, e.g., Planalytics*, 2004 TTAB LEXIS 198, at *11-12 (“Clearly, applicant’s [GASBUYER] mark describes a feature or characteristic of the services to the extent that it immediately conveys that its services are intended for individuals who purchase natural gas.”); *Camel Mfg.*, 1984 TTAB LEXIS 84, at *5 (“[W]e embrace the holding that a mark is merely descriptive if it describes the type of individuals to whom an appreciable number or all of a party’s goods or services are directed.”).

First, Applicants’ identification of goods recites “skateboards,” along with clothing items, such as “t-shirts, hooded sweatshirts, crewnecks, and shorts,” that are of a casual nature often worn by skateboarders. Indeed, the Examining Attorney’s evidence of skateboarding clubs includes photos of people wearing such items of clothing.¹⁶

In addition, the verb “skateboard,” of which “skateboarding” is a gerund, is defined as “to ride or perform stunts on a skateboard.”¹⁷ Club is defined as “an association of

¹⁶ July 26, 2023 Nonfinal Office Action, TSDR 25 (photo of Clemson Boards Club includes young man wearing hooded sweatshirt); *id.* at 29 (same); *id.* at 31 (photo of skateboarder wearing a t-shirt). Applicants’ specimen of use, digital photos of a crewneck sweatshirt bearing the mark, is consistent. Oct. 3, 2022 Specimen, TSDR 1-2.

¹⁷ Nov. 14, 2023 Final Office Action, TSDR 12-13 (Internet printouts from online version of Merriam-Webster Dictionary, merriam-webster.com).

persons for some common object usually jointly supported and meeting periodically” or, also, as “a group identified by some common characteristic.”¹⁸ Moreover, although not plentiful, the two Internet printouts submitted by the Examining Attorney show that a “skateboarding club” is a recognized type of association of persons for a common object.¹⁹

When viewed in the context of the entire mark THANKS SKATEBOARDING CLUB, the identified goods, the dictionary definitions and the evidence of third-party use of the term “skateboarding club,” SKATEBOARDING CLUB immediately informs the average purchaser that such goods are directed to persons sharing an interest in skateboarding. This is the case whether such persons have formed an association or simply are a group identified by this common characteristic. There is no need for multiple analytical steps or mental gymnastics, or other stunts, to perceive the meaning. Indeed, as Applicants argue in support of purported differences in the marks, use of the adjective SKATEBOARDING before CLUB “refers to a club, namely a club for skateboarding.”²⁰

Combining the terms yields a single unit or unitary expression, but that expression does not present a unique nondescriptive meaning, incongruity or something more than the sum of its parts. *Cf. Shutts*, 1983 TTAB LEXIS 150, at *5-

¹⁸ *Id.* at 17.

¹⁹ July 26, 2023 Nonfinal Office Action, TSDR 25-36. In addition, by recognizing the desire to establish associations, the Shredlights article illustrates that persons often share the common characteristic of an interest in skateboarding, even if they have not yet established such an association.

²⁰ Applicants’ Brief, 4 TTABVUE 7; see also Oct. 26, 2023 Response to Office Action, TSDR 1 (referring to “the discerning world of skateboarding enthusiasts”).

6 (SNO-RAKE presented incongruity because “the idea of a ‘rake’ or ‘raking’ does indeed sit strange in terms of application to snow”). Instead, as explained above, the phrase directly references the intended users of the goods. Hence, the words SKATEBOARDING CLUB in the mark THANKS SKATEBOARDING CLUB are merely descriptive, and Applicants’ disclaimer of SKATEBOARDING alone is not acceptable.

III. Likelihood of Confusion

“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 of the issue of likelihood of confusion is based on analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*DuPont* factors”). We consider each *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); *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, 1164-65 (Fed. Cir. 2002)).

Varying weight may be assigned to each *DuPont* factor depending on the evidence presented. *See Charger Ventures*, 64 F.4th at 1381 (“In any given case, different *DuPont* factors may play a dominant role and some factors may not be relevant to the analysis.”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 1342 (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.”).

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

Under these *DuPont* factors, we compare the goods and services as they are identified in the Application and the cited registrations. *See In re Detroit Ath. Co.*, 903 F.3d 1297, 1306 (Fed. Cir. 2018); *see also Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 1325 (Fed. Cir. 2014) (Board must give “full scope” to an identification of goods or services). “Likelihood of confusion must be found if there is likely to be confusion with respect to any item in a class that comes within the identification of goods in the application and cited registration.” *In re i.am.symbolic, LLC*, Serial No. 85044494, 2015 TTAB LEXIS 369, at *8 (TTAB 2015), *aff’d*, 866 F.3d 1315 (Fed. Cir. 2017). Applicants do not argue that the goods, channels of trade, or

classes of consumers for their goods are different from those of the cited registrations.²¹

Certain of the goods are identical as the Application and cited Registration No. 5835623 both cover “shorts” and “socks” in Class 25 and the Application and cited Registration No. 5835624 both cover “skateboards” in Class 28. The Application’s remaining Class 25 goods overlap with items identified in cited Registration No. 5835623. Specifically, the “t-shirts, hooded sweatshirts, crewnecks” identified in the Application fall within the broadly worded “tops as clothing” identified in cited Registration No. 5835623. Moreover, the “t-shirts” of the Application encompass the “short-sleeved or long-sleeved T-shirts” of that cited registration. Thus, these goods are legally identical. *See, e.g., Double Coin Holdings Ltd. v. Tru Dev.*, Can. No. 92063808, 2019 TTAB LEXIS 347, at *17 (TTAB 2019) (“tires” identified in registration “encompass, and thus are legally identical to,” “vehicle wheel tires,” “automobile tires,” and “tires for vehicle wheels” identified in petitioner’s registration); *In re Hughes Furniture Indus., Inc.*, Serial 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.’”).

There are no limitations in either the Application or the cited registrations as to channels of trade or classes of consumers. Thus, “we must presume that the channels of trade and classes of purchasers are the same as to those legally identical [goods].”

²¹ See Applicants’ Brief, 4 TTABVUE.

Monster Energy Co. v. Lo, Opp. No. 91225050, 2023 TTAB LEXIS 14, at *23 (TTAB 2023) (citing *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (identical goods or services are presumed to travel in same channels of trade to same class of purchasers)); see also *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1372 (Fed. Cir. 2018) (Board “properly followed our case law and presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods”) (internal quotation marks omitted).

B. Similarity or Dissimilarity of the Marks

In considering the first *DuPont* factor, we compare Applicants’ mark THANKS SKATEBOARDING CLUB and the cited mark THANK YOU SKATEBOARDS “in their entireties as to appearance, sound, connotation and commercial impression.” *Detroit Ath.*, 903 F.3d at 1303 (quoting *DuPont*, 476 F.2d at 1361). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, Serial No. 87075988, 2018 TTAB LEXIS 170, at *13 (TTAB 2018) (quoting *In re Davia*, Serial No. 85497617, 2014 TTAB LEXIS 214, at *4 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019).

“The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai*, 901 F.3d at 1373 (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012) (cleaned up)); see also *In re St. Helena Hosp.*, 774 F.3d 747, 751 (Fed. Cir. 2014) (marks “must be considered ... in

light of the fallibility of memory ...”) (internal quotations omitted). Thus, “there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). For instance, as the U.S. Court of Appeals for the Federal Circuit has observed, “[t]hat a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark” *Id.* at 1058. In addition, “where, as here, the goods at issue are identical, ‘the degree of similarity necessary to support a conclusion of likely confusion declines.’” *Viterra*, 671 F.3d at 1363 (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir. 1992)).

Most of Applicants’ arguments, including as to the first terms in each mark, THANKS and THANK YOU, are based on the references made in their brief to purported evidence of third-party registrations, which we do not consider.²² To the extent Applicants simply argue that the initial terms of THANKS SKATEBOARDING CLUB and THANK YOU SKATEBOARDS differ, we are not persuaded. The words THANKS and THANK YOU are both forms of the same word and expressions of gratitude. Specifically, the plural noun “thanks” is defined as “kindly or grateful thoughts” or “an expression of gratitude (often used in an utterance containing no verb and serving as a courteous and somewhat informal

²² Applicants’ Brief, 4 TTABVUE 6-7.

expression of gratitude).”²³ The noun “thank-you” is defined as “a polite expression of one’s gratitude.”²⁴ The words are commonly used interchangeably in speech, with no apparent meaning with reference to the respective identified goods. Thus, although not identical, the words THANKS and THANK YOU are similar in appearance, sound and connotation, and they convey the same commercial impression of gratitude.

There is no evidence that THANKS or THANK YOU has any meaning or significance when applied to any of the goods identified in the Application and cited registrations, and there is no evidence of use by third parties of similar marks in association with similar goods that might dilute the source-identifying capacity of THANKS or THANK YOU for those goods. On the other hand, the trailing terms SKATEBOARDING CLUB and SKATEBOARDS are, at minimum, merely descriptive of the identified goods, and, as discussed above, the former (in Applicants’ mark) requires disclaimer, and the latter (in Registrant’s mark) has been disclaimed. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407 (Fed. Cir. 1997) (given disclaimer of “cafe,” Board correctly found that dominant portion of mark THE DELTA CAFE was DELTA).

Descriptive matter typically is less significant or less dominant when comparing marks. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 947 (Fed. Cir. 2000) (the “descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion”) (quoting *Nat’l Data*, 753 F.2d at 1060). We find that to be

²³ July 26, 2023 Nonfinal Office Action, TSDR 12 (citing online version of Merriam-Webster Dictionary).

²⁴ *Id.* at 19.

the case here, where consumers likely will view the terms SKATEBOARDING CLUB in Applicants' mark and the term SKATEBOARDS in Registrant's mark in their descriptive sense, rather than as a source-distinguishing element in either mark.

The prominence of the terms THANKS and THANK YOU is further enhanced by their placement as the lead element of each mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372-73 (Fed. Cir. 2005) (shared first term VEUVE, which was arbitrary for the goods, rendered the marks similar); *Presto Prods. v. Nice-Pak Prods.*, Opp. No. 91074797, 1988 TTAB LEXIS 60, at *8 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered ...”); *see also Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876 (Fed. Cir. 1992) (upon encountering the marks, consumers must first notice the identical lead word). THANKS and THANK YOU thus serve as the dominant, source identifying elements in each mark.

Applicants' remaining arguments assert differences in the marks' secondary terms, SKATEBOARDING CLUB and SKATEBOARDS, due to their use of the word “skateboard” in different parts of speech.²⁵ Specifically, Applicants note that the cited mark uses the term SKATEBOARDS (no ING) as a noun, to refer to an item of manufacture, whereas Applicants' mark uses the term SKATEBOARDING as an adjective to modify the word CLUB, purportedly lending “a fundamentally different

²⁵ Applicants' Brief, 4 TTABVUE 7.

commercial impression” to the marks.²⁶ We disagree. Although the uses are not identical, both marks contain forms of “skateboard,” and would be perceived by consumers as referring to the activity of skateboarding or goods used therein.

Also, while both Registrant and Applicants have disclaimed their respective uses of SKATEBOARDS / SKATEBOARDING, these terms “are relevant to the assessment of similarity.” *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1243 (Fed. Cir. 2004). “This is so because confusion is evaluated from the perspective of the purchasing public, which is not aware that certain words or phrases have been disclaimed.” *Id.* As noted, “the Board must consider the mark ‘in its entirety, including the disclaimed portion.” *Detroit Ath.*, 903 F.3d at 1305 (quoting *Viterra*, 671 F.3d at 1367)).

Comparing the marks THANKS SKATEBOARDING CLUB and THANK YOU SKATEBOARDS in their entireties, the shared use of skateboard-derivative words as a secondary element after THANKS and THANK YOU increases, rather than lessens, the similarity of the marks, particularly in view of the fallibility of memory. *See St. Helena Hosp.*, 774 F.3d at 751 (marks to be considered in light of the fallibility of memory and not on the basis of side-by-side comparison) (citation omitted).

We have considered the differences between Applicants’ mark and the cited mark, but on the whole we consider the marks quite similar when they are viewed in their entireties, especially when used in connection with identical and legally identical goods.

²⁶ *Id.*

C. Conditions Under Which and Buyers to Whom Sales are Made

The fourth *DuPont* factor considers “the conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 476 F.2d at 1361. “Purchaser sophistication may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect.” *Palm Bay Imps*, 396 F.3d at 1376.

The Examining Attorney argues that “[f]or products that are relatively low-priced and subject to impulse buying, as in the present case, the risk of likelihood of confusion increases because purchasers of these products are held to a lesser standard of purchasing care.”²⁷ Applicants noted in passing in their Response to Office Action (but not in their Brief) that the marks have different commercial impressions, “especially in the discerning world of skateboarding enthusiasts.”²⁸ Although we may deem this argument waived because Applicants do not renew it on appeal, *see* TBMP § 1203.02(g), we consider this unsupported statement for what it is worth for the sake of completeness in view of the Examining Attorney’s argument.

The Examining Attorney submitted evidence of third party websites offering various of Applicants’ and Registrant’s goods in support of relatedness. These websites show a range of prices as low as \$8 for a t-shirt or as high as \$168 for a

²⁷ Examining Attorney’s Brief, 6 TTABVUE 4 (citing *Sock It to Me, Inc. v. Aiping Fan*, Opp. No. 91230554, 2020 TTAB LEXIS 201, at *25 (TTAB 2020) (quoting *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000)).

²⁸ Oct. 26, 2023 Response to Office Action, TSDR 1.

hooded sweatshirt.²⁹ This is consistent with the nature of the identified goods, skateboards and ordinary items of clothing, including casual clothing such as t-shirts, shorts, and hooded sweatshirts. These goods are likely sold to a broad range of consumers at a broad range of price points. Nothing about the identified goods suggests that the consumers are particularly sophisticated or that the conditions of sale would mitigate any confusion that would otherwise be likely. Even if there were evidence that skateboarding enthusiasts are “discerning” purchasers, *cf. Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005) (attorney argument no substitute for evidence), we must base our decision on the least sophisticated potential purchasers, *Stone Lion*, 746 F.3d at 1325, which may include more occasional buyers of the goods.

IV. Conclusion

In sum, we find that when applied to Applicants’ identified goods, the words SKATEBOARDING CLUB merely describe, without any kind of mental reasoning, the intended users of Applicants’ goods. Moreover, we find SKATEBOARDING CLUB is a merely descriptive unitary phrase, expression, or term that must be disclaimed in its entirety. Applicants’ disclaimer of SKATEBOARDING alone is not acceptable.

As for the refusal under Section 2(d) of the Trademark Act, the goods identified in the Application and the cited registrations are identical or legally identical, and are

²⁹ Nov. 14, 2023 Final Office Action, TSDR 282 (printout of bakerskateboards.com, offering t-shirt on sale for \$8), 25 (printout of brooksbrothers.com, offering hoodie for \$168); *see id.* at 25-355 (printouts of third party retailer websites showing clothing and skateboarding goods with prices primarily ranging from low tens of dollars to hundred dollar range).

presumed to travel in the same channels of trade where they will be encountered by the same classes of consumers, with the second and third *DuPont* factors weighing heavily in favor of likelihood of confusion. When considered in their entirety, the marks themselves are quite similar, with the first *DuPont* factor also weighing heavily in favor of likelihood of confusion. Any potential heightened discernment among skateboarding enthusiasts is counterbalanced by the ordinary, casual nature of the identified goods and the evidence that they fall in a relatively modest price range. Thus, the fourth *DuPont* factor is neutral. No other *DuPont* factor weighs for or against likelihood of confusion. Considering all of the evidence and arguments and balancing the factors, we find that confusion is likely when Applicants' and Registrant's marks are used with their respective identified goods.

Decision: The refusal to register Applicants' mark based on the requirement, made under Trademark Act Section 6(a), to disclaim SKATEBOARDING CLUB is affirmed as to both Class 25 and Class 28. The refusal to register Applicants' mark under Trademark Act Section 2(d) also is affirmed as to both classes.