

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: September 23, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Damsselfly Global LLC
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Serial No. 97669661
—

Michele Berdinis of Berdinis Law P.C.,
for Damsselfly Global LLC.

Claudia A. Kopenski, Trademark Examining Attorney, Law Office 129,
Pamela Y. Willis, Managing Attorney.

—
Before Kuhlke, Larkin and Lebow,
Administrative Trademark Judges.



Opinion by Lebow, Administrative Trademark Judge:

Applicant, Damsselfly Global LLC, appeals from a final refusal by the Trademark Examining Attorney to register, on the Principal Register, the composite shown below



(NY disclaimed) for “Back packs; fanny packs; tote bags” in International Class 18, and “Clothing, namely, aprons, t-shirts, sweatshirts, and hats” in International Class

25,¹ in view of the following composite marks owned by the New York State Department of Economic Development (“Registrant”) on the Principal Register:

	<p>“Traveling bags, tote bags, all purpose sports bags” in International Class 18.²</p> <p>“T-shirts” in International Class 25.³</p>
	<p>“Traveling bags, tote bags, drawstring pouches, all purpose sports bags, cosmetic bags sold empty, umbrellas, parasols and walking sticks” in International Class 18.⁴</p> <p>“T-shirts, gloves, hats, jackets, sportshirts, sweaters, scarves, sweatshirts and shoes” in International Class 25.⁵</p>



¹ Application Serial Nos. 97669661 (“the Application”) was filed on November 9, 2022 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegations of a bona fide intention to use the mark in commerce. “The mark consists of the letters NY and, directly above those letters, are the letter I and an image of a flower. There is an ivy-like stem with leaves running in and through the other elements of the mark. The letters are dark grey. The flower is red. The stem and leaves are green. The colors red, green, and dark grey are claimed as features of the mark. The Application also identifies goods in Class 31, which are not subject to the refusal.

² Registration No. 3944680, issued April 12, 2011; renewed. The mark consists of characters in black and a heart in green. The colors green and black are claimed as features of the mark.

³ Registration No. 4099266, issued February 14, 2012; renewed. The mark consists of characters in black and a heart in green. The colors black and green are claimed as features of the mark.

⁴ Registration No. 2431705, issued February 27, 2001; renewed. The lining in the drawing represents the color red.

⁵ Registration No. 1555836, issued September 12, 1989; renewed. The lining in the drawing represents the color red.

	<p>“T-shirts, sweatshirts” in International Class 25.⁶</p>
	<p>“Pet apparel, namely, clothing for domestic pets, dog collar, umbrellas, namely, rain umbrellas, beach umbrellas, golf umbrellas, parasols; luggage tags; bags and reusable bags, namely, book bags, sports bags, bum bags, empty cosmetic bags, backpacks, coin purses, travel bags, handbags and leather credit card pocket wallets; leather and imitation leather key chains; business card cases” in International Class 18;</p> <p>“Clothing, namely, t-shirts, sport shirts, sweatshirts, sweaters, scarves, gloves, hats, jackets, rain coats, socks, pajamas, pants, slippers, shoes, boots; one-piece garments for babies; bottoms, caps, loungewear, shorts, tops, tank tops, cloth bibs and aprons, ear muffs” in International Class 25.⁷</p>

The appeal has been briefed by Applicant and the Examining Attorney.⁸

⁶ Registration No. 4254793, issued December 4, 2012; renewed. The mark consists of the characters “I” and “NY” in black and a heart in rainbow colors. The colors black, red, orange, yellow, green, blue and purple are claimed as features of the mark.

⁷ Registration No. 4267307, issued January 1, 2013. The mark consists of the capital letter “I” followed by a heart with the capital letters “NY” appearing underneath. Color is not claimed as a feature of the mark.

A seventh registration, No. 4409927, was also cited against the Application but has since been cancelled.

⁸ We note that Applicant did not cite to the prosecution record in its brief, and to the extent Applicant cites to evidence at all, it refers exclusively to the 116 pages of evidence it attached in several exhibits to its main brief, which complicated our efforts in deciding this case. While parties and appellants in Board cases “occasionally seem to be under the impression that

For the reasons discussed below, we affirm the refusal to register.

I. Likelihood of Confusion

Section 2(d) of the Trademark Act provides that a mark may be refused registration if it:

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, ... as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive....

15 U.S.C. § 1052(d), *quoted in In re Charger Ventures LLC*, 64 F.4th 1375, 2023 USPQ2d 451, at *2 (Fed. Cir. 2023).

To determine whether there is a likelihood of confusion between marks under Section 2(d), we analyze the evidence and arguments under the factors set forth in *In re E. I. duPont deNemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (the “*DuPont* factors”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015).

“Whether a likelihood of confusion exists between an applicant’s mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors.” *Omaha Steaks Int’l, Inc. v. Greater*

attaching previously-filed evidence to a brief and citing to the attachments, rather than to the original submission is a courtesy or a convenience to the Board[,] [i]t is neither.” *In re Michalko*, 110 USPQ2d 1949, 1950-51 (TTAB 2014). “When considering a case for final disposition, the entire record is readily available to the panel. Because we must determine whether attachments to briefs are properly of record, citation to the attachment requires examination of the attachment and then an attempt to locate the same evidence in the record developed during the prosecution of the application, requiring more time and effort than would have been necessary if citations directly to the prosecution history were provided.” *Id.* Counsel should refrain from this practice in future cases before the Board.

Omaha Packing Co., 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018). We consider each *DuPont* factor for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019). “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.” *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (internal punctuation omitted).

We will focus our analysis on Registrant’s mark in Registration No. 4267307 (hereafter, “the Registration”) because it is closest in appearance to Applicant’s mark (due to the absence of a color claim) and identifies goods that overlap with those in the Application. If we find a likelihood of confusion with respect to this mark, we need not find it with respect to the other marks owned by Registrant. Conversely, if we do not find a likelihood of confusion with respect to this mark, we would not find it with respect to Registrant’s other cited marks. *See In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Relatedness of the Goods, Channels of Trade, and Classes of Customers

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration ... ,” and the third *DuPont* factor concerns the “similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567; *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). A proper comparison of the goods “considers whether ‘the consuming public may perceive [the

respective goods or services of the parties] as related enough to cause confusion about the source or origin of the goods and services.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002)).

The Class 18 and Class 25 goods identified in the Application and Registration are identical in part because both the Application and Registration identify back packs (or backpacks) in Class 18, and t-shirts, sweatshirts, and hats in Class 25. It is sufficient for a finding of likelihood of confusion if relatedness is established for any goods encompassed by the identification of goods within a particular class. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)); *see also In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (“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.”).

The channels of trade and classes of purchasers are also identical because identical goods are presumed to travel in the same channels of trade to the same classes of purchasers. *Viterra*, 101 USPQ2d at 1908 (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are

considered to be the same); *see also In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers”), *quoted in In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672-73 (TTAB 2018).

Applicant does not mention relatedness of the goods, channels of trade, or classes of customers in its brief, apparently conceding these points. *See In re Morinaga Nyugyo K.K.*, 120 USPQ2d 1738, 1740 (TTAB 2016) (viewing the applicant’s failure to address the second and third *DuPont* factors in its appeal brief as an apparent concession on those factors). The second and third *DuPont* factors weigh heavily in favor of finding a likelihood of confusion.

B. Strength of the Registered Mark

Before we turn to a comparison of the marks themselves, we consider the strength of Registrant’s mark, as that will affect the scope of its protection. *See Morinaga Nyugyo*, 120 USPQ2d at 1743 (“[T]he strength of the cited mark is -- as always -- relevant to assessing the likelihood of confusion under the du Pont framework.”).

When evaluating the strength or weakness of a mark, we look at the mark’s inherent strength based on the nature of the term itself, and its commercial strength in the marketplace. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (measuring both conceptual and marketplace strength); *see also Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *17 (TTAB 2022) (quoting *DuPont*, 177 USPQ at 567); *New Era Cap Co. v. Pro Era LLC*, 2020 USPQ2d 10596, at *10 (TTAB 2020) (“[T]he strength of a mark is not a binary factor, but varies

along a spectrum from very strong to very weak.”) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)).

Beginning with commercial strength, we note that in an ex parte appeal the strength of the cited registrant’s mark “is normally treated as neutral because the record generally includes no evidence as to fame.” *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1086 (TTAB 2016). *See also In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009) (noting that the absence of evidence as to the strength of the registered mark “is not particularly significant in the context of an ex parte proceeding”). That is the case here as well. Nevertheless, Applicant itself provides some evidence that Registrant’s mark is commercially strong. First, a Wikipedia article submitted by




Applicant explains, among other things, that Registrant’s mark:

- “is a slogan, a logo, and a song that are the basis of an advertising campaign ... used since 1977 to promote tourism in the state of New York”;
- “appears in souvenir shops and brochures throughout the state”;
- “is the official state slogan of New York”;
- “became a major success”;
- “has become closely associated with New York City, and the placement of the logo on plain white T-shirts readily sold in the city has widely circulated the appearance of the image, making it a commonly recognized symbol”; and
- has become a pop-culture icon, inspiring imitations in every corner of the globe.”⁹

⁹ November 24, 2023 Office Action Response, TSDR 17-19.

Although Wikipedia articles are generally considered hearsay under the Federal Rules of Evidence in inter partes cases, “the Board does not, in ex parte appeals, strictly apply the Federal Rules of Evidence, as it does in inter partes proceedings.” *In re Sela Prods. LLC*, 107 USPQ2d 1580, 1584 (TTAB 2013). Notably, Applicant itself submitted the article and, as discussed *infra*, relies on portions of it to argue how, in fact, Applicant’s mark is or would be pronounced by the public. Specifically, Applicant argues based on this article that “consumers are likely to pronounce [Registrant’s] I LOVE NY Marks because **that’s how the extremely popular and widespread marketing campaign pronounces, and has always pronounced, the I LOVE NY Marks.**”¹⁰ Applicant thus affirmatively acknowledges an “extremely popular and widespread marketing campaign” supporting the cited mark.

We turn next to conceptual strength (a/k/a inherent strength). To determine the conceptual strength of Registrant’s  mark, we evaluate its intrinsic nature, that is, where it lies “along the generic-descriptive-suggestive-arbitrary (or fanciful) continuum of words.” *In re Davia*, 110 USPQ2d 1810, 1814 (TTAB 2014). Here, because Registrant’s mark is registered on the Principal Register without a claim of acquired distinctiveness, it is considered presumptively valid, inherently distinctive, and at most, suggestive of the identified goods. Trademark Act Section 7(b), 15 U.S.C. § 1057(b); *see also See Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (“A mark that is registered on the Principal Register is entitled to all




¹⁰ 4 TTABVUE 11 (Applicant’s Brief) (emphasis added).

Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods.”).

The Federal Circuit has held, however, that if there is evidence that a mark, or an element of a mark, is commonly adopted by many different registrants, that may indicate that the mark or common element has some non-source identifying significance that undermines its conceptual strength as an indicator of a single source. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (“evidence of third-party registrations is relevant to ‘show the sense in which a mark is used in ordinary parlance,’ ... that is, some segment that is common to both parties’ marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that segment is relatively weak’”) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)).

Applicant argues that “[t]he existence of other registrations containing the literal elements of the I LOVE NY Marks shows that the literal elements are ‘relatively weak.’ Therefore, ... the literal elements should be afforded less weight than the design elements.”¹¹ To support this contention, Applicant submitted copies of twenty use-based third-party registrations printed from the USPTO’s TESS database, including the following:

¹¹ *Id.* at 18.

Mark	Relevant Goods / Services
	<p>Tops, sweat shirts, athletic shirts, collared shirts, sweat pants, sweat jackets, hooded sweatshirts, leather jackets, athletic jackets, shorts, undergarments, lingerie, pajamas, tennis shirts, headwear, namely, hats, caps, visors, tennis hats baseball hats.¹²</p>
	<p>Men's women's children's, and infant's clothing, namely, t-shirts, polo shirts, sweatshirts, jeans, jackets, hats, caps, headbands, visors, shoes, sandals, shorts, dresses, wristbands, and socks.¹³</p>
	<p>Men's women's children's, and infant's clothing, namely, t-shirts, baby tees, sweatshirts, jeans, jackets, hats, caps, headbands, shoes, sandals, shorts, dresses, wristbands, and socks. ¹⁴</p>
	<p>Clothing, namely, shirts, t-shirts and sweatshirts.¹⁵</p>
	<p>Clothing, namely, tops, pants, skirts, and dresses.¹⁶</p>
	<p>Beachwear; bottoms; dresses; fashion hats; footwear; men's and women's jackets, coats, trousers, vests; men's suits, women's suits; sandals and beach shoes; shirts; sports pants; sports shirts; sports shoes; swim suits; swim wear; t-shirts; tops; women's clothing, namely, shirts, dresses, skirts, blouses.¹⁷</p>

¹² November 24, 2023 Office Action Response, TSDR 19 (Registration No. 6390592).

¹³ *Id.* at 20 (Registration No. 2990103).

¹⁴ *Id.* at 21 (Registration No. 3096033).

¹⁵ *Id.* at 23 (Registration No. 5165659).

¹⁶ *Id.* at 24 (Registration No. 3620843).

¹⁷ *Id.* at 25 (Registration No. 4940478).

	<p>Clothing, namely, base layers; sun protective clothing, namely, shirts for surfing and beach wear; tops; wearable garments and clothing, namely, shirts; women's clothing, namely, shirts.¹⁸</p>
	<p>Various clothing items including, e.g., athletic shorts; baseball caps; belts made of leather; boxer briefs; boxer shorts; bras; briefs; caps with visors; denim jackets; denim jeans; fabric belts; fedoras; flip flops; footwear for men; footwear for men and women; footwear for women;¹⁹</p>
	<p>Clothing, namely, t-shirts.²⁰</p>
	<p>Clothing, namely, shirts, hats, and sweatshirts.²¹</p>
	<p>Boxer shorts; one piece garment for infants and toddlers; sweat shirts; t-shirts; tank tops; tank-tops; thongs; track suits; underpants.²²</p>
	<p>Clothing, namely, shirts, T-shirts, polos, sweatshirts, knit tops, leggings, shirt, vest, pants, jeans, shorts, knit bottoms, sleepwear; Outerwear, namely, jackets, leather jackets, coats, rain coats, vests.²³</p>

¹⁸ *Id.* at 26 (Registration No. 4220706).

¹⁹ *Id.* at 27 (Registration No. 5549571).

²⁰ *Id.* at 28 (Registration No. 4076885).

²¹ *Id.* at 29 (Registration No. 4032982).

²² *Id.* at 39 (Registration No. 3427388).

²³ *Id.* at 31 (Registration No. 6302050).

<p>I ♥ TREES</p>	<p>Clothing, namely, t-shirts, shirts, sweatshirts, sweatpants, pants, socks, jackets, shorts, skirts, dresses, hats, headbands and caps.²⁴</p>
<p>I ♥ Drilling!</p>	<p>Clothing namely, t-shirts, shirts, tank tops, sweaters, sweatshirts, jackets, aprons, shorts, and headgear, namely, caps and hats.²⁵</p>
<p>I ♥ COMPOSITES</p>	<p>Clothing for men, women and children, namely, shirts, t-shirts.²⁶</p>
<p>I ♥ PIE</p>	<p>Clothing, namely hats, t-shirts, sweatshirts, and pants.²⁷</p>
<p>I ♥ CANNABIS</p>	<p>Various clothing items including, e.g., Ankle socks; Baseball caps; Bathrobes; Belts; Belts made of leather; Bras; Denim jackets; Ear muffs; Fabric belts; Fedoras; Flip flops; Footwear; Footwear for men; Footwear for women; G-strings; Gloves as clothing; Graphic T-shirts; Hats;²⁸</p>
<p>I MI SS NY</p>	<p>Shirts; Tee-shirts.²⁹</p>

²⁴ *Id.* at 32 (Registration No. 4351167).



²⁵ *Id.* at 33 (Registration no. 3852380).

²⁶ *Id.* at 34 (Registration No. 3491265).

²⁷ *Id.* at 35 (Registration No. 3250719).

²⁸ *Id.* at 36 (Registration No. 5785971).

²⁹ *Id.* at 37 (Registration No. 6175958).

	<p>Hats; Sports shirts; T-shirts.³⁰</p>
	<p>T-shirts.³¹</p>

Both Applicant and the Examining Attorney note, quoting TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 807.14(c) and *Jack Wolfskin*, 116 USPQ2d at 1136, respectively, that “a large number of active third-party registrations including the same or similar term or mark component for the same or similar goods or services may be given some weight to show, in the same way that dictionaries are used, that a mark or a portion of a mark has a normally understood descriptive or suggestive connotation, leading to the conclusion that the term or mark component is relatively weak.”³² However, they disagree as to the effect of these particular registrations.

The Examining Attorney argues that while Applicant “provided a plethora of third-party registrations in support of the argument that the literal elements of the marks are weak ... these registrations all incorporate different distinctive wording and are not comparable or definitive in supporting the argument that the marks at

³⁰ *Id.* at 38 (Registration No. 6112413).

³¹ *Id.* at 40 (Registration No. 4384753).

³² 4 TTABVUE 13 (Applicant’s Brief).

present are not confusingly similar.”³³ He further argues that “the marks provided include differing wording such as ‘I MB’, ‘I MARIJUANA’, ‘I TNIAN’ [sic], ‘I RONSON’, ‘I DRILLING!’, and ‘I NODA’, among many others ... none of these marks feature the identical wording at issue in this refusal” and therefore “are not probative in a lack of likelihood of confusion finding.”³⁴

We agree, generally, with the Examining Attorney’s comments. At the same time, we cannot but acknowledge that the formulation and structure of many of these third-party registrations is similar to that of Registrant’s mark, with the expression “I ♥” displayed horizontally at the top (although sometimes on one line) above the subject of the phrase, e.g., LV, GUAM, MAUI, THICK VEGANS, MARIJUANA, COMPOSITES, etc. The evidence, taken as a whole, suggests that the “I ♥” format is often registered, but with additional elements that were considered to have distinguished them overall. Some refer to a geographic location (e.g., LV, GUAM, MAUI, HAWAII, HARLEM, TINIAN, others, an object or thing (e.g., SMALL WAVES, MARIJUANA, THICK VEGANS, PIE, COMPOSITES, TREES), and even a verb (DRILLING!).

We also observe that very few of the registrations refer specifically to “NY,” the abbreviation for New York that is common to the involved marks here. Indeed, out of

³³ 6 TTABVUE 9 (Examining Attorney’s Brief).

³⁴ *Id.* at 9-10.



the 20 third-party registrations submitted by Applicant, only three of them,



and , refer to “NY,” though there is one other referring to a



neighborhood of New York, **HARLEM**. But there are also notable differences among those four, with only one – the Harlem mark – using a ♥ symbol, and even that use is somewhat different with its incorporation of the wording “LOVE” within the ♥ symbol itself.

Importantly, Applicant did not submit any evidence of use of these registered marks. Therefore, we must keep in mind that “third-party registrations standing alone, are not evidence that the registered marks are in use on a commercial scale, let alone that consumers have become so accustomed to seeing them in the marketplace that they have learned to distinguish among them by minor differences.”

Morinaga Nyugyo, 120 USPQ2d at 1740.³⁵

In sum, we find that the frequent registration of marks containing an “I ♥” format shows that these sorts of affinity marks are somewhat weak conceptually, and that

³⁵ Applicant also submitted USPTO TESS database records for a number of applications that never matured into registrations, most of which were blocked by Registrant’s marks, January 8, 2024 Request for Reconsideration, TSDR 13-125, which we have disregarded as not probative. Abandoned applications have “no probative value other than as evidence that the application[s] [were] filed.” *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1606 (TTAB 2018).

Registrant's particular mark reflecting affinity with New York thus has some commercial weakness. However, that weakness is tempered somewhat by the particular differences in the third-party marks resulting from the presence of additional wording and/or elements, very few of which contain the subject of Registrant's (and Applicant's) affinity marks: NY, rendering all of them less similar to the cited mark than Applicant's mark. *Made in Nature*, 2022 USPQ2d 557, at *29. We also account for Applicant's acknowledgement that Registrant's mark has some commercial strength.



C. Similarity of the Marks

We turn now to a comparison of the marks. Under the first *DuPont* factor, we must determine the similarity or dissimilarity of Applicant's and Registrant's marks in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion*, 110 USPQ2d at 1160; *Palm Bay Imps.*, 73 USPQ2d at 1692. "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), *aff'd*, 777 Fed. App'x 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d at 1812). The focus is on the recollection of the average purchaser – here, an ordinary consumer of clothing and bags – who normally retains a general rather than a specific impression of trademarks. *See Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

"While the marks must be considered in their entireties, in articulating reasons for reaching a conclusion on the issue of confusion, 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 entireties.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ2d 749, 751 (Fed. Cir. 1985)). “[S]imilarity is not a binary factor but is a matter of degree.” *St. Helena Hosp.*, 113 USPQ2d at 1085 (internal quotation omitted)).

Again, Applicant’s and Registrant’s marks are:

Applicant	Registrant
	

Comparing the marks, the Examining Attorney observes that:

the literal elements of applicant’s mark and registrant’s mark are I NY, respectively. As such, these marks are nearly identical in appearance, and identical sound, and meaning, “and have the potential to be used ... in exactly the same manner.” ... *i.am.symbolic*, ... 116 USPQ2d [at] 1411 Additionally, because the literal elements are identical, these marks are likely to engender the same connotation and overall commercial impression when considered in connection with applicant’s and registrant’s respective goods and/or services. *Id.* Therefore, the marks are confusingly similar.³⁶

As to appearance, Applicant concedes that “there is some similarity because of the

³⁶ *Id.* at 5.

existence of the word I and the abbreviation NY with the letter I appearing of over the letter N,” but notes there are differences. Specifically, Applicant asserts that:

(1) Registrant’s marks “feature a heart,” whereas Applicant’s mark “features a flower, vines, and leaves”;

(2) Registrant’s marks “have no ornamentation other than a heart,” whereas Applicant’s mark “features a twisting leaf-covered vine running through the entire image, including the literal elements”;

(3) “All of the hearts in [Registrant’s] Marks are in either a solid color or a rainbow,” whereas Applicant’s mark “features a flower in various shades of red”;


(4) “The font in [Registrant’s] Marks is uneven, jagged, and skewed as if made by a typewriter,” whereas Applicant’s mark “uses a font with clean, even lines”; and


(5) “The letters in [Registrant’s] Marks are black and the letter in Applicant’s mark are grey.”³⁷

Points (1) and (2) above essentially assert the same point in different ways. We acknowledge there are differences in the marks resulting from Registrant’s use of a heart design in the upper right quadrant of its mark versus Applicant’s use of a flower design in the upper right quadrant of its mark, with a vine with leaves extending to the other literal elements. We also acknowledge that the respective marks use different fonts, though we disagree with Applicant’s dramatic characterization of those differences; they are still fairly similar overall, especially to a consumer with a general rather than specific recollection of the cited mark who separately encounters

³⁷ 4 TTABVUE 10 (Applicant’s Brief).

Applicant's mark without the opportunity to engage in the sort of painstaking side-by-side comparison made by Applicant. As to points (3) and (4), Applicant either misapprehends or overlooks the fact that Registrant's Registration No. 4267307 for

the mark  upon which we focus in our analysis does not claim color. "Because

applicant's [registration of ] makes no color claim, the drawing of the mark is presumed to contemplate the use of any color," including those shown in Applicant's mark *See Bd. of Trs. v. Pitts.*, 107 USPQ2d 2001, 2021 (TTAB 2013) (citing *In re Data Packaging Corp.*, 453 F.2d 1300, 1302, 172 USPQ 396, 397 (CCPA 1972) and TMEP § 807.14(e)(i) (2012)).

Applicant also argues at one point in its brief that "the design elements in [its] Mark and [Registrant's] Marks are at least equally prominent with the literal elements,"³⁸ and at another point, that "the literal elements should be afforded less weight than the design elements."³⁹ The Examining Attorney, in response, citing *Viterra*, 101 USPQ2d at 1908 (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) and other cases), notes that "when evaluating a composite mark consisting of words and a design, the word portion is normally accorded greater weight because it is likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the goods and/or

³⁸ *Id.* at 9.

³⁹ *Id.* at 18

services.”⁴⁰

On this point, we agree with Applicant’s first position noted above that the words and design should be considered equally prominent (and not its second position that the design should be afforded more weight) because of the nature of the respective marks. We find that there is no dominant element in either Applicant’s or Registrant’s marks. They are both unitary in nature, conveying a single and distinct commercial impression that is distinct from the constituent words “I” and “NY” that they contain. *See Dena Corp. v. Belvedere Int’l Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991) (“A unitary mark has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent elements. In other words, a unitary mark must create a single and distinct commercial impression.”).

In this day and age, it is common knowledge that a heart symbol represents “love” in the context of affinity marks and is often used in text, or in emojis, as a substitute for the term “love.” Indeed, Applicant asserts that “consumers are very likely to pronounce the I LOVE NY Marks as I LOVE NEW YORK,” but attributes that to Registrant’s “extremely popular and widespread marketing campaign pronounces, and has always pronounced [Registrant’s] marks.”⁴¹ We are not sure how Applicant’s mark would be pronounced, or how consumers would call for Applicant’s goods under

⁴⁰ 6 TTABVUE 5 (Examining Attorney’s Brief).

⁴¹ 4 TTABVUE 11 (Applicant’s Brief).

the mark. However, “[t]here is no correct pronunciation of a trademark that is not a recognized word,” *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1651 (Fed. Cir. 2014), and we must consider “all the reasonable possibilities” for the pronunciation of Applicant’s mark. *Inter IKEA Sys., B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 n.19 (TTAB 2014) (citing *Centraz Indus., Inc. v. Spartan Chem. Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006); *Edison Bros. Stores, Inc. v. Brutting E.B. Sport Int’l GmbH*, 230 USPQ 530, 533 (TTAB 1986)). Thus, while we acknowledge that there may be some difference in sound, given the structure and contents of the mark, and the fact that flowers are often associated with love, pronouncing the mark as “I LOVE NEW YORK” is at least as reasonable as pronouncing it as “I FLOWER NEW YORK” or “I ROSE NEW YORK.”

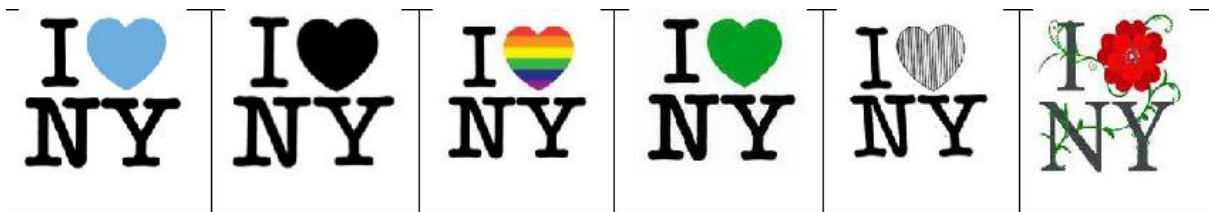
As to connotation, Applicant argues that “[t]he connotation of [Registrant’s] Marks is the idea that NY is a fun and interesting place to be. It’s meant to encourage tourism in the state.”⁴² In contrast, asserts Applicant, “[t]he connotation of [its] mark “is that flowers are wonderful, beautiful, and easy to enjoy.”⁴³ Applicant’s first observation is reasonable, but the second has no basis in fact. This is nothing more than the argument of counsel, “which is no substitute for evidence.” *In re Embiid*, 2021 USPQ2d 577, at *55 (TTAB 2021), quoting *In re OEP Enters. Inc.*, 2019 USPQ2d 309323, at *46 (2019) (quoting *Cai*, 127 USPQ2d at 1799). Indeed, Applicant’s mark uses the common formulation and structure shown in the various third-party affinity

⁴² *Id.* at 12.

⁴³ *Id.*

marks discussed above, with the flower design serving as a verb like the ♥ design in Registrant’s mark, and it is clear that the subject of one’s affinity in both marks is NY (New York), not a flower. We find the connotation and overall commercial impressions similar in that the marks are presented in the same structure and use a design element to convey a message about affinity with New York. Just as Registrant depicts the heart in different colors to add to the message, the flower could be seen as an extension of the message, or simply a variant of Registrant’s mark.

“The proper test [of similarity] 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.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quoting *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007)). Applicant, nevertheless does a side-by-side comparison in its brief as shown below:



Applicant contends that this array “feels like the Sesame Street® game “One of These Things Is Not Like the Others.”⁴⁴ We disagree, and find Applicant’s mark very similar to Registrant’s mark. That is, notwithstanding the small visual differences found in Applicant’s substitution of a flower design for a heart design, the overall appearance,

⁴⁴ *Id.* at 10.


sound, connotation and commercial impression of the marks are far more similar than dissimilar. In making this determination, we keep in mind that the more similar the marks at issue, the less similar the goods or services need to be to support a finding of likelihood of confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 1207 (Fed. Cir. 1993).

We find that the first *DuPont* factor weighs in favor of finding a likelihood of confusion.

D. Conclusion

In sum, we find that the first, second, and third *DuPont* factors weigh in favor of a finding of likelihood of confusion; the second and third, heavily so. While we have found Registrant's mark to be somewhat weak, conceptually, due to the number of registered third-party marks that utilize a similar "I ♥" affinity format with other elements, there are only a few third-party affinity marks that relate specifically to New York. Nevertheless, that conceptual weakness does not overcome the weight of the evidence and we find that confusion is likely.



Decision: The refusal to register the mark  in Serial No. 97669661 under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), is affirmed. Accordingly, the application will proceed to publication only for the Class 31 goods not subject to the refusal.