

This Opinion is Not a
Precedent of the TTAB

Mailed: September 19, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Evan James Thornton

Serial No. 98221072

Evan James Thornton, pro se.

Jacob Magit, Trademark Examining Attorney, Law Office 111,
Chris Doninger, Managing Attorney.

Before Pologeorgis, Cohen, and Bradley,
Administrative Trademark Judges.

Opinion by Bradley, Administrative Trademark Judge:

Evan James Thornton (“Applicant”) seeks registration on the Principal Register of the standard character mark M8KIT for “athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms” in International Class 25.¹

The 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 is likely to cause

¹ Application Serial No. 98221072 was filed on October 12, 2023, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming first use anywhere on August 31, 2020 and first use in commerce on January 10, 2023.

confusion with the standard character mark M8 registered on the Principal Register in International Class 25 for:

Bottoms as clothing for men and women, namely pants, shorts, skirts, jeans, dresses, sweatpants, suits, swimwear, lingerie, sleep wear, hosiery, socks, and athletic wear, namely, shorts, jogging pants, skirts, skorts, tights, and leggings; Tops as clothing for men and women, namely, shirts, sweaters, scarves, gloves, T-shirts, woven tops, shirts, blouses, sweaters, jackets, coats, dresses, hats, sweatshirts, suits, swimwear, sleep wear, lingerie, knits, namely, shirts, dresses, sweaters, cardigans, coats, and jackets, and athletic wear, namely, T-shirts, shirts, tank tops, sports bras, and pullovers.²

After the Examining Attorney issued the final refusal, Applicant appealed and filed a request for reconsideration.³ When the request for reconsideration was denied, the appeal resumed. The appeal is fully briefed.⁴ We affirm the refusal to register.

I. Likelihood of Confusion

Our determination under Section 2(d) of the Trademark Act involves an analysis of all of the probative evidence of record that is relevant to the factors bearing on a likelihood of confusion. *See In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361

² Registration No. 6662152, registered on March 8, 2022.

³ 1 TTABVUE.

Citations in this opinion to the briefs and other materials in the appeal docket refer to TTABVUE, the Board's online docketing system. Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any number(s) following TTABVUE refer to the page number(s) of the docket entry where the cited materials appear. Page references to the application file 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.

⁴ 8 TTABVUE (Applicant's brief); 10 TTABVUE (Examining Attorney's brief); 11 TTABVUE (Applicant's reply brief). Applicant's originally filed appeal brief exceeded the 25-page limit (6 TTABVUE), but the Board allowed Applicant to file a substitute brief complying with the page limitation. 7 TTABVUE. We consider only Applicant's substitute brief at 8 TTABVUE.

(CCPA 1973) (“*DuPont*”); *see also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371 (Fed. Cir. 2005).

We must consider “each *DuPont* factor for which there is evidence and argument.” *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1362 (Fed. Cir. 2023) (citing *In re Guild Mortg. Co.*, 912 F.3d 1376, 1380 (Fed. Cir. 2019)). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See 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.’”) (alteration in the original) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65 (Fed. Cir. 2002)). These and other factors are discussed below.

A. Similarity of the Goods, Trade Channels and Classes of Purchasers

We begin by analyzing the second and third *DuPont* factors, the similarity or dissimilarity of nature of the goods, and the similarity or dissimilarity of the channels of trade and classes of purchasers. We “consider the applicant’s goods as set forth in its application, and the [registrant’s] goods as set forth in its registration.” *M2 Software, Inc. v. M2 Communs., Inc.*, 450 F.3d 1378, 1382 (Fed. Cir. 2006).

Here, Applicant’s “athletic apparel, namely, shirts” is identical to “athletic wear, namely, . . . shirts” in the cited registration. Additionally, the “bottoms as clothing for men and women, namely pants” and “tops as clothing for men and women, namely, . . . jackets . . . [and] hats” in the cited registration are broad enough to encompass

Applicant's more specific goods "athletic apparel, namely, . . . pants, jackets, . . . hats and caps" and as such these respective goods are legally identical. *See In re Solid State Design Inc.*, Ser. No. 87269041, 2018 TTAB LEXIS 1, at *16, 20 (TTAB 2018) (finding goods legally identical because "where the goods in an application or registration are broadly described, they are deemed to encompass all the goods of the nature and type described therein") (citation and quotation omitted).

Applicant argues that the mere fact that both marks are classified in International Class 25 is insufficient to establish relatedness.⁵ However, the refusal is not based on classification in International Class 25, but rather the fact that Applicant's goods include goods that are identical and legally identical to those in the cited registration. Applicant also argues that the goods are different because "[t]he cited registration covers broad categories such as lingerie, hosiery, and swimwear" and Applicant's mark "targets youth athletic apparel" and "is used for youth athletic uniforms."⁶ But "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." *In re Aquamar, Inc.*, Ser. No. 85861533, 2015 TTAB LEXIS 178, at *9 n.5 (TTAB 2015) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1336 (CCPA 1981)). And Applicant's goods clearly include items that are identical and legally identical to Registrant's goods. Finally, Applicant contends that "[a]s *Detroit Athletic*, 903 F.3d at 1303, explains, the real-world marketplace . . . controls

⁵ 8 TTABVUE 8-9, 21

⁶ 8 TTABVUE 8, 21.

relatedness.”⁷ Yet, the Federal Circuit in *Detroit Athletic* actually stated the contrary, explaining that “[t]he relevant inquiry in an ex parte proceeding focuses on the goods and services **described in the application and registration**, and **not** on real-world conditions.” *In re Detroit Ath. Co.*, 903 F.3d 1297, 1307 (Fed. Cir. 2018) (italics in original, bold here).

Turning to the third *DuPont* factor regarding trade channels and consumers, neither Applicant nor Registrant limit their trade channels or classes of purchasers in their respective identifications of goods. As such, because the goods described in the application and the cited registration are in part identical and legally identical, we must presume that these identical in part and legally identical goods “travel in the same channels of trade to the same class of purchasers.” *In re Viterro Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (citation omitted); *Genesco Inc. v. Martz*, Opp. No. 91121296, 2003 TTAB LEXIS 123, at *28 (TTAB 2003) (“Given the in-part identical . . . nature of the parties’ goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade.”).

Applicant argues that the “goods travel in distinctly separate trade channels” with its goods being offered at youth athletic programs, sports tournaments, and on its website at m8kit.com, while “[t]he cited registration contains no documentation of active commerce.”⁸ However, Applicant misses that “the question of registrability of

⁷ 8 TTABVUE 21.

⁸ 8 TTABVUE 20-21, 9. We address Applicant’s arguments regarding the alleged lack of use of the cited registration in Section I.G.

[its] mark must be decided on the basis of the identification of goods set forth in the application” which does not contain any restriction to certain trade channels, or to any particular consumers. *Octocom Sys. v. Hous. Comput. Servs.*, 918 F.2d 937, 942 (Fed. Cir. 1990). *See also 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.”). Applicant’s argument also overlooks that “the owner of an unrestricted registration is entitled to change its current trade channels at any time.” *Detroit Ath.*, 903 F.3d at 1308. Accordingly, Registrant may change its trade channels to also include youth athletic programs and sports tournaments, and use in such trade channels is encompassed by its unrestricted federal registration. *See B&B Hardware, Inc. v. Hargis Indus.*, 575 U.S. 138, 143 (2015) (“if an application does not delimit any specific trade channels of distribution, no limitation will be applied”) (citation omitted); *Detroit Ath.*, 903 F.3d at 1308 (given the unrestricted registration “we may not assume that the club will never sell clothing online or through third-party distributors”).

In view of the foregoing, the second and third *DuPont* factor weigh heavily in favor of a finding of likelihood of confusion. *See, e.g., In re Bay State Brewing Co.*, Ser. No. 85826258, 2016 TTAB LEXIS 46, at *4-5 (TTAB 2016) (“identity in the goods and trade channels therefor, and the overlap in purchasers, are factors that weigh heavily in favor of a finding of likelihood of confusion”).

B. Consumers’ Sophistication and Purchasing Conditions

Under this *DuPont* factor we consider the “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ v. careful, sophisticated purchasing.” *DuPont*, 476

F.2d at 1361. Because there are no limitations on price point or consumer type in either the application or the cited registration, we must presume that the athletic apparel and other clothing in the application and cited registration are sold at all price points and to all types of consumers. We must also base our decision on “the least sophisticated potential purchasers.” *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1325 (Fed. Cir. 2014).

“When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.” *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000); *see also Major League Baseball Players Ass’n v. Chisena*, Opp. No. 91240180, 2023 TTAB LEXIS 117, at *65 (TTAB 2023) (“t-shirts and many of the other casual, everyday items of wearing apparel identified in applicant’s application are relatively inexpensive and are therefore likely to be purchased by consumers on impulse, and without a great deal of care”). We agree with the Examining Attorney that “applicant’s specimen indicates its goods are relatively low-priced.”⁹ Specifically, Applicant’s specimen shows hats offered for sale at \$22 and shirts offered for sale at \$20 and \$28.¹⁰ As discussed above, Registrant’s identification of goods also includes hats and shirts. Accordingly, given the evidence demonstrating that goods of the type identified in Applicant’s and Registrant’s identifications are inexpensive, consumers

⁹ 10 TTABVUE 9.

¹⁰ August 28, 2024 Substitute Specimen at 2-4. Applicant argues that “[t]he Examiner’s generalized claims about consumer sophistication and impulse purchasing lack any evidentiary support relevant to Applicant’s actual goods.” 11 TTABVUE 11. Yet it is clear that Applicant’s own specimen provides evidentiary support for the Examining Attorney’s position.

are likely to use a lesser standard of care in making purchasing decisions regarding these ordinary consumer items, thereby increasing the likelihood of confusion. *See Sock It to Me v. Aiping Fan*, Opp. No. 91230554, 2020 TTAB LEXIS 201, at *25 (TTAB 2020) (“Because the buyers to whom sales are made are all general consumers, and the goods at issue [i.e., socks] are relatively low-priced and subject to impulse buying, we find that, the fourth *DuPont* factor weighs in favor of finding a likelihood of confusion.”); *Brown Shoe Co. v. Robbins*, Opp. No. 91176273, 2009 TTAB LEXIS 364, at *6 (TTAB 2009) (“goods include general clothing items that would not be purchased with a great deal of care or require purchaser sophistication, which increases the likelihood of confusion”).

Applicant argues that its consumers are “discerning purchasers,” specifically, “coaches, parents, and team officials [who] purchase custom athletic apparel with intention and care—not on impulse.”¹¹ However, Applicant’s identification of goods does not cover “custom athletic apparel,” or contain any limitation to particular purchasers. Moreover, Applicant provides no evidence in support of his assertions that the purchasers are discerning or do not otherwise purchase the low-cost goods - including shirts, hats and caps -- on impulse, and “[a]ttorney argument is no substitute for evidence.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1371 (Fed. Cir. 2018) (citation omitted) (“assertions of fact” in a brief are “not evidence under any of the relevant rules”); *H.D. Lee Co. v. Maidenform, Inc.*, Opp. No. 91168309, 2008 TTAB LEXIS 21, at *33 (TTAB 2008) (“problem with ‘degree of consumer care’ argument . . .

¹¹ 8 TTABVUE 9, 20-21.

is that there is no corroborating evidence and it is inconsistent with the description of goods in the application and registration (i.e., not all of the potential consumers for outerwear and under garments are sophisticated consumers”).

We thus find that this *DuPont* factor weighs in favor of likelihood of confusion.

C. Strength or Weakness of the Registrant’s M8 Mark

Applicant contends that widespread third-party uses of “M8” “dilute [the cited mark’s] distinctiveness and demonstrate that it does not function as a strong, source-identifying mark for apparel.”¹² There are “two prongs of analysis for a mark’s strength under the sixth [*DuPont*] factor: conceptual strength and commercial strength.” *See, e.g., Spireon*, 71 F.4th at 1362. However, because Applicant has not provided any evidence of third-party marketplace use of identical or similar marks to the cited mark for identical or similar goods, we only analyze the conceptual strength or weakness of the cited mark.¹³ *See New Era Cap Co. v. Pro Era, LLC*, Opp. No. 91216455, 2020 TTAB LEXIS 199, at *36 (TTAB 2020) (“Applicant did not provide

¹² 8 TTABVUE 17, 22; 11 TTABVUE 9.

¹³ Applicant faults the Examining Attorney for not providing evidence of commercial strength, fame, consumer recognition, or exclusive use of the cited mark M8. 8 TTABVUE 15-16, 22-23; 11 TTABVUE 9. However, the cited mark is registered on the Principal Register and as such the registration itself is “prima facie evidence of the validity of the registered mark . . . and of the owner’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate.” 15 U.S.C. § 1057(b). With regard to fame, “[b]ecause of the nature of the evidence required to establish the fame of a registered mark, the Board does not expect Trademark Examining Attorneys to submit evidence as to the fame of the cited mark in an ex parte proceeding, and they do not usually do so.” *In re Mr. Recipe, LLC*, Ser. No. 86040643, 2016 TTAB LEXIS 80, at *4 (TTAB 2016). Accordingly, “the absence of such evidence is not particularly significant in the context of an ex parte proceeding.” *In re Davey Prods. Pty*, Ser. No. 77029776, 2009 TTAB LEXIS 524, at *21 (TTAB 2009).

evidence of any third-party use of marks consisting of or comprised of the term ERA for these goods, and thus no evidence of commercial weakness.”).

Conceptual or inherent strength is a measure of a mark’s distinctiveness. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353-54 (Fed Cir. 2010). A mark’s distinctiveness is “often classified in categories of generally increasing distinctiveness[:] . . . (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992). Because the cited registration is “prima facie evidence of the validity of the registered mark[s],” see Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), we must assume that Registrant’s mark M8 is inherently distinctive (i.e., at least suggestive), since it is registered on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act. See *In re Davia*, Ser. No. 85497617, 2014 TTAB LEXIS 214, at *11-12 (TTAB 2014). The record does not indicate that M8 has any identified meaning in connection to clothing, and as such we find that Registrant’s mark is arbitrary. See *KME Ger. GmbH v. Zhejiang Hailiang Co.*, Opp. No. 91267675, 2023 TTAB LEXIS 379, at *34 (TTAB 2023) (mark consisting of “a three-letter combination with no recognized meaning or significance in connection with the goods and services . . . is arbitrary, and therefore conceptually strong”) *rev’d on other grounds*, No. 1:23-cv-01606-LMB-LRV, ECF No. 363 (E.D. Va. Jan. 10, 2025), *appeal docketed*, No. 25-1129 (4th Cir. Feb. 10, 2025).

“The existence of third-party registrations on similar goods can bear on a mark’s conceptual strength. Specifically, third-party registrations containing an element

that is common to both the [Registrant's] and the [Applicant's] marks can show that that element has a normally understood and well-recognized descriptive or suggestive meaning.” *Spireon*, 71 F.4th at 1363 (citations omitted). However, to do so, such third-party registrations must be “similar marks in use on **similar goods**.” *Omaha Steaks Int’l v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1324 (Fed. Cir. 2018) (citations omitted) (italics in original, bold here).

Applicant submitted evidence of two third-party applications and two third-party registrations for M8 marks.¹⁴ The applications lack probative value in the analysis of conceptual strength because they “are not proof of anything except that they were filed on a particular date.” *Std. Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, Opp. No. 91116242, 2006 TTAB LEXIS 9, at *49 (TTAB 2006). We also do not consider Registration No. 6405842 because it only recently issued under § 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), and the record contains no § 71 affidavits or declarations of continuing use. *Made in Nature, LLC v. Pharmavite LLC*, Opp. No. 91223352, 2022 TTAB LEXIS 228, at *30 (TTAB 2022) (“third-party registrations that are not based on use in commerce; but rather issued under Trademark Act Sections 44(e) or 66(a), . . . and have been registered for less than five years . . . lack probative value, and we have not considered them”). The one remaining registration lacks probative value because it covers automobiles and structural parts thereof

¹⁴ November 27, 2024 Request for Reconsideration at 15-17, 26-34, 38-39. In its Request for Reconsideration Applicant also lists Reg. No. 77850181 owned by Brunswick Corporation (and Applicant also references this mark in its appeal brief), but Applicant did not submit a TSDR print-out or other evidence regarding this registration so we do not consider it. *See id.* at 9; *see also* 8 TTABVUE 17.

which Applicant has not shown are similar to the clothing items covered by the cited registration.¹⁵ See *Tao Licensing, LLC v. Bender Consulting Ltd.*, Can. No. 92057132, 2017 TTAB LEXIS 437, at *51 (TTAB 2017) (third-party registrations in unrelated fields “have no bearing on the strength of the term in the context relevant to this case”).

Applicant has not submitted evidence that would demonstrate any conceptual weakness of Registrant’s arbitrary mark M8. Accordingly, we find that Registrant’s mark is conceptually strong. See *Palm Bay Imps.*, 396 F.3d at 1372 (“an arbitrary term . . . [is] conceptually strong as a trademark”). We thus find that the sixth *DuPont* factor is neutral.

D. Similarity or Dissimilarity of the Marks

We evaluate “[t]he similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *Detroit Ath.*, 903 F.3d at 1303 (citing *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*, Ser. No. 87075988, 2018 TTAB LEXIS 170, at *13 (TTAB 2018) (citation omitted). Where, as here, the goods at issue are in part identical and legally identical, “the degree of similarity necessary to support a conclusion of likely confusion declines.” See *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir. 1992). “The proper test is not a side-by-side comparison of the marks, but instead

¹⁵ November 27, 2024 Request for Reconsideration at 26. Applicant confirms that its proffered third-party marks lack probative value when it argues “[n]umerous **unrelated commercial uses** of the designation “M8” . . . dilute its distinctiveness . . .” 8 TTABVUE 17 (emphasis added).

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.” *i.am.symbolic*, 866 F.3d at 1323 (*quoting Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012)).

Additionally, “[i]t is well-established that it is improper to dissect a mark, and that marks must be viewed in their entirety.” *Coach Servs.*, 668 F.3d at 1368; *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGaA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1371 (Fed. Cir. 2015) (“the touchstone of this factor is consideration of the marks in total”). Nonetheless, “it is settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark.” *Bay State Brewing*, 2016 TTAB LEXIS 46, at *7 (*citing In re Nat’l Data*, 753 F.2d 1056, 1059 (Fed. Cir. 1985) (“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.”)).

Considering the appearance of the parties’ marks, Applicant’s applied to register the mark M8KIT, which contains the entirety of the cited mark M8. Where, as here, “one mark incorporates the entirety of another mark, it has been found to be similar.” *Bureau Nat’l Interprofessionnel DU Cognac v. Cologne*, 110 F.4th 1356, 1370 (Fed. Cir. 2024) (citation omitted). *See also TiVo Brands LLC v. Tivoli, LLC*, Opp. No. 91221632, 2018 TTAB LEXIS 439, at *51-52 (TTAB 2018) (Applicant’s marks

TIVOTAPE and TIVOBAR “are similar to [o]pposer’s TIVO mark in appearance and pronunciation due to the shared term ‘TIVO’ in each mark.”). The fact that the first part of Applicant’s mark is the entire cited mark M8 increases the similarity between the two marks. *See Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, Opp. No. 91074797, 1988 TTAB LEXIS 60, at *8 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”); *In re Hitachi High-Technologies Corp.*, Ser. No. 79110412, 2014 TTAB LEXIS 32, at *12-13 (TTAB 2014) (marks similar where “[a]pplicant’s mark incorporates in full [the cited mark OPTI] as the first part of its mark OPTICROSS”).

We agree with the Examining Attorney that “M8” is the dominant part of Applicant’s mark M8KIT and as such is entitled to greater weight in our comparison of the marks.¹⁶ As noted above, M8 is arbitrary in relation to the apparel and athletic apparel of Applicant and Registrant, and is also the first part of Applicant’s mark. “[P]urchasers in general are inclined to focus on the first word or portion in a trademark.” *L’Oreal S.A. v. Marcon*, Opp. No. 91184456, 2012 TTAB LEXIS 77, at *17 (TTAB 2012). *See also Palm Bay Imps.*, 396 F.3d at 1372 (“VEUVE” a “‘prominent feature’ as the first word in the mark and the first word to appear on the label”). Additionally, “[t]hat a particular feature is descriptive . . . with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a

¹⁶ 10 TTABVUE 4-6.

portion of a mark.” *Nat’l Data*, 753 F.2d at 1058.¹⁷ The Examining Attorney provided evidence showing that the word “kit” is descriptive in relation to at least the “athletic uniforms,” and “athletic apparel, namely, shirts” covered by Applicant’s identification of goods. Specifically, the Examining Attorney produced the following evidence that “kit” is used to refer to a soccer jersey, uniform, and/or the overall attire and equipment worn by a soccer player:

Articles:

- Sportuniform.com:¹⁸

“What is a Soccer Kit in USA?”

A kit contains essential soccer equipment such as shirts, shorts, socks, and shin protection. It is critical to the team’s identity and on-field performance since it makes players easily identified and well-equipped. . . .

¹⁷ Applicant contends that “the Examiner failed to properly raise or support the descriptiveness claim with a formal § 2(e)(1) refusal, rendering the refusal legally defective” and that the Examining Attorney has not proven that ‘kit’ is descriptive or generic under the § 2(e)(1) evidentiary standard. 11 TTABVUE 10; 8 TTABVUE 10-13; *see also* 11 TTABVUE 3-5. However, the Examining Attorney is not refusing registration of Applicant’s mark based on descriptiveness under Section 2(e)(1), but appropriately analyzing the features of Applicant’s mark and determining the weight accorded thereto in determining the issue of likelihood of confusion. *See Nat’l Data*, 753 F.2d at 1058 (“Without question, the descriptive or generic character of an expression . . . is pertinent to the issue of likelihood of confusion.”). Applicant itself, recognizes as such in noting that “the descriptiveness or genericness of a component may, in limited circumstances, inform a § 2(d) analysis.” 11 TTABVUE 3. And Applicant’s claim that it was deprived of the opportunity to develop its evidence and arguments on this issue is without merit. *See* 11 TTABVUE 3-4. The Examining Attorney raised the issue of the descriptiveness of “kit” within Applicant’s mark in the August 31, 2024 Final Office Action (at 4). As such, Applicant had an opportunity to respond and provide evidence on this issue in its November 27, 2024 Request for Reconsideration, but failed to do so.

¹⁸ March 27, 2025 Denial of Request for Reconsideration, 4 TTABVUE 11.

Why Do Teams Have Multiple Kits?

A team's primary outfit worn at home stadium matches is called the home kit. Usually, it has the team's customary colors and patterns, which stand for their history and identity. Wearing this uniform allows the team to show off their pride and heritage."

- Soccerpro.com:¹⁹

WHAT ARE JERSEYS IN SOCCER CALLED?

"In professional soccer, a player's jersey and the rest of the equipment they wear out on the pitch is referred to as a 'kit' or 'uniform.' . . .

Why Is It Called A Kit?

The term 'kit' in soccer refers to a player's complete outfit. This means not just their jersey, but all their gear, including shorts, cleats, shin pads, strappings, socks, and headbands, with every piece meant to match in terms of color and design. A kit is therefore everything you need to play the game - like a shaving kit holds all the tools you need to shave. . . .

Why Do Teams Have Multiple Kits?

Professional soccer teams typically have three separate kits: a home kit, an away kit, and a third alternative kit used on some game days. . . ."

- Charlottefootballclub.com:²⁰

"Soccer kit culture has taken the world by storm even within circles of people who aren't fans of the sport. . . .

The kit is the whole uniform a soccer team wears from the jersey to the shorts down to the socks.

But, ironically, the term 'kit' is technically misused in most soccer circles. Really, the common usage of the word is the equivalent of the word 'jersey' in American sports."

¹⁹ March 27, 2025 Denial of Request for Reconsideration, 4 TTABVUE 13.

²⁰ March 27, 2025 Denial of Request for Reconsideration, 4 TTABVUE 12.

- Wikipedia.org:²¹
“In association football [i.e., soccer], kit (also referred to as a strip or uniform) is the standard equipment and attire worn by players.”



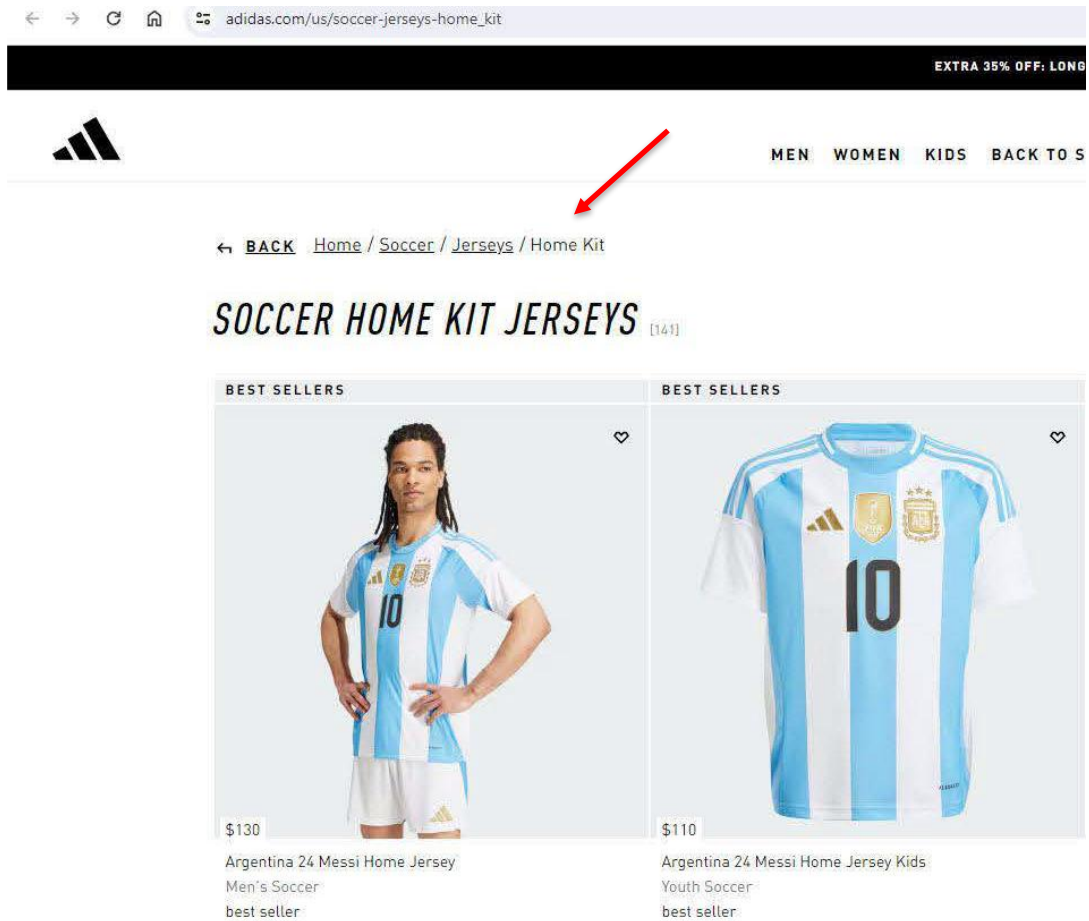
Pavel Nedvěd pictured in 2006 wearing a typical modern football kit

[photograph accompanying the article]

²¹ August 31, 2024 Final Office Action at 8.

Online Stores

- Adidas (adidas.com)²²



²² August 31, 2024 Final Office Action at 9 (excerpt with red arrow added).

- Orange County SC (ocscshop.com)²³

← → ↺ ↻ 🏠 📄 ocscshop.com/collections/jerseys/products/orange-kit-adult



THE CLASSIC KIT - ADULT

Size: ~~Small~~ **Medium** ~~Large~~ ~~X-Large~~
~~XX-Large~~ ~~XXX-Large~~ ~~4X-Large~~ ~~5X-Large~~

\$100.00
pricing calculated at checkout

Personalized Jersey
☐ \$30
Player

Last Name (+ \$30.00 USD)

Number

ADD TO CART

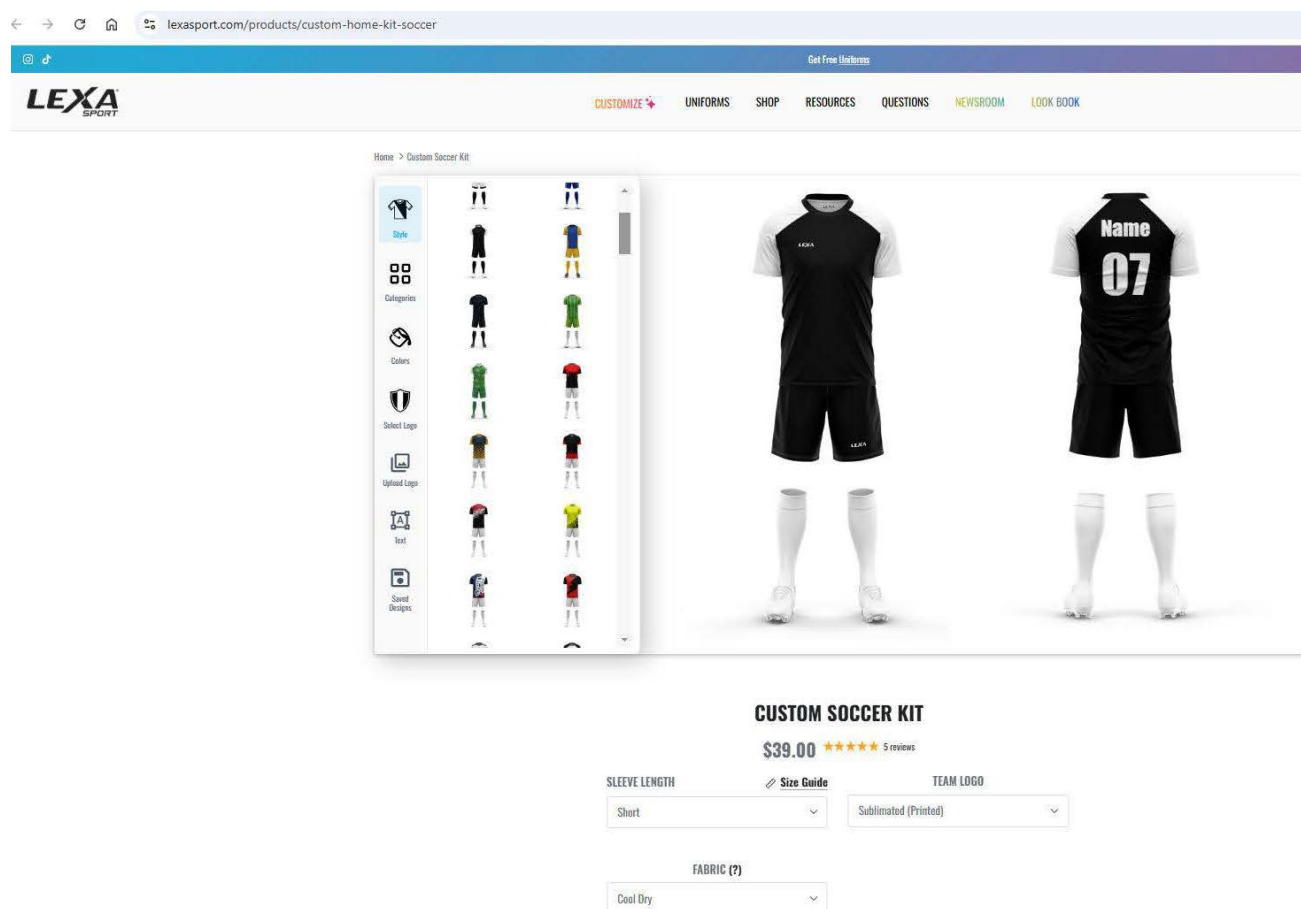
Buy with: **shop** Pay

More payment options

²³ August 31, 2024 Final Office Action at 11.

Serial No. 98221072

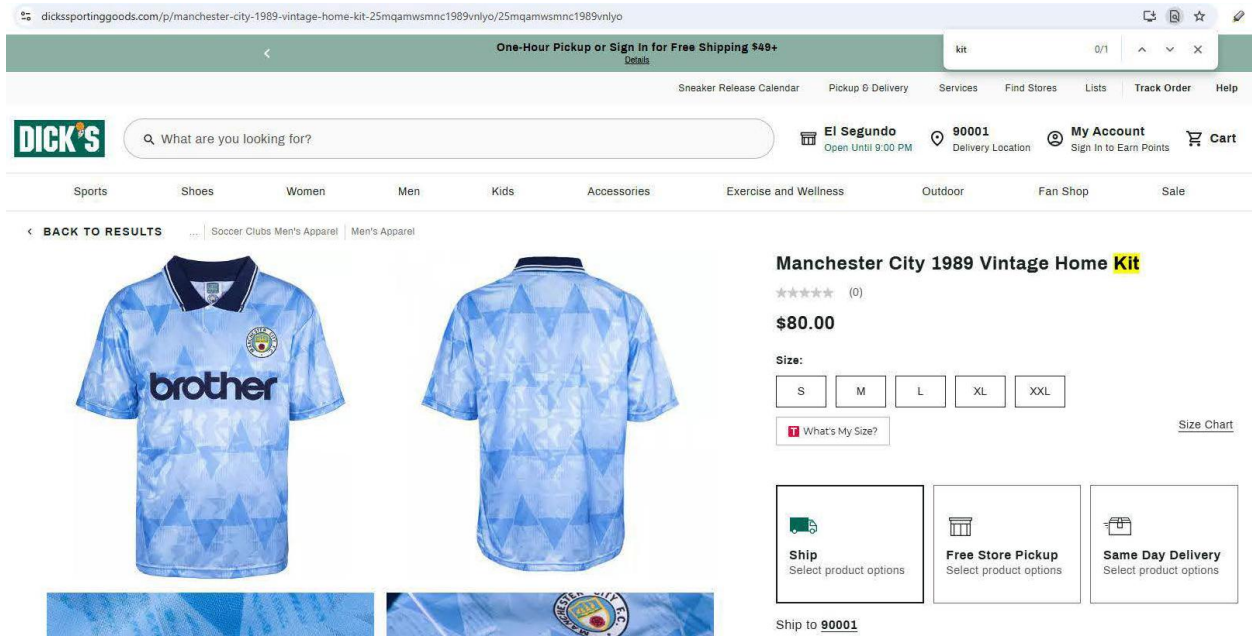
- Lexa Sport (lexasport.com)²⁴



²⁴ March 27, 2025 Denial of Request for Reconsideration, 4 TTABVUE 10.

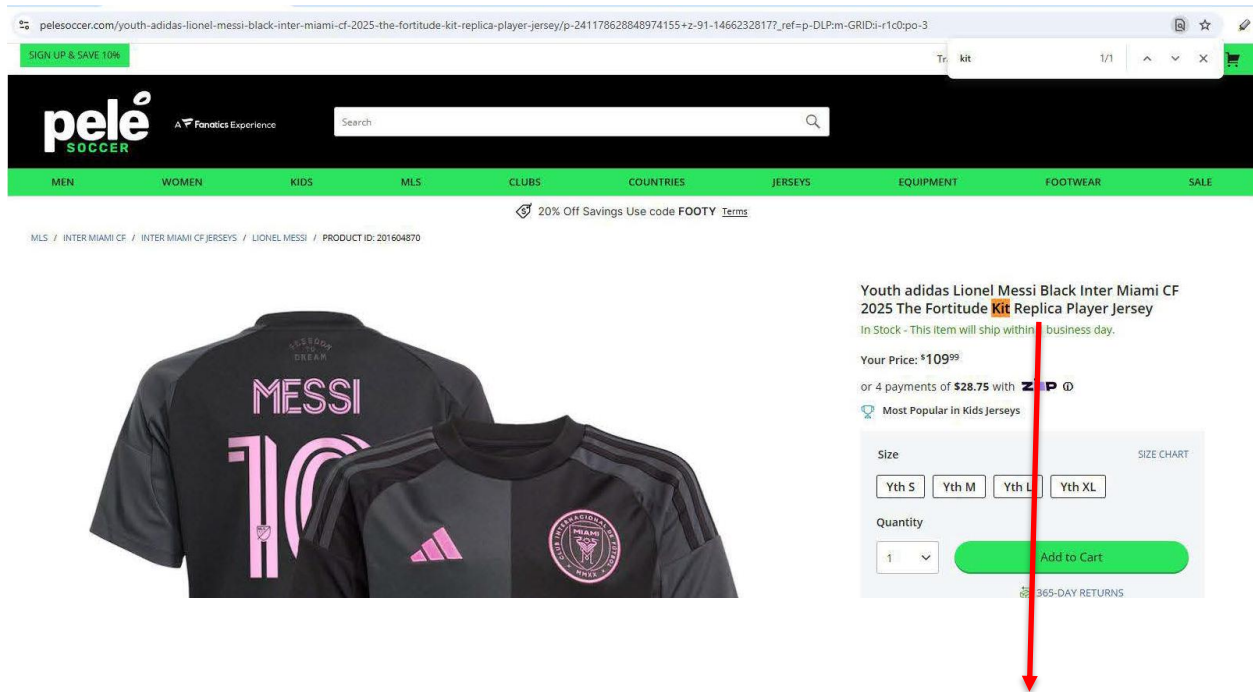
Serial No. 98221072

- Dick's Sporting Goods (dickssportinggoods.com)²⁵



²⁵ March 27, 2025 Denial of Request for Reconsideration, 4 TTABVUE 9.

- Pelé Soccer (pelesoccer.com)²⁶



Youth adidas Lionel Messi Black Inter Miami CF 2025 The Fortitude **Kit** Replica Player Jersey

In Stock - This item will ship within 1 business day.

Your Price: \$109⁹⁹

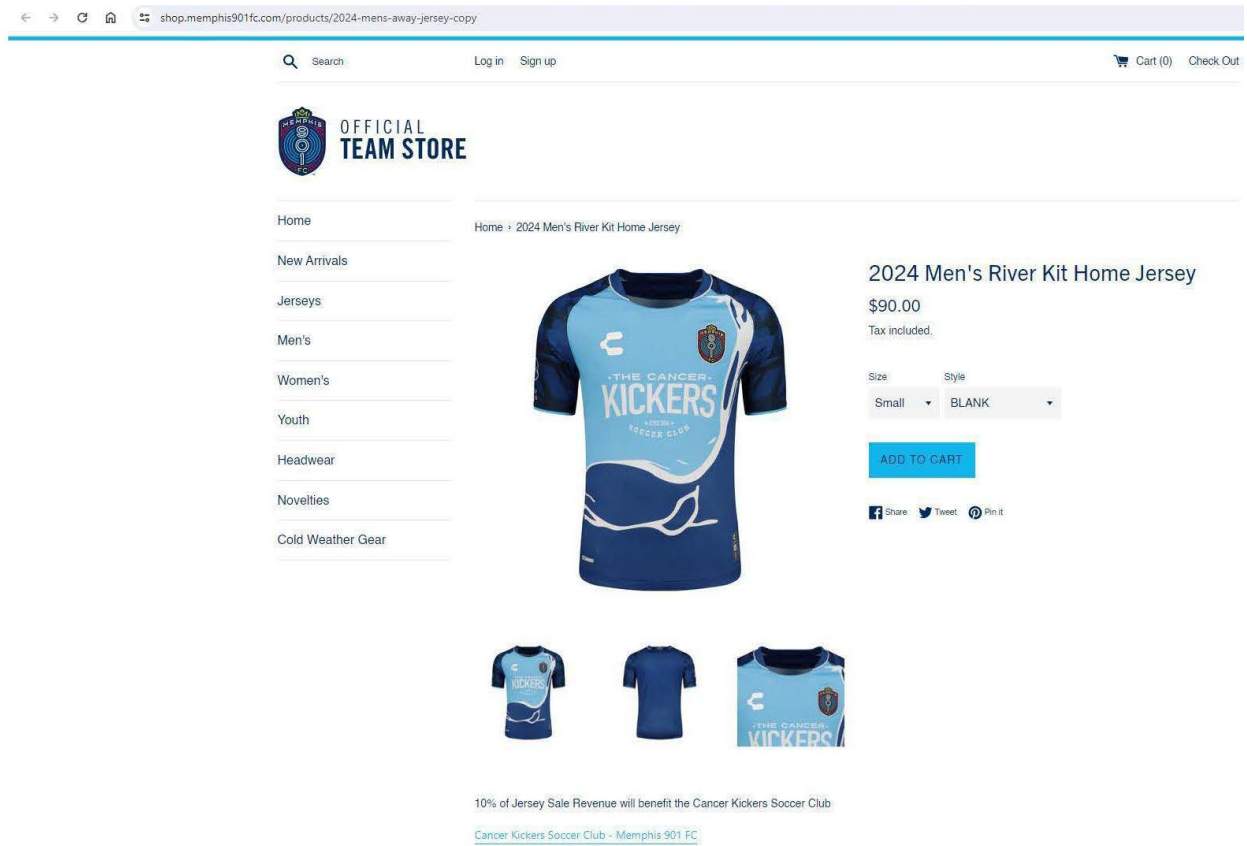
or 4 payments of \$28.75 with **ZIP** ⓘ

🏆 Most Popular in Kids Jerseys

²⁶ March 27, 2025 Denial of Request for Reconsideration, 4 TTABVue 8 (red arrow and excerpt containing enlargement of item description added).

Serial No. 98221072

- Memphis SC (shop.memphis901fc.com)²⁷



²⁷ August 31, 2024 Final Office Action at 13.

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- MLS Store (mlsstore.com)²⁸

tion football) - Wiki: X | Soccer Home Kit Jerseys | adid: X | Men's LA Galaxy adidas White: X | The Classic Kit - Adult: X | New Real Madrid Jersey 24/25: X | 2024 Men's River Kit Home Jer: X | +

mlsstore.com/en/la-galaxy/mens-la-galaxy-adidas-white-2024-angeleno-kit-authentic-custom-jersey/t-14347993+p-357756123466981+z-9-37685765397_ref=p-DLPm-GRIDi-r6c0:po-18

MLSSTORE SHOP BY TEAM Shipping to 20146 Sbadge Gift Cards Track Order Help My Account Language FanCash Learn More

LA GALAXY STORE What can we help you find? SIGN UP & SAVE 10%

JERSEYS MEN WOMEN KIDS SCARVES ACCESSORIES HOME & OFFICE COLLECTIBLES CLEARANCE

HURRY! THIS OFFER ENDS IN: 09 HRS 08 MIN 23 SEC **FREE SHIPPING** ON ORDERS OVER \$29 USE CODE: **MLS29** *Excludes App

LA GALAXY / LA GALAXY JERSEYS / PRODUCT ID: 201110354

Officially Licensed Gear

Men's LA Galaxy adidas White 2024 Angeleno Kit Authentic Custom Jersey
Customized Item

Your Price: *\$194⁹⁹

☐ Coupon ☐ Apply Code Here!

Ships Free with code: MLS29 Offer ends in 9hrs 8min 23sec!

Most Popular in Men Jerseys

Select Player

- OR -

Number* Name*

Size SIZE CHART

S M L XL 2XL 3XL

Quantity

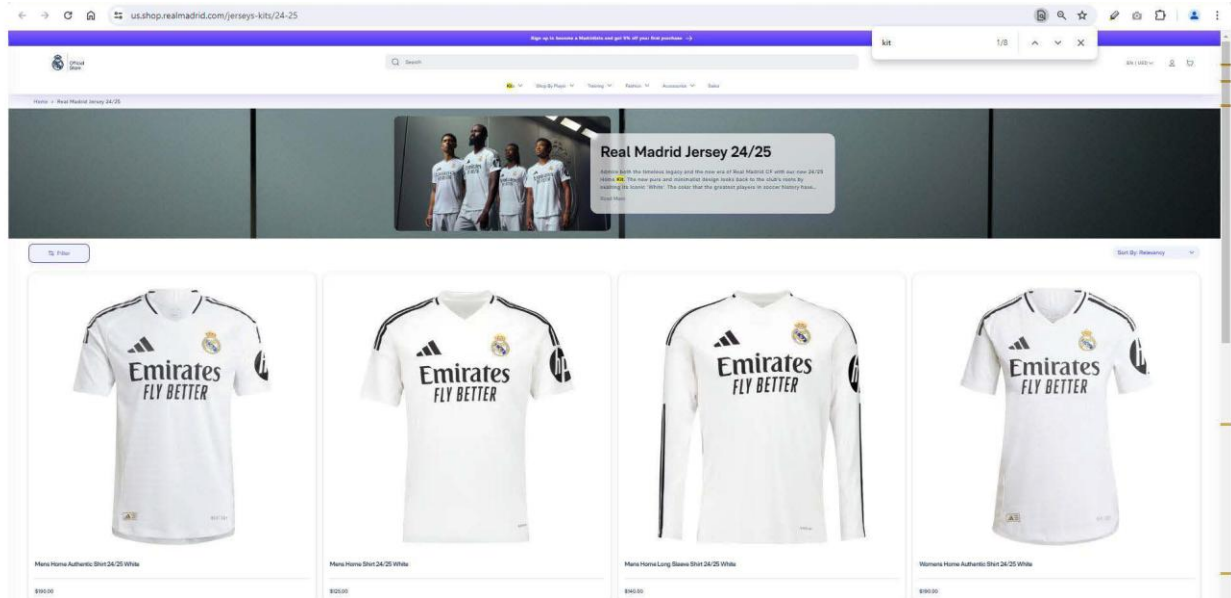
1 Add to Cart

²⁸ August 31, 2024 Final Office Action at 10 (red arrow added).

- Real Madrid (us.shop.realmadrid.com) with accompanying text stating:

“Real Madrid Jersey 24/25

Admire both the timeless legacy and the new era of Real Madrid CF with our new 24/25 Home Kit. . . .”²⁹



Accordingly, in view of the foregoing evidence, we find that Applicant’s addition of the descriptive term “kit” to Registrant’s arbitrary mark M8 “do[es] little to alleviate confusion.” *In re Charger Ventures LLC*, 64 F.4th 1375, 1382 (Fed. Cir. 2023) (no error in focusing on dominant portions of SPARK LIVING and SPARK and affirming the marks were confusingly similar); *In re Corning Glass Works*, Ser. No. 73361576, 1985 TTAB LEXIS 12, at *5 (TTAB 1985) (CONFIRM and CONFIRMCELLS likely to cause confusion “in view of the descriptive significance of ‘cell’”). Our analysis does not improperly dissect the mark as Applicant contends,³⁰ but analyzes the mark in its entirety while appropriately giving more weight to the dominant M8 portion and

²⁹ August 31, 2024 Final Office Action at 12.

³⁰ 8 TTABVUE 7, 10.

less weight to the descriptive “KIT” portion. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 1343 (Fed. Cir. 2004) (“Viewed in their entirety with non-dominant features [ALE, JOSE and GOLD] appropriately discounted, the marks [GASPAR’S ALE for beer and ale and JOSE GASPAR GOLD for tequila] become nearly identical.”).

Applicant’s criticisms of the Examining Attorney’s evidence are not persuasive and fail to detract from our finding that the addition of “kit” does not sufficiently distinguish the marks. First, Applicant contends that the refusal “relies primarily on usage drawn from international soccer contexts” and such foreign usage does not establish descriptiveness among U.S. consumers.³¹ Yet, nothing on the face of the websites indicates that they are directed to a foreign audience. Rather, all of the websites are in English, the prices are in U.S. dollars, there are no country codes used in the top-level domains, and the retail websites include recognizable stores in the U.S. such as Adidas and Dick’s Sporting Goods, as well as websites from soccer teams and clubs located in the United States (i.e., Orange County, Memphis, Los Angeles). And even the articles that mention that “kit” is less familiar among the U.S. generally, show that the meaning is recognized broadly in the context of soccer apparel which falls within “athletic uniforms” in Applicant’s identification of goods. Second, Applicant asserts that the refusal “leans heavily” on “unreliable Wikipedia evidence.”³² The Board will consider evidence taken from Wikipedia “so long as the non-offering party has an opportunity to rebut that evidence by submitting other

³¹ 8 TTABVUE 11; 11 TTABVUE 4.

³² 8 TTABVUE 13-14; *see also* 11 TTABVUE 4 (noting Examining Attorney’s reliance on “open-source materials”).

evidence that may call its accuracy into question.” *Bay State Brewing*, 2016 TTAB LEXIS 46, at *3 n.3. Applicant had ample opportunity to rebut the Wikipedia evidence in its request for reconsideration, and did not do so. In any event, the Wikipedia article is only one of 12 sources the Examining Attorney relies on, and the other sources corroborate the descriptive meaning evident in the Wikipedia article. Third, Applicant argues that “[b]eyond soccer, ‘kit’ is effectively nonexistent in the lexicon of American sports such as football, baseball, basketball, wrestling, track, or volleyball” and that “kit” does not describe its actual goods which Applicant states are “youth baseball uniforms and accessories.”³³ However, it is enough that “kit” is descriptive of soccer uniforms, a type of “athletic uniform” included in Applicant’s application; it does not need to be descriptive of all sports.³⁴ *See Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1565 n.2, 1565-66 (Fed. Cir. 1987) (sufficient that the term “sweats” was descriptive of “sweatpants” and “sweatshirts” in finding term less distinctive; “[t]hat ‘sweats’ is not generic or descriptive of [opposer’s other] goods [i.e., shoes, swimsuits, caps, visors, bags], however, is irrelevant to the [likelihood of confusion] issue here”). Finally, Applicant asserts that on retail websites “kit” “is consistently subordinate to ‘jersey’ in navigation menus, category labels, URLs, and promotional copy” and that “kit” is only used “stylistically,” “informally,” or in “decorative or secondary mentions.”³⁵ Any alleged subordinate use

³³ 8 TTABVUE 12.

³⁴ While Applicant identifies its “actual goods” as youth baseball uniforms and accessories, it is Applicant’s identification of goods which is relevant, here. *See Detroit Ath.*, 903 F.3d at 1307.

³⁵ 8 TTABVUE 11-12.

confirms that “kit” is recognized as a type of jersey, and the Examining Attorney’s evidence consistently shows use of “kit” in the name of products to identify the accompanying pictured jersey or uniform being offered for sale.

With regards to sound, Applicant contends that “[t]he applied-for mark M8KIT (M8K-IT) forms a unified, phonetically suggestive phrase—‘MAKE IT’—that is aurally and conceptually distinct from the cited mark M8, typically read as ‘mate’ or ‘em-eight.’”³⁶ However, “there is no correct pronunciation of a trademark, and consumers may pronounce a mark differently than intended by the brand owner.” *Viterra*, 671 F.3d at 1367. Additionally, Applicant’s argument confirms the similarity in sound -- if M8 is “typically read as ‘em-eight’” in the cited mark then the same would hold true for M8 in Applicant’s mark M8KIT. Further, we agree with the Examining Attorney that Applicant has not provided any “evidence that consumers would view ‘M8KIT’ as being pronounced ‘MAKE IT’.”³⁷ None of the specimens Applicant submitted make any reference to the phrase. Even in its argument Applicant had to insert a hyphen, not present in its mark, to convey the alleged sound of its mark.

Similarly, on commercial impression Applicant asserts that its mark “M8KIT forms a motivational phrase—‘MAKE IT’” and that the refusal improperly dissects the mark and ignores “its fused, motivational character.”³⁸ In contrast, Applicant

³⁶ 8 TTABVUE 19, 21.

³⁷ 10 TTABVUE 7.

³⁸ 8 TTABVUE 8, 19.

contends that the cited mark M8 is “an alphanumeric abbreviation” that has “no stylization, contextual use, or phonetic significance beyond its characters.”³⁹ We are not persuaded by Applicant’s arguments. If Applicant’s mark is “fused” as it claims, then there is no support for asserting that consumers will read it as a phrase consisting of two words. Applicant also does not provide a basis for why M8 would be perceived differently in the cited mark than its own mark, especially given the identical and legally identical goods. Rather, “as used in both marks, [M8] would have the same meaning, and the marks overall have the same connotation.” *In re Max Capital Grp. Ltd.*, Ser. No. 77186166, 2010 TTAB LEXIS 1, at *14 (TTAB 2010).

Overall, considering that the first and dominant part of Applicant’s mark is identical to the cited mark M8, as well as the lesser degree of similarity required as a result of the identical and legally identical goods, we conclude that Applicant’s mark is similar to the cited registration such that this *DuPont* factor weighs in favor of a likelihood of confusion.

E. Lack of Actual Confusion

Applicant asserts that its “use of M8KIT has not resulted in any known consumer confusion” since the cited registration issued in 2022 despite its mark being “promoted openly and widely.”⁴⁰ However, Applicant’s “uncorroborated statements of no known instances of actual confusion are of little evidentiary value.” *In re Majestic Distilling Co.*, 315 F.3d 1311, 1317 (Fed. Cir. 2003) (“lack of evidence of actual

³⁹ 8 TTABVUE 8, 18.

⁴⁰ 8 TTABVUE 22; 11 TTABVUE 7.

confusion carries little weight, especially in an ex parte context”) (citation omitted). Additionally, given the ex parte context, “there has been no opportunity to hear from Registrant about whether it is aware of any reported instances of confusion.” *In re Guild Mortg. Co.*, Ser. No. 86709944, 2020 TTAB LEXIS 17, at *23 (TTAB 2020). Accordingly, we find this factor neutral.

F. Any Other Established Fact Probative of the Effect of Use

The thirteenth *DuPont* factor examines “any other established fact probative of the effect of use.” *DuPont*, 476 F.2d at 1361. This factor “accommodates the need for flexibility in assessing each unique set of facts.” *In re Embiid*, Ser. No. 88202890, 2021 TTAB LEXIS 168, at *57 (TTAB 2021) (citation omitted). We address Applicant’s argument regarding the alleged inconsistent treatment of its mark during prosecution as compared to the prosecution of the cited mark under this factor.⁴¹ Specifically, Applicant contends that for the cited registration, “the Office accepted ‘M8’ as phonetically equal to ‘MATE’ during prosecution.”⁴² However, for its mark M8KIT Applicant states, “the Examiner asserts an unsupported new pronunciation: ‘MEIGHTKIT’” which Applicant argues, “conflicts with earlier Office interpretations and lacks explanation or justification for the shift.”⁴³

As Applicant recognizes, the Federal Circuit states that “[t]he Board must decide each case on its own merits” and “the PTO’s allowance of . . . prior registrations does not bind the Board or this court.” *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342 (Fed.

⁴¹ 8 TTABVUE 8, 19; 11 TTABVUE 6-7, 9-10.

⁴² 11 TTABVUE 7, 10; 8 TTABVUE 8.

⁴³ 11 TTABVUE 7.

Cir. 2001).⁴⁴ In particular, each case must be decided on its own facts and evidentiary record. *See In re The Consumer Prot. Firm PLLC*, 2021 TTAB LEXIS 67, at *29 (TTAB 2021). Here, the evidence Applicant filed regarding the prosecution history of the cited mark and of the mark MATE clearly shows that the record before the examining attorney in those cases involved different evidence.⁴⁵ And, as such the “Board is not bound by prior decisions involving different records.” *In re Lizzo LLC*, Ser. No. 88466264, 2023 TTAB LEXIS 22, at *28 (TTAB 2023).

Accordingly, we find the thirteenth *DuPont* factor is neutral.

G. Collateral Attack on Cited Registration is Impermissible

Applicant argues that the specimen submitted for the cited registration does not demonstrate use in commerce, the domain name m8.com is inactive, and “[t]here is no evidence of commercial activity, product listings, or sales channels associated with the cited mark.”⁴⁶ Yet, Applicant again provides no evidence in support of its assertions. Moreover, Applicant’s arguments that the cited mark M8 is not in use is an improper “collateral attack on the validity of the registration.” *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1408 (Fed. Cir. 1997).⁴⁷ “[A]n ex parte proceeding is not the

⁴⁴ 11 TTABVUE 7.

⁴⁵ November 27, 2024 Request for Reconsideration at 78-87, 18-25, 40-75.

⁴⁶ 8 TTABVUE 16, 21 (“cited mark shows no retail presence or advertising”), 22.

⁴⁷ Applicant asserts that it “does not challenge the validity of the cited registration” but that it “has shown that the cited mark lacks commercial strength.” 11 TTABVUE 9. But the way to demonstrate commercial weakness of the cited mark is by producing evidence of third-party use of similar marks. *See i.am.symbolic*, 866 F.3d at 1327-29; *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338 (Fed. Cir. 2015) (“the strength or weakness of . . . [a] mark[]—[is] a consideration that is connected to ‘the number and nature of similar marks in use on similar goods’”). Applicant has not done so here.

proper forum for a trademark applicant to launch an attack on a registered mark” *Charger Ventures*, 64 F.4th at 1383 (citation omitted; cleaned up). *See also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1207.01(d)(iv) (May 2025) (and cases cited therein) (“During ex parte prosecution, an applicant will not be heard on matters that constitute a collateral attack on the cited registration (e.g., a registrant’s nonuse of the mark).”). Accordingly, Applicant’s argument “that a registrant no longer uses the registered mark must be disregarded.” *Dixie Rests.*, 105 F.3d at 1408 (citation omitted; cleaned up).

II. Conclusion

After reviewing the evidence of record, and the arguments relating thereto, we conclude that confusion is likely. Applicant’s and Registrants’ goods are identical and legally identical in part, overlapping channels of trade and classes of purchasers are presumed, and Applicant’s and Registrants’ marks are similar, all of which weighs in favor of a likelihood of confusion. The evidence shows that athletic apparel and clothing are relatively inexpensive and subject to impulse purchases thereby increasing the risk of confusion. The factors regarding strength of the marks, actual confusion, and Applicant’s asserted inconsistent treatment in prosecution are neutral and do not alter our conclusion that confusion is likely. We do not consider Applicant’s impermissible collateral attack on the cited registration.

Decision: The refusal to register under Section 2(d) is affirmed.