Mailed: February 26, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

Trademark Trial and Appeal Board

_____

In re X-Fight LLC

_____

Serial No. 76680512

_____

Myron Amer of Myron Amer, P.C. for X-Fight LLC.

Midge F. Butler, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop, Managing Attorney).

_____

Before Bucher, Bergsman and Ritchie, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

X-Fight LLC filed a use-based application for the mark X-FIGHT, in standard character form, for "athletic apparel," in Class 25. *See* the discussion below regarding applicant's amended description of goods.

Registration has been refused under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with clothing so resembles the mark X-FIGHTERS, in standard character form, for clothing, set forth below, as to be likely to cause confusion.[1]

[1] Registration No. 3543747, issued December 9, 2009.

> Clothing, namely, T-shirts, blouses, sweaters, anoraks, wind resistant jackets, aprons, caps, hats, headbands, suspenders, belts, money belts, sun visors; sportswear, namely, shirts, pants, polo shirts, sweat shirts and sweat pants, hooded shirts and sweat shirts, shorts, blouses, skirts, jumpers, jackets and coats; footwear for sports; footwear excluding orthopedic footwear; headgear, namely, hats, caps, headbands; cap peaks, namely, cap visors, baseball caps, golf caps, and caps with visors, in Class 25.

In addition, there is an issue regarding the operative description of goods because the examining attorney refused to accept applicant's second amended description of goods.

A summary of the relevant prosecution history of this application is necessary to understand the refusal.

Date	**Action**
August 9, 2007	Applicant filed its application for the mark X-FIGHT for "athletic apparel."
November 28, 2007	The examining attorney noted application Serial No. 79038602 for the mark X-FIGHTERS for clothing as a potential bar to registration and required an amendment to the description of goods. The examining attorney required that applicant identify the specific types of clothing with which the mark is used.
February 15, 2008	Applicant amended its description of goods to read as follows: "Athletic apparel, namely, sweatshirts and sweatpants, except t-shirts, sportswear and footwear for sports."
April 13, 2009	Application Serial No. 79308602 issued as Registration No. 3543747 and the examining attorney cited it as a Section 2(d) bar to registration.

Date	Action
May 20, 2009	Applicant amended its mark from X-FIGHT to X FIGHT (without the hyphen) and amended the description of goods to read as follows: "Footwear for sports, not including golf shoes with spikes."
May 28, 2009	The examining attorney refused to accept the second amended description of goods because it exceeded the scope of the goods identified in the first amended description of goods; therefore, the examining attorney asserted that the first amended description of goods remained the operative description of goods. In addition, the examining attorney made FINAL the Section 2(d) likelihood of confusion refusal.

The Description of Goods

Trademark Rule 2.71(a), 37 CFR §2.71(a) provides that "[t]he applicant may amend the application to clarify or limit, but not broaden, the identification of goods and/or services." Once an applicant amends the identification of goods and/or services in a manner that is acceptable to the examining attorney, the amendment replaces all previous identifications, and thus restricts the scope of goods/services to that of the amended language. Further amendments that would add to or expand the scope of the recited goods or services, as amended, are not permitted. *In re Swen Sonic Corp.*, 21 USPQ2d 1794, 1795 (TTAB 1991); *In re M.V Et Associes*, 21 USPQ2d 1628, 1630 (Comm'r Pats. 1991); TMEP §1407.07(e) (6th ed. 2009). The applicant may not amend the identification to reinsert goods or services

that were omitted or deleted from the identification of goods or services. *Id.*

On February 15, 2008, applicant amended the description of goods from "athletic apparel" to "athletic apparel, namely, sweatshirts and sweatpants, except t-shirts, sportswear and footwear for sports." The examining attorney properly refused to accept applicant's May 20, 2009 proposed amendment to "footwear for sports, not including golf shoes with spikes" because it exceeded the scope of the first amended description of goods. Specifically, applicant sought to insert "footwear for sports" after explicitly excluding "footwear for sports."

Applicant argues, as best as we can understand its argument, that its second proposed description of goods should be accepted because it obviates the likelihood of confusion. However, applicant's argument is based on the false premise that an amendment to the description of goods must be accepted merely because it creates additional distance from the goods in the cited registration. In an *ex parte* setting, the description of goods in a cited registration is not material in determining whether applicant has a proper identification of goods. Rather, as explained during the prosecution of this application, the examining attorney may require amendment of the

identification of goods and/or services to ensure that it is clear and accurate and conforms to the requirements of the statute and rules. *See* TMEP §1402.01(e).

In view of the foregoing, we find that the first amended description of goods - - "athletic apparel, namely, sweatshirts and sweatpants, except t-shirts, sportswear and footwear for sports" - - is the operative description of goods.

Likelihood of Confusion

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

A. The similarity or dissimilarity and nature of the goods, channels of trade and classes of consumers.

As indicated above, applicant is seeking to register its mark for "athletic apparel, namely, sweatshirts and sweatpants, except t-shirts, sportswear and footwear for sports." The cited registration is for, *inter alia,* sportswear, namely, sweatshirts and sweatpants. The products are legally identical. There is no meaningful distinction that we can discern between sweatshirts and sweatpants identified as "sportswear" or "non-sportswear."

Because the goods identified in the application and the cited registration are in part identical, we must presume that the channels of trade and classes of purchasers are the same. *See Genesco Inc. v. Martz,* 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related 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"); *In re Smith and 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").

B. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

We turn now to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In analyzing the similarity or dissimilarity of the marks, we are mindful that where, as here, the goods are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007).

Moreover, in comparing the marks, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of overall commercial

impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1835, 1741 (TTAB 1991), *aff'd unpublished,* No. 92-1086 (Fed. Cir. June 5, 1992). In making this determination, we must consider the recollection of the average purchaser who normally retains only a general, rather than a specific, impression of the marks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Because the products at issue are sweatpants and sweatshirts, we analyze the marks with the ordinary purchaser in mind.

Applicant's mark X FIGHT is almost identical to the registered mark X-FIGHTERS. The only differences between the marks -- the hyphen and "ers" suffix in the registered mark -- do not distinguish them. Accordingly, we find that the marks are highly similar in terms of appearance, sound, meaning and commercial impression.

E. Balancing the factors.

In view of the near identity of the marks and the goods and the presumption that the goods move in the same channels of trade and are sold to the same classes of ordinary consumers, we find that applicant's mark X FIGHT

for "athletic apparel, namely, sweatshirts and sweatpants, except t-shirts, sportswear and footwear for sports" so resembles the mark X-FIGHTERS for, *inter alia,* sportswear, namely, sweatshirts and sweatpants as to be likely to cause confusion.

Decision: The refusal to register is affirmed.