

This Opinion is Not a  
Precedent of the TTAB

Mailed: April 17, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Coats & Clark Inc.*  
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Serial No. 79236578  
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Lee J. Euglen of Neal Gerber & Eisenberg LLP  
for Coats & Clark Inc.

Katherine Ferrell, Trademark Examining Attorney, Law Office 126,  
Andrew Lawrence, Managing Attorney.

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Before Taylor, Kuczma, and Dunn,  
Administrative Trademark Judges.

Opinion by Dunn, Administrative Trademark Judge:

Coats & Clark Inc. (Applicant) seeks an extension of protection in the United States of International Registration 1412791A for the mark SUPER SAVER FAIR ISLE (in standard characters) for

Yarns and threads, for textile use, in International Class  
23.<sup>1</sup>

The application includes a disclaimer of FAIR ISLE.

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<sup>1</sup> Application Serial No. 79236578 filed on June 15, 2018 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), based on International Registration No. 1412791A, registered June 15, 2018, and claiming priority as of February 2, 2018.

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as applied to the goods identified in the application, so resembles the mark FAIR ISLE (in standard characters) for "knitting yarn; yarn; hand knitting yarns," in International Class 23 and "crochet hooks; crochet needles; knitting counters; knitting implements, namely, stitch holders; knitting implements, namely, stitch markers; knitting needles; hand-knitting needles," in International Class 26,<sup>2</sup> on the Supplemental Register as to be likely to cause confusion, to cause mistake, or to deceive.

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

### **I. Evidentiary Issue**

The Examining Attorney's objection to evidence attached to Applicant's brief as untimely is sustained and this evidence has not been considered. Trademark Rule 2.142(d).

### **II. Likelihood of Confusion Analysis**

Section 2(d) of the Trademark Act prohibits registration of a mark that "so resembles a mark registered in the Patent and Trademark Office" as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Marks registered on the

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<sup>2</sup> Registration No. 5258016, issued August 1, 2017 on the Supplemental Register alleging January 21, 2017 as its dates of first use anywhere and in commerce.

Supplemental Register are “marks registered in the Patent and Trademark Office” and may be used as a basis for refusing registration under Section 2(d) due to a likelihood of confusion. *Id.*; *In re Research & Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 49 (Fed.Cir.1986); *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1743 (TTAB 2016). While the strength of the cited mark is always relevant to assessing the likelihood of confusion, the citation of registrations on the Supplemental Register does not involve a different test for likelihood of confusion. *See In re The Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 341 (CCPA 1978) (“[n]o reason exists, however, for the application of different standards to registrations cited under 2(d).”); *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d at 1744 (“there is no categorical rule that citation of registrations on the Supplemental Register is limited to registrations of ‘substantially identical’ marks for ‘substantially similar goods’”).

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each relevant *DuPont* factor for which there is evidence or argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*,

544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1628 (TTAB 2018).

**A. Similarity or Dissimilarity of the Goods and Channels of Trade**

We turn to the *DuPont* factors regarding the similarity or dissimilarity of the respective goods (second factor) and channels of trade, including prospective purchasers (third factor). When determining whether goods are related, we must consider the goods as they are identified in the respective identification of goods in the application and cited registration. *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods”). *See also Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed”). Applicant seeks to register its SUPER SAVER FAIR ISLE mark for “yarns and threads, for textile use.” The cited FAIR ISLE registration lists, in part, “knitting yarn; yarn; hand knitting yarns.”

Because the registered goods are worded broadly, the “knitting yarn; yarn; hand knitting yarns” plainly encompass Applicant’s “yarns for textile use.” *See In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s

broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007) (petitioner’s “restaurant services” encompass respondent’s “restaurant services featuring bagels as a main entrée”). The goods are in part legally identical. It is not necessary that we find a likelihood of confusion between all of the registered goods and all the goods listed in the application. It is sufficient if likelihood of confusion is established for any item encompassed by the identification of goods in a particular class in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015). This *DuPont* factor weighs in favor of finding a likelihood of confusion.

Furthermore, where, as here, Applicant’s and Registrant’s goods are in part legally identical, we must presume that the channels of trade and classes of purchasers for those goods are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (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); *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”). The third *DuPont* factor also favors a likelihood of confusion.

The legal identity (in part) of Applicant's and Registrant's goods and their overlapping channels of trade and classes of consumers not only weigh in favor of finding a likelihood of confusion, but also reduce the degree of similarity between the marks necessary to find a likelihood of confusion. *In re Viterra*, 101 USPQ2d at 1908; *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016).

### **B. Strength of the Registered Mark**

The fifth *DuPont* factor is the "fame" or strength of the prior mark. *DuPont*, 177 USPQ at 567. In determining the strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and, if evidence is submitted (which it was not in this case), commercial strength, based on recognition in the relevant market. *In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning)."). "In order to determine the conceptual strength of the cited 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, 1815 (TTAB 2014).

We acknowledge the inherent weakness of a mark registered on the Supplemental Register. *In re Bush Bros. & Co.*, 884 F.2d 569, 12 USPQ2d 1058, 1059 n.2 (Fed. Cir. 1989) ("Registration on the Supplemental Register is not evidence of ownership, validity, or the exclusive right to use."). Because Section 23 of the Trademark Act requires marks registered on the Supplemental Register to be "capable of distinguishing applicant's goods or services," we cannot automatically attribute to the

term FAIR ISLE the degree of descriptiveness equivalent to that of a generic word. 15 U.S.C. § 1091; *In re The Clorox Co.*, 198 USPQ at 340. Rather, we must place the registered mark along the descriptive-generic continuum. *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d at 1743-44 (“Most marks are on the Supplemental Register because they are descriptive, and the weaker the mark on the fanciful to generic continuum, the less its ability to preclude registration of a similar mark under Section 2(d).”).

The term FAIR ISLE is defined as “a style of knitting originating in the Shetland Islands that is characterized by bands of multicolored geometric patterns” and “also an article of clothing knitted in this style.”<sup>3</sup> In support of the requirement for a disclaimer of FAIR ISLE in Applicant’s mark, the Examining Attorney submitted a Wikipedia article explaining that the term FAIR ISLE describes a traditional knitting technique named after one of the Shetland islands in Scotland and used to create patterns with multiple colors, and any knitting where stitches are knitted alternately in various colors; an article from a knitting blog showing Applicant’s goods under the SUPER SAVER FAIR ISLE mark; and webpages from two online stores, one for knitting supplies and one for clothing, using the term FAIR ISLE to refer to

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<sup>3</sup> <https://www.merriam-webster.com/dictionary/Fair%20Isle>. Merriam-Webster, <https://www.merriam-webster.com/> (4/15/20). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).

a knitting pattern.<sup>4</sup> Examples of the use of FAIR ISLE for knitting supplies and knit goods are shown below:

same Super Saver you love now comes in new and exciting prints. New Fair Isle prints magically appear as you stitch – no need to change color; one skein does it all! Perfect for sweaters, throws and accessories.



Super Saver Fair Isle is still a weight 4, 100% acrylic yarn. With 6 new color options you can create a variety of looks for your accessories.

Figure 1 Applicant's SUPER SAVER FAIR ISLE yarn<sup>5</sup>

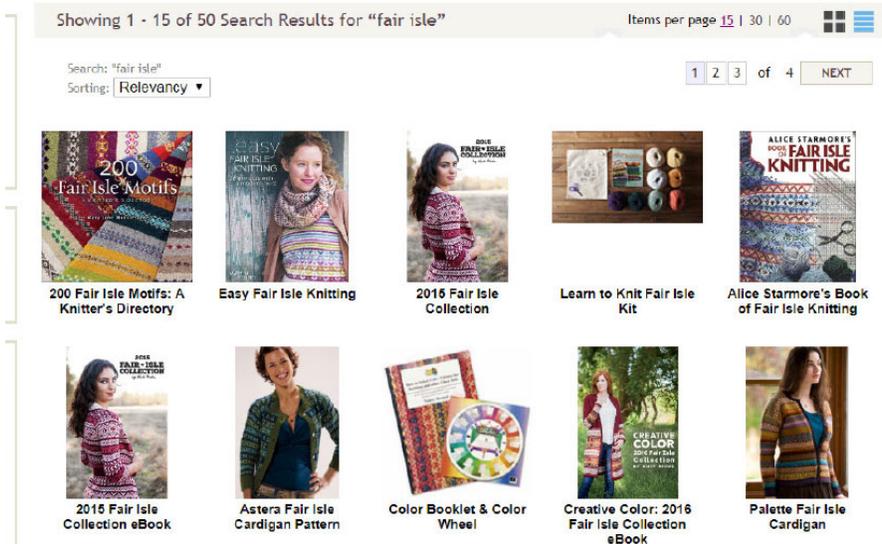


Figure 2 Fair Isle Knitting supplies<sup>6</sup>

<sup>4</sup> August 28, 2018 Office Action, TSDR 8-11 [pdf]. Citations to the application record are to downloaded pages from the USPTO's Trademark Status & Document Retrieval (TSDR) database.

<sup>5</sup> *Id.* at 9

<sup>6</sup> *Id.* at 10.



*Figure 3 Fair Isle sweater<sup>7</sup>*

In view of this record evidence, we find that as applied to the yarn featured in the cited registration, the mark FAIR ISLE is highly descriptive, and conceptually weak as applied to the registered goods. This *DuPont* factor weighs against finding a likelihood of confusion.

### **C. Similarity or Dissimilarity of the Marks**

We consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression. *See Palm Bay*, 73 USPQ2d at 1689. “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*, Slip Op. No. 18–2236 (Fed. Cir. Sept. 13, 2019) (mem) (*quoting In re Davia*, 110 USPQ2d at 1812). The proper focus is on the recollection of the average purchaser, who retains a general impression of trademarks. *In re Bay State Brewing*

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<sup>7</sup> Id. at 11.

Co., 117 USPQ2d at 1960 (citing *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)).

The registered mark is FAIR ISLE, and Applicant’s mark is SUPER SAVER FAIR ISLE. Applicant’s mark includes a disclaimer of FAIR ISLE. It is well settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. *See In re Nat’l Data Corp.*, 753 F3d 1056, 224 USPQ 749, 752 (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

In support of its argument that the term SUPER SAVER is inherently distinctive, and the dominant part of its mark, Applicant submitted copies of six prior Principal Register registrations for SUPER SAVER and SUPER SAVER-formative marks, summarized below<sup>8</sup>:

Registration No. 1566021 issued 11/14/1989, renewed	SUPER SAVER	handknitting yarn
Registration No. 4086820 issued 01/17/2012, Sec. 8 accepted	RED HEART SUPER SAVER CHUNKY (CHUNKY disclaimed)	yarns for knitting and crocheting
Registration No. 5243416 issued 07/18/2017	SUPER SAVER JUMBO (JUMBO disclaimed)	yarns and threads, for textile use
Registration No. 5362126 issued 12/26/2017	RED HEART SUPER SAVER STRIPES	yarns and threads, for textile use

<sup>8</sup> Applicant’s July 23, 2019 Response, TSDR 13-32

	(STRIPES disclaimed)	
Registration No. 5362127 issued 12/26/2017	RED HEART SUPER SAVER OMBRE (OMBRE disclaimed)	yarns and threads, for textile use
Registration No. 5790438 issued 07/02/2019	SUPER SAVER POOLING (POOLING disclaimed)	yarns and threads, for textile use

The Examining Attorney does not dispute that the term SUPER SAVER in Applicant's mark SUPER SAVER FAIR ISLE is inherently distinctive. Instead, the Examining Attorney contends that Applicant's prior registrations establish that SUPER SAVER is Applicant's house mark, and cites the general rule that an applicant's addition of its house mark to one of two otherwise similar marks will not avoid a likelihood of confusion between the marks.<sup>9</sup> *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *General Mills Inc. v. Fage Dairy Proc. Ind. SA*, 100 USPQ2d 1584, 1601 (TTAB 2011), *judgment set aside, opinion not vacated* 110 USPQ2d 1679 (TTAB 2014).

An exception to this general rule, not discussed by the Examining Attorney, applies when a mark is so highly suggestive or descriptive that the addition of a house mark to the same or highly similar mark renders the two marks sufficiently distinguishable to avoid a likelihood of confusion. *See Food Specialty Co. v. Kal Kan Foods, Inc.*, 487 F.2d 1389, 180 USPQ 136 (CCPA 1973) (no likelihood of confusion

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<sup>9</sup> TTABVUE 7. TTABVUE refers to the Board's electronic docket, the location on the USPTO website where the publicly viewable trial record and briefs can be found. The first number is the docket entry and the second, if applicable, is the page within the entry.

between KAL KAN KITTY STEW and KITTY for cat food); *Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d 1163 (TTAB 2011) (no likelihood of confusion between ZIG ZAG CLASSIC AMERICAN BLEND and CLASSIC CANADIAN); *Rocket Trademarks Pty Ltd. v Phard S.p.A.*, 98 USPQ2d 1066 (TTAB 2011) (no likelihood of confusion between ZU ELEMENTS (stylized) and ELEMENTS); *Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844 (TTAB 2008) (no likelihood of confusion between BASS PRO SHOPS SPORTSMAN'S WAREHOUSE and design and SPORTSMAN'S WAREHOUSE); *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ 1313 (TTAB 2005) (no likelihood of confusion between NORTON MCNAUGHTON ESSENTIALS and ESSENTIALS); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (no likelihood of confusion between ADOLPH'S GOLD'N CRUST and design and GOLDEN CRUST); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (no likelihood of confusion between DAN RIVER DESIGNER FABRICS and design and DESIGNERS/FABRIC (stylized)); and Trademark Manual of Examining Procedure (TMEP) § 1207.01(b)(iii) (2019).

The cases cited by the Examining Attorney in support of her position that the marks are similar are distinguishable.<sup>10</sup> The common element in each of those cases is distinctive, unlike in the instant case where the common term is highly descriptive. See *In re Fiesta Palms LLC*, 85 USPQ2d 1360 (TTAB 2007) (likelihood of confusion between CLUB PALMS MVP and MVP); *In re Chica, Inc.*, 84 USPQ2d 1845 (TTAB 2007) (likelihood of confusion between CORAZON BY CHICA and CORAZON); *In re*

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<sup>10</sup> 9 TTABVUE 6-7.

*Christian Dior, S.A.*, 225 USPQ 533 (TTAB 1985) (likelihood of confusion between LE CACHET DE DIOR and CACHET).<sup>11</sup>

The Examining Attorney also argues that, even if the registered mark is considered a weak mark, “such marks are still entitled to protection against registration by a subsequent user of the same or similar marks for the same or closely related goods or services.”<sup>12</sup> However, the question is whether Applicant’s mark is sufficiently similar. The degree of protection to be accorded the registered mark is circumscribed by its weakness. We have found the registered mark FAIR ISLE to be highly descriptive, and conceptually weak as applied to the registered goods, which means it is entitled to a narrow scope of protection. To treat Applicant’s mark SUPER SAVER FAIR ISLE as “the same or similar” to the registered mark FAIR ISLE merely on the basis of these words would give the cited registration a much greater scope of protection than it is entitled to have.

In comparing the two marks in their entirety, we find that the dominant term in Applicant’s mark is the term SUPER SAVER, and not the descriptive and disclaimed term FAIR ISLE. Not only is the term SUPER SAVER inherently distinctive, but it has the prominent first position in Applicant’s mark. *See Presto*

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<sup>11</sup> *See also Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 94 USPQ 419, 422 (CCPA 1977) (finding CALIFORNIA CONCEPT and surfer design and CONCEPT confusingly similar); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (finding BENGAL LANCER and design and BENGAL confusingly similar); *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016) (finding BARR GROUP and BARR confusingly similar); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1090 (TTAB 2016) (finding JAWS DEVOUR YOUR HUNGER and JAWS confusingly similar).

<sup>12</sup> 9 TTABVUE 8.

*Prods., Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (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”). When we compare the marks in their entirety, we find they are not similar in connotation and commercial impression. This *DuPont* factor weighs against finding a likelihood of confusion.

In conclusion, we have considered all of the arguments and evidence of record, and all relevant *DuPont* factors. Given the limited scope of protection to which the Registrant’s Supplemental Registration is entitled, we find that the differences in the marks SUPER SAVER FAIR ISLE and FAIR ISLE are sufficient to avoid a likelihood of confusion, despite the facts that the goods are in-part identical and are deemed to travel in the same channels of trade.

### **III. Decision**

The refusal to register Applicant’s mark SUPER SAVER FAIR ISLE is reversed.