

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: August 30, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Yokohama Rubber Co., Ltd.

Serial No. 79271385

Cynthia A. Moyer of Fredrikson & Byron PA,
for The Yokohama Rubber Co., Ltd.

Benjamin Rosen, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

Before Zervas, Greenbaum and Pologeorgis,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

The Yokohama Rubber Co., Ltd. (“Applicant”) seeks registration on the Principal Register of the composite mark R RADIAL YOKOHAMA G.T. SPECIAL and design,



displayed as

, for various goods in eight International Classes

including “clothing, namely, shirts, pants, shorts, socks, sweaters, jackets; headwear; footwear; garters; suspenders being braces for clothing; belts being clothing; sports jerseys” in International Class 25.¹ Applicant disclaimed the term “YOKOHAMA” for all the International Classes of goods identified in the application and claims the colors black, white and red as a feature of the mark. Additionally, the description of the mark reads as follows:

The mark consists of a circular design consisting of an outer concentric band with a smaller inner circle within, with spacing between the outer band and the inner circle. The outer concentric band consists of four sections, being a top semicircular section, a bottom semicircular section, and two smaller nearly rectangular curved sections on the left and right, all four sections having slight spacing separating each. The top section is a curved solid black band with the white stylized word “YOKOHAMA” within. The bottom section is a curved solid black band with the white stylized wording “G.T. SPECIAL” within. The left and right sections are technically curved bands that more closely resemble rectangles, and each consists of a checkered black and white pattern within a thin black outline. The smaller inner circle is solid red. Within the inner circle is a large stylized letter “R” that is black with white outlining, and beneath that is the smaller white stylized word “RADIAL”. All other instances of the color white, particularly the spacing between the inner circle and outer concentric circular band, the spacing between the four elements of the outer band, and the remaining background outside the circular design, represent background or transparent areas only.

¹ Application Serial No. 79271385, filed on August 30, 2019 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), requesting extension of protection based on International Registration No. 1496920.

Page references to the application record are to the downloadable .pdf version of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs and orders on appeal are to the Board's TTABVUE docket system.

The Examining Attorney refused registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark when used solely in connection with its identified Class 25 goods is likely to cause confusion with the standard character mark RADIALWEAR registered on the Principal Register for the following goods in International Class 25:

Outerwear, namely, coats, jackets, sweaters, gloves, hats; Shorts; Shorts for exercise; Yoga pants; Athletic shirts; Athletic shorts; Athletic tops and bottoms for yoga, pilates, hiking, exercise; Fleece shorts; Gym shorts; Long-sleeved shirts; Moisture-wicking sports shirts; Sports shirts; Sweat shirts; Sweat shorts; T-shirts; Walking shorts; Wearable garments and clothing, namely, shirts; Yoga shirts.²

After the refusal was made final, Applicant appealed and filed a request for reconsideration. The Board suspended the appeal and remanded the application to the Examining Attorney for consideration of the request for reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal resumed. The appeal is fully briefed. For the reasons explained below, we affirm the refusal.

I. Section 2(d) - Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129

² Registration No. 5764998, registered on May 28, 2019.

USPQ2d 1160, 1162-63 (Fed. Cir. 2019). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). “[E]ach case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973) (internal citations removed).

A. Relatedness of the Goods

We initially compare the goods under the second *DuPont* factor. In making our determination regarding the relatedness of the goods, we must look to the goods as identified in Applicant’s application and the goods listed in cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Hous. Comput. Servs. 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.”)); *see also In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011).

Moreover, we need not find similarity as to each and every good listed in an

applicant's identification of goods. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any item encompassed by the identification of goods or services in a particular class in the application. *See SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 938-39 (Fed. Cir. 1983) (holding that a single good from among several may sustain a finding of likelihood of confusion); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods or services in the application).

Here, Applicant's and Registrants'³ jackets, sweaters, shorts and shirts are identical goods identified in both identifications of goods, and Applicant does not contend otherwise.⁴ Additionally, Registrants' "yoga pants" and "hats" are encompassed by Applicant's broadly worded "pants" and "headwear," respectively, and Applicant's "sports jerseys" are encompassed within Registrants' "shirts." *See In re Solid State Design Inc.*, 125 USPQ2d 1409, 1413-14 (TTAB 2018) (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); *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

³ We note that the cited registration is jointly owned by two individuals.

⁴ Applicant states, "Applicant has already acknowledged that its goods and the goods identified in the Cited Mark are related." Applicant's Appeal Brief at p. 12, 6 TTABVUE 15.

‘residential and commercial furniture.’”). We therefore find that certain of Applicant’s and Registrants’ goods are identical, and others are legally identical in part.

Thus, the second *DuPont* factor heavily favors a finding of likelihood of confusion.

B. Similarity of Trade Channels and Classes of Purchaser

Next we consider established, likely-to-continue channels of trade, the third *DuPont* factor. Because we have found that Applicant’s and Registrants’ goods are identical or legally identical, we must presume that these identical and legally identical goods travel through the same channels of trade and are offered to the same or overlapping classes of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board 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).

Accordingly, the third *DuPont* factor also strongly weighs in favor of finding a likelihood of confusion.

C. Strength of the Cited Mark

“A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace [or commercial] strength (secondary meaning).” *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010). For likelihood of confusion purposes, “the strength of a mark is not a binary factor, but varies along a spectrum from very strong to very weak.” *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003).

Applicant has raised the sixth *DuPont* factor, under which we consider the alleged

weakness of the cited registered mark, based on the “[t]he number and nature of similar marks in use on similar ... goods.”⁵ *DuPont*, 177 USPQ at 567. Applicant argues that the cited mark merits a narrowed scope of protection because there are 15 “RADIA”-formative marks that are registered for goods in International Class 25 or in International Class 35 for related services, making “RADIA”-formative marks weak in Class 25.⁶

Despite the reference to use, Applicant’s weakness argument is supported only with third-party registration evidence, but not with any evidence of third-party use.⁷ Third-party registration evidence goes not to the commercial strength of the cited mark, but rather only to its conceptual strength. *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017) (“Use evidence may reflect commercial weakness, while third-party registration evidence that does not equate to proof of third-party use may bear on conceptual weakness if a term is commonly registered for similar goods or services.”) (citing *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976)); *see also In re Guild Mortg. Co.*, 2020 USPQ2d 10279 *3 (TTAB 2020) (“[E]vidence of third-party registrations is relevant to ‘show the sense in which . . . a mark is used in ordinary parlance.’”). Indeed, the Federal Circuit has held that if there is evidence that a mark, or an element of a mark, is commonly adopted by many different registrants, that may

⁵ Applicant’s Appeal Brief, p. 12, 6 TTABVUE 15.

⁶ *Id.* at pp. 13-16, 6 TTABVUE 16-19.

⁷ Because there is no evidence of third-party use of marks similar to the cited mark for similar goods, the sixth *DuPont* factor is neutral.

indicate that the 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) (“[E]vidence 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 that segment is relatively weak’”) (quoting *Juice Generation*, 115 USPQ2d at 1674).

Turning to Applicant’s third-party registration evidence, we find that the 15 third-party registrations owned by 14 different owners submitted to show weakness do not assist Applicant. One entity owns two registrations for the marks RADIAL SPORTS and RADIAL SPORTS and Design, for “retail store services in the field of cycling apparel, gear and accessories; marketing services in the field of cycling apparel, gear and accessories”⁸ and another entity owns a registration for RADIAL for unrelated services. Applicant has not offered evidence or an explanation as to why they are relevant to the issues before us. *See i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (disregarding third-party registrations for goods in other classes where the proffering party “has neither introduced evidence, nor provided

⁸ We note that the registration files for the marks RADIAL SPORTS and RADIAL SPORTS and design are not of record. Thus, we cannot ascertain why these two registered marks co-exist with the cited mark. Notwithstanding, these two registrations owned by a single registrant is hardly sufficient to show common registration of the word RADIAL for clothing or that the term is in any way weak in relation to clothing items.

adequate explanation to support a determination that the existence of I AM marks for goods in other classes ... support[s] a finding that registrants' marks are weak with respect to the goods identified in their registrations"). The remaining third-party registrations have little, if any, probative value because (1) they are for marks that differ from the term RADIAL and have differing connotations and overall commercial impressions, i.e., RADIUS, RADIATE, RADIATE CHRIST, RADIATORS and BE RADIANT, or (2) they list goods unrelated to the goods identified in the cited registration. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) (third-party registrations for goods that appear to be in fields which are far removed from the goods at issue are of limited probative value).

In view of the foregoing, we find that Applicant has not established that the term RADIAL or the cited mark as a whole, when used in connection with clothing, is weak or diluted. Thus, the cited mark, which is registered on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, is entitled to the normal scope of protection accorded an inherently distinctive mark.

D. Similarity of the Marks

We next consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Stone Lion* 110 USPQ2d at 1160; *Palm Bay Imps.*, 73 USPQ2d at 1691; TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") §§ 1207.01(b)-(b)(v) (July 2021). "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 mem.*, Slip Op.

No. 18-2236 (Fed. Cir. Sept. 13, 2019); TMEP § 1207.01(b).


“The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *In re i.am.symbolic, LLC*, 123 USPQ2d at 1748 (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713 1721 (Fed. Cir. 2012) (internal quotation marks omitted)). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Because the goods at issue are clothing items, the average purchaser is an ordinary consumer.

Our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on a comparison of the entire marks, not just part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). However, “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 entirety.” *In re Nat’l Data*, 224 USPQ at 751.

Finally, where the goods of an applicant and registrant are identical or legally identical in part, as is the case here, the degree of similarity between the marks required to support a finding that confusion is likely declines. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *In re Viterra Inc.*, 101 USPQ2d at 1908).



Applicant’s mark is . The cited mark is RADIALWEAR. Here, we find that the term RADIAL, common to both marks, is the dominant element of both marks for the following reasons. First, the average purchaser will generally associate each mark, even when viewed in its entirety, with the term “RADIAL”, because the wording is arbitrary and distinctive as it relates to the clothing items offered by both Applicant and Registrants. With regard to the cited mark, the constituent term “wear” has little to no source-indicating significance because it is the generic name for Registrants’ goods.⁹ *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (quoting *Nat’l Data Corp.*, 224 USPQ at 752); *see also In re N.A.D. Inc.*, 57 USPQ2d 1872, 1873-74 (TTAB 2000) (“[t]hese descriptive, if not

⁹ The Examining Attorney submitted evidence demonstrating that the term “wear” (1) is the generic name for clothing items, and (2) has been consistently disclaimed in registrations that list various clothing articles. *See* January 22, 2021 Denial of Request for Reconsideration, TSDR pp. 7-64.

generic, words have little or no source-indicating significance”). Thus, although we do not ignore the presence of the term “WEAR” in the cited mark, we recognize that this term is weak, and that purchasers are not likely to consider it as an indication of source. Instead, consumers would view the word “RADIAL” as the dominant feature of the cited mark.

As for Applicant’s proposed mark, the letter R, which is the largest literal portion of Applicant’s mark in terms of size, position, and emphasis, would be seen and understood by consumers as reinforcing and focusing attention to the arbitrary term “RADIAL.” This especially holds true since the letter “R” and the term “RADIAL” appear in the center of Applicant’s mark highlighted by a red background that would draw the attention of consumers to the middle of the mark.

We acknowledge that Applicant’s mark also includes the wording YOKOHAMA and G.T. SPECIAL, as well as design elements. However, adding terms or a design element to a registered mark generally does not obviate the similarity between the compared marks nor does it overcome a likelihood of confusion under Section 2(d). *See, e.g., In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009). Thus, the mere addition of wording and a design to the dominant wording “RADIAL” does not overcome a finding of likelihood of confusion, despite any minor changes it may make in appearance, sound, or meaning. The only exceptions are when (1) the matter common to both marks, namely, “RADIAL”, is merely descriptive or diluted, and not likely to be perceived by purchasers as distinguishing source, or (2) the compared marks in their entireties convey significantly different commercial impressions. As

discussed more fully below, neither of the exceptions are applicable in this case. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); TMEP §1207.01(b)(iii).

Further, the term YOKOHAMA has been disclaimed presumably in light of its geographic significance.¹⁰ Disclaimed matter that is descriptive of or generic for a party's goods or services is typically less significant or less dominant when comparing marks. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP § 1207.01(b)(viii). Also, in the case of a composite mark containing both words and a design, as is the case here with Applicant's proposed mark, "the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed." *CBS*, 708 F.2d at 1581-82; *see also L.C. Licensing, Inc. v. Cary Berman*, 86 USPQ2d 1883, 1887 (TTAB 2008) ("[I]t is well settled that if a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods."). Further, as previously noted, where, as here, the goods at issue are identical or identical in part, "the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir. 1992).

¹⁰ "Yokohama" is a generally known geographic place or location, namely, a city in Japan, located just south of Tokyo, Japan. *See* December 4, 2019 Office Action, TSDR pp. 13-14.

Finally, we note that the Trademark Act not only guards against the misimpression that senior users, like Registrants, are the source of a junior user's goods, but it also protects against "reverse confusion," where an assertedly significantly larger or prominent junior user, such as Applicant,¹¹ is perceived as the source of a smaller, senior user's goods such that the "senior user may experience diminution or even loss of its mark's identity and goodwill due to extensive use of a confusingly similar mark by the junior user" for related or, in this instance, identical goods. *In re i.am.symbolic, llc*, 123 USPQ2d at 1752 (quoting *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993)).

In challenging the refusal, Applicant argues that by focusing on the shared use of the term "RADIAL," the Examining Attorney violates the anti-dissection rule because the marks must be compared in their entirety. Specifically, Applicant maintains that Registrants' mark is one word "RADIALWEAR" and not two words "RADIAL WEAR," but provides no supporting law that the lack of a space should have any material bearing on this analysis.¹² The Board has repeatedly found that marks that are

¹¹ Applicant has submitted evidence purportedly demonstrating that the YOKOHAMA portion of its proposed mark is its well-known tire brand in the United States. See Applicant's January 4, 2021 Request for Reconsideration, Exhibits 1, 3 and 4, TSDR pp. 20-22, 26-27, and 28-37.

¹² Applicant's Brief, pp. 6-7; 6 TTABVUE 9-10.

Additionally, Applicant argues that the Examining Attorney only attached two-word marks and failed to include any single word compound marks including "WEAR" in the style of "RADIALWEAR." See Applicant's Appeal Brief, 6 TTABVUE brief, TSDR p. 13. However, any compound word mark containing "WEAR" without a space would be considered a unitary term for the purposes of a disclaimer and therefore any such mark (including "RADIALWEAR") would not contain a disclaimer of the word "WEAR." Therefore, raising the lack of any such examples is a misleading argument that we disregard.

compound words and two separate words should be treated as nearly identical. *See, e.g., Seaguard Corp. v. Seaward Int'l, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (“[T]he marks ‘SEAGUARD’ and ‘SEA GUARD’ are, in contemplation of law, identical [internal citation omitted].”); *In re Best W. Family Steak House, Inc.*, 222 USPQ 827, 827 (TTAB 1984) (“There can be little doubt that the marks [BEEFMASTER and BEEF MASTER] are practically identical”); *Stock Pot, Inc., v. Stockpot Rest., Inc.*, 220 USPQ 52, 52 (TTAB 1983), *aff’d* 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) (“There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical.”).

Applicant also maintains that the addition of the terms YOKOHAMA and G.T. SPECIAL falls within the acceptable exceptions to the legal doctrine that adding terms to a registered mark generally does not obviate the similarity between the compared marks nor does it overcome a likelihood of confusion.

We disagree. As noted above, the only exceptions are when (1) the matter common to both marks, namely, “RADIAL”, is merely descriptive or diluted, and not likely to be perceived by purchasers as distinguishing source, or (2) the compared marks in their entireties convey significantly different commercial impressions. The first exception is inapplicable since Applicant has not adduced any evidence in support of an argument that the term “RADIAL” is weak or diluted when used in association with clothing. Likewise, the second exception also does not apply because Applicant provides no specific evidence that the wording YOKOHAMA and G.T. SPECIAL

changes the commercial impression of “RADIAL”. Applicant merely argues that despite the placement of “RADIAL” in the front and center of its mark, “YOKOHOMA” is the dominant element of its mark and, as noted above, provides evidence on the fame of its “YOKOHOMA” tire brand. However, Applicant is not applying to register a mark consisting of its tire trademark as ornamental matter on clothing; rather, Applicant is seeking to register a mark that includes additional wording and a design for clothing. Applicant’s argument is tantamount to asserting that because one component of its mark is very distinctive and famous, it is therefore entitled to adopt Registrants’ arbitrary and distinctive wording “RADIAL” and use it visually in the very center of its mark. However, as we have previously held, the addition of a trade name or house mark is generally insufficient to avoid a likelihood of confusion. *See, e.g., In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (finding TITAN and VANTAGE TITAN confusingly similar); *SMS, Inc. v. Byn-Mar Inc.*, 228 USPQ 219, 220 (TTAB 1985) (applicant's marks ALSO ANDREA and ANDREA SPORT were “likely to evoke an association by consumers with opposer's preexisting mark [ANDREA SIMONE] for its established line of clothing.”); *In re Christian Dior, S.A.*, 225 USPQ 533, 535 (TTAB 1985) (addition of house mark in LE CACHET De DIOR does not avoid likelihood of confusion with registered CACHET mark). This especially holds true here where Applicant has disclaimed the term YOKOHAMA. Quite simply, while the addition of the terms YOKOHAMA and G.T. SPECIAL in Applicant’s proposed mark may cause the marks at issue to differ visually and aurally, the inclusion of the terms are insufficient to distinguish the

marks since Applicant has merely appropriated the distinctive and arbitrary wording “RADIAL” in Registrants’ mark and has centrally positioned such wording in its own proposed mark in a conspicuous manner on a red background that is reinforced with the large letter “R” above the wording.

Applicant also submitted three examples of purported analogous situations of co-existing marks, where one contains the same “WEAR” wording, i.e., LEGION v. LEGIONWEAR, LA ROCA v. ROCAWEAR, and various co-existing TRU-formative marks, including TRUWEAR.¹³ While these examples may appear analogous, the underlying facts of these other registrations are not part of the record and the prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. *See In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017). Without any relevant information, we have given these co-existing third-party registrations very little, if any, probative value in our analysis.


Overall, while there are obvious differences between Applicant’s and Registrants’ marks, we find that, when viewed in their entireties, the marks are more similar than dissimilar due to the common presence of the arbitrary and distinctive term RADIAL. The first *DuPont* factor thus supports a finding of likelihood of confusion.

¹³ Applicant’s January 4, 2021 Request for Reconsideration, Exhibit 5, TSDR pp. 38-60.

II. Conclusion

We have considered all of the evidence made of record pertaining to the likelihood of confusion issue, as well as all of the arguments related thereto. Because Applicant's mark is similar to Registrants' mark, the goods are identical or identical in part, the channels of trade for these identical and identical in part goods are presumed to be the same, the classes of consumers are identical, and since the evidence of record does not demonstrate that the cited mark is diluted or weak, we find, under the relevant *DuPont* factors, that confusion is likely between the marks. In reaching our decision, we recognize that this is a close case. However, to the extent that any of the points presented by Applicant raise a doubt about likelihood of confusion, that doubt is resolved in favor of the prior Registrants. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290-91 (Fed. Cir. 1984).



Decision: The refusal to register Applicant's mark  under Section 2(d) of the Trademark Act with regard to the goods identified in International Class 25 is affirmed. The application will proceed solely with respect to the goods identified in International Classes 6, 16, 18, 21, 24, 26 and 28.

Dissent:

Opinion by Zervas, Administrative Trademark Judge, dissenting:

I respectfully dissent from the majority's findings regarding the first *DuPont* factor, the similarity or dissimilarity of the marks, and its conclusion on likelihood of confusion.

The majority's analysis of the first *DuPont* factor – beginning with its side-by-side display of the marks – is formulaic and leads to the wrong result. The majority forgets that 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 in their entirety are sufficiently similar in terms of their **overall** commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713 1721 (Fed. Cir. 2012). As explained below, the marks are not sufficiently similar in their overall commercial impression.

Because of Applicant's tire design,¹⁴ the checkered flags¹⁵ and the reference to GT,¹⁶ RADIAL screams "radial tire" to the consumer. "Radial tire" does not come to mind when the adjective RADIAL is placed next to the noun WEAR in the context of

¹⁴ January 11, 2020 Response to Office Action, 4 TSDR ("RADIAL is in the center of Applicant's tire-shaped design").

¹⁵ "Checkered flag" is defined as "a flag marked by alternating black and white squares that is waved at the finish line to signal the end of a race." <https://www.merriam-webster.com/dictionary/checkered%20flag> (accessed on August 26, 2021). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

¹⁶ "GT" is an abbreviation for "grand touring car." <https://www.merriam-webster.com/dictionary/gt> (accessed on August 26, 2021). Judicial notice is taken of this definition.

clothing.¹⁷ The majority fails to recognize the stark differences in meaning of RADIAL in the marks.

RADIAL is the smallest word in Applicant's mark. While in the middle of the mark, a large "R" overshadows it. The majority says that the "R" reinforces and focuses the attention to the arbitrary term RADIAL. The large "R" – which is so large that it spans the length of the term RADIAL and appears in the top center portion of the middle of the mark, above RADIAL, in a striking black color on a red background – forms a distinctive element. By minimizing significance of the largest single literal element in Applicant's mark and emphasizing the smallest word in the mark, the majority errs.

Further, the majority notes that the term YOKOHAMA has been disclaimed, speculating that it is a geographically descriptive term but also labeling it a trade name or house mark. It applies the proposition that the addition of a trade name or house mark is **generally** insufficient to avoid a likelihood of confusion, adding that "[t]his especially holds true here where Applicant has disclaimed the term YOKOHAMA." This proposition – which is not absolute – does not apply to this case.

¹⁷ The adjective "radial" is defined as:

- 1: arranged or having parts arranged like rays
- 2 a: relating to, placed like, or moving along a radius
b: characterized by divergence from a center
- 3: of, relating to, or adjacent to a bodily radius
- 4: developing uniformly around a central axis

(<https://www.merriam-webster.com/dictionary/radial>, accessed on August 26, 2021). Judicial notice is taken of this definition.

YOKOHAMA is the largest word in the mark, it is part of a ring design which includes G.T. SPECIAL in the same color and lettering style, and has particular prominence at the top of the mark. Also, (i) Applicant has not simply added a house mark to a single term mark, as was the case in two of the cases relied on by the majority, (ii) the cited mark is not RADIAL but is RADIALWEAR – Applicant did not add YOKOHAMA to RADIALWEAR, and (iii) consumers are not likely to be aware of what terms are disclaimed in a registration.

Applicant's mark is a very busy mark. There are many features – the tire design, the large “R,” the term YOKOHAMA, the terms G.T. SPECIAL, the two checkered flags, the different fonts and the multiple colors. These multiple features render it implausible that RADIAL is a dominant feature. Why a consumer would hone in on the smallest word in such a busy mark and find it to be “dominant” is inexplicable, unless, of course, the consumer too engages in a similar formulaic analysis.

Because in my view the first *DuPont* factor, the differences between the marks, outweighs the other factors, I would reverse the refusal to register as it pertains to the International Class 25 goods. See *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive”).