

This Opinion is not a
Precedent of the TTAB

Hearing:
January 15, 2015

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re i.am.symbolic, llc

Serial Nos. 85044496

Jill M. Pietrini of Sheppard Mullin Richter & Hampton,
for i.am.symbolic, llc.

Timothy J. Finnegan, Trademark Examining Attorney, Law Office 104,
Chris Doninger, Managing Attorney.

Before Quinn, Taylor, and Shaw,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

i.am.symbolic, llc (“Applicant”), by way of assignment from William Adams, filed an application to register the mark I AM (in standard characters) for the goods ultimately identified as (emphasis added)¹:

Brass wrist cuff bracelets; clocks; jewelry, namely, dog tags for wear by humans for decorative purposes; jewelry; jewelry boxes; jewelry sets, namely, necklaces, earrings and bracelets; key holders, rings and chains of precious metal; lapel pins; medals; ornamental pins, rubber

¹ After the appeal was filed the application was assigned in a document executed on July 19, 2013; the assignment document was recorded on July 25, 2013 in the Assignment Branch records of the Office at reel 5078, frame 0946.

wristbands in the nature of bracelets; silver wrist cuff bracelets; sun dials; watch bands; watch bracelets; watch cases; watches; wrist bands of imitation leather; wrist bands of leather; and jewelry made of resin, namely, wrist cuffs of resin, **all associated with William Adams, professionally known as “will.i.am”** (in International Class 14).²

The Trademark Examining Attorney refused registration under Section 2(d) on the ground that Applicant’s mark, when applied to Applicant’s goods (including jewelry; jewelry sets, namely, necklaces, earrings and bracelets; rubber wristbands in the nature of bracelets; wrist bands of imitation leather; wrist bands of leather), so resembles the previously registered mark shown below

The image shows the handwritten signature 'I am' in black ink. The 'I' is a simple vertical line, and 'am' is written in a cursive, lowercase style.

for “jewelry and fashion jewelry, bracelets, anklets, necklaces, pendants, earrings, ear clips, broaches, finger rings, arm rings; watches, wrist watches, pocket watches, watch chains and watch fobs” in International Class 14,³ and the mark I AM (in standard character form) for “silicone stretchable wrist band in the nature of a bracelet” in International Class 14,⁴ as to be likely to cause confusion. The registrations are owned by different entities.

² Application Serial No. 85044496, filed May 21, 2010, alleging a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). By way of an Examiner’s Amendment dated March 1, 2015, the amendment to the identification as highlighted above was accepted and entered.

³ Registration No. 3188447, issued December 26, 2006; Section 8 affidavit accepted. The registration is owned by Beeline GmbH.

⁴ Registration No. 3935952, issued on March 22, 2011 on the Supplemental Register. The registration is owned by Justin Finch. Applicant’s attacks on this registration based on the fact that it is on the Supplemental Register are irrelevant. As Applicant itself concedes, a

The crux of Applicant's position centers on the purported dissimilarity of its goods and the goods of Registrant due to the specific language highlighted above in Applicant's identification of goods (namely, the language "associated with William Adams, professionally known as 'will.i.am'"). After a final refusal issued, Applicant appealed. Applicant's counsel and the Examining Attorney filed briefs, and both appeared at an oral hearing. We affirm the refusal of registration. *See In re i.am.symbolic, llc*, ___USPQ2d___, S.N. 85044494 (TTAB Oct. 7, 2015).

Background

William Adams is an American musician known by his stage name "will.i.am" as the front man of the music group The Black Eyed Peas. The evidence shows that Mr. Adams became well-known as a member of that highly successful group, and that he has embarked in expanding his career beyond music, to acting, fashion and political advocacy. Applicant, by way of assignment from Mr. Adams, owns the following registrations: WILL.I.AM (in standard characters) for "series of pre-recorded phonograph records, CDs and audio cassettes featuring music; series of pre-recorded video tapes and DVDs featuring music videos and musical performances" in International Class 9;⁵ and for "entertainment services, namely, live musical performances by a male artist; and fashion designer" in International Class 41;⁶ and I AM (typed drawing) for "clothing, namely, hats, caps, socks, shirts,

Supplemental Register registration can be used as a basis for refusing registration under Section 2(d). *See Otter Prods. LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1254 (TTAB 2012 (citing *In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 340 (CCPA 1978)).

⁵ Registration No. 3678106, issued September 1, 2009 on the Supplemental Register.

⁶ Registration No. 3707981, issued November 10, 2009.

t-shirts, sweatshirts, tank tops, shorts, pants, sweatpants, jeans, swimwear, swimsuits, beachwear and footwear, namely, shoes, athletic footwear, boots, clogs, sneakers and sandals” in International Class 25.⁷ As discussed further below, Applicant contends that its I AM mark now sought to be registered is a natural extension of its registered WILL.I.AM and I AM marks, and “conveys the synthesis of [Mr. Adams’] own artistry, expression, and activism.” (Response, March 14, 2011).

Discussion

Applicant contends that there is no likelihood of confusion because its mark identifies Applicant’s founder “will.i.am”; Applicant’s goods are exclusively associated with Applicant’s founder “will.i.am”; the goods under the respective marks are marketed differently; and the cited mark is not famous.

Applicant filed excerpts of the websites of both Registrants. The Examining Attorney introduced numerous excerpts of third-party websites and copies of third-party registrations.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). “In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods.” *In re SL&E*

⁷ Registration No. 2433688, issued March 6, 2001; renewed. Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i) (July 2015).

Training Stable, Inc., 88 USPQ2d 1216, 1217 (TTAB 2008). See also *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.”).

In determining the issue of likelihood of confusion, we are guided by the following legal principles that pertain to the first and second *du Pont* factors. With respect to the first *du Pont* factor, we must compare the marks in their entireties as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567). “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.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

As to the second *du Pont* factor, when analyzing the similarity of the goods, “it is not necessary that the products of the parties be similar or even competitive to support a finding of likelihood of confusion.” *Coach Services Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1722, citing *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007). Instead, likelihood of confusion can be found “if the respective products are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.” *Id.* The issue is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of the goods. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). In making our determination regarding the relatedness of the goods, we must look to the goods as identified in the application and the cited registrations. *See Octocom Sys., Inc. v. Houston Computers Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011). Likelihood of confusion must be found if there is likely to be confusion with respect to any item in a class that comes within the identification of goods in the application and cited registration. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007).

“Associated With” Language in Identification of Goods

We first address Applicant’s main argument against the refusal, that is, that the language “associated with William Adams, professionally known as ‘will.i.am’” in its identification of goods ensures that consumers are unlikely to be confused as to the source of the goods. Applicant contends that its goods represent a creative extension of Mr. Adams’ growing commercial interests beyond music. However, we view the language “associated with William Adams, professionally known as ‘will.i.am’” in Applicant’s identification of goods as merely highlighting an association with Applicant’s presumed principal, Mr. Adams.⁸ Contrary to Applicant’s assertion, we do not see the language as imposing a meaningful limitation on Applicant’s goods in any fashion, most especially with respect to either trade channels or class of purchasers. The language does not, in any meaningful way, alter the nature of the goods identified; nor does it represent that the goods will be marketed in any particular, limited way, through any particular, limited trade channels, or to any particular class of customers. It does not even represent that Mr. Adams will be named, or otherwise identified, in the promotion of the goods. The language “associated with William Adams, professionally known as ‘will.i.am’” is precatory language, and not binding on consumers when they encounter Applicant’s mark. *Cf. M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944 (Fed. Cir. 2006) (based on restrictions to specific industries in both of the identifications of goods in Opposer’s registration and Applicant’s application, the

⁸ As indicated earlier, Mr. Adams transferred his rights in the applied-for mark and ownership of the application to Applicant.

goods are unrelated and travel in different trade channels to different purchasers). Purchasers are unlikely to know of the assertion in a registration issued to Applicant that Applicant's goods are limited to those associated with Mr. Adams.

Applicant also argues that its mark will be perceived as identifying Mr. Adams, and that this perception will, in some way, affect the marketing of the goods and the customers to whom they are directed. It should be noted, however, that Applicant is seeking to register the mark I AM, not WILL.IAM. The record falls short of establishing that Mr. Adams is widely known by "i.am" (as opposed to "will.i.am"), or that "i.am" and "will.i.am" are used interchangeably by either Mr. Adams or the public; Applicant's registration for the mark I AM (which it acquired by assignment) does not persuade us to the contrary. In this connection, we note that Applicant's registration for the mark WILL.IAM includes a statement that "[t]he name shown in the mark identifies a living individual whose consent to register is of record." Although the lack of such a statement is not proof that a mark does not identify a particular living individual, we note Applicant's registration for the mark I AM for clothing does not include such a statement.

Applicant is seeking to register the mark I AM (no periods), and not WILL.IAM. Even if we were to accept Applicant's contention that Mr. Adams is known by "i.am" and that this brand has gained notoriety, the statute still "protects the registrant and senior user from adverse commercial impact due to use of a similar mark by a newcomer." *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). As the Federal Circuit stated:

The term “reverse confusion” has been used to describe the situation where a significantly larger or prominent newcomer “saturates the market” with a trademark that is confusingly similar to that of a smaller, senior registrant for related goods or services. *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 957 & n.12, 24 USPQ2d 1001, 1010 & n.12 (7th Cir. 1992), *cert. denied*, 61 U.S.L.W. 3621 (U.S. Apr. 19, 1993) (No. 92-1400). The junior user does not seek to benefit from the goodwill of the senior user; however, 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. *Banff, Ltd. v. Federated Department Stores, Inc.*, 841 F.2d 486, 490, 6 USPQ2d 1187, 1191 (2d Cir. 1988); *Ameritech, Inc. v. American Information Technologies Corp.*, 811 F.2d 960, 966, 1 USPQ2d 1861, 1866 (6th Cir. 1987).

The avoidance of confusion between users of disparate size is not a new concept; however, the weighing of the relevant factors must take into account the confusion that may flow from extensive promotion of a similar or identical mark by a junior user. *See DeCosta v. Viacom International Inc.*, 981 F.2d 602, 607-10, 25 USPQ2d 1187, 1191-93 (1st Cir. 1992).

The language in the identification of goods simply is not a reasonable basis to assume that purchasers would be able to distinguish the source of such goods from those emanating from the prior Registrant. As we view it, the language essentially is a distinction without a difference for purposes of our likelihood of confusion analysis.

We now turn to consideration of the relevant *du Pont* factors. We state, at the outset, that we have carefully considered all of the evidence made of record pertaining to the issue of likelihood of confusion, as well as all of the arguments related thereto, including any evidence and arguments not specifically discussed in this opinion.

Similarity of the Marks

We first compare Applicant's mark to each of the cited marks. Applicant's mark I AM in standard characters is identical in every respect to the registered mark I AM in standard characters. The marks are identical in appearance and sound. As to connotation, we fail to perceive any distinction. There is no question that typical customers know the meaning of the words I AM; accordingly, both marks would immediately be perceived to have the same literal meaning. Thus, the overall commercial impressions of the marks are the same.

With respect to a comparison between Applicant's standard character mark and the registered mark in stylized form, because Applicant's mark is in standard characters, the marks may be considered to be legally identical. The stylization of Registrant's mark is insufficient to distinguish it from Applicant's mark. Because Applicant's mark is presented in standard characters, Applicant is not limited to any particular depiction of its mark. Thus, if Applicant were to obtain a registration, Applicant would be entitled to all depictions of its standard character mark regardless of the font style, size, or color; Applicant's mark could at any time in the future be displayed in a manner similar to Registrant's mark, that is, the terminology I AM displayed in the same font style and size. *In re Viterra Inc.*, 101 USPQ2d at 1909-10; *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011). *See Squirrco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (rejecting argument that a mark in standard character format (typed) is distinct from a mark in a stylized format; "[b]y

presenting its mark in a typed drawing, a difference cannot legally be asserted by that party”).

Applicant contends that silicone wristbands of the type offered by Registrant are typically emblazoned with words or designs for the purposes of showing support of the wearer, and in this connection relies upon Registrant’s website to show that Registrant’s wristbands feature the words “I AM” followed by various words, as for example, “I AM HAPPY.” Regardless of how Applicant or Registrant currently intends to promote its mark, it is indisputable that the two marks at issue are legally identical, carry the same meaning, and have the potential to be used (at least in terms of their grammatical meaning) in exactly the same manner. Thus, although we acknowledge Applicant’s intentions in this regard and Registrant’s marketing surrounding the registered mark, we find that the marks, when used in connection with the goods as set forth in the identifications of goods, would be perceived similarly. In considering the similarity between the marks, we must compare Applicant’s mark with the cited mark *as shown in the registration certificate*. See *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1508 (TTAB 2007); *Jockey Int’l. Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1236 (TTAB 1992); *Blue Cross and Blue Shield Assoc. v. Harvard Community Health Plan Inc.*, 17 USPQ2d 1075, 1077 (TTAB 1990). The cited registration is for I AM, not I AM combined with some other word.

Accordingly, the identity between Applicant's mark and each of the registered marks is a *du Pont* factor that weighs heavily in favor of a finding of likelihood of confusion.

Relatedness of the Goods and Channels of Trade

With respect to the goods, Applicant's identification of goods concludes with the language "all associated with William Adams, professionally known as 'will.i.am.'" As indicated earlier, the language is of little significance in comparing the goods, essentially being a distinction without a difference. Further, the language does nothing in the way of limiting the trade channels or purchasers for Applicant's goods. Applicant's "jewelry, bracelets, necklaces, and earrings" are identical to those same goods listed in Registration No. 3188447. Applicant's "rubber wristbands in the nature of bracelets" are legally identical to the "silicone stretchable wrist band in the nature of a bracelet" listed in Registration No. 3935952.⁹ *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 209 USPQ at 988 (Likelihood of confusion must be found as to the entire class of an application if there is likely to be confusion with respect to any item in the identified goods in that class).

⁹ We take judicial notice of the following definitions:

Silicone: a chemical that does not let water or heat pass through and that is used to make rubber, grease, and in plastic surgery.

Silicone rubber: rubber made from silicone elastomers and noted for its retention of flexibility, resilience, and tensile strength over a wide temperature range.

(www.merriam-webster.com). 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 have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006). *See In re Thomas White Int'l Ltd.*, 106 USPQ2d 1158, 1160 n.1 (TTAB 2013).

Moreover, because the goods identified in the application are legally identical to these goods in the cited registrations, we must presume that the channels of trade and classes of purchasers are the same. *See 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); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). *See also 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). The classes of purchasers would include ordinary consumers.

As to conditions of sale, because Applicant's and Registrants' identifications do not limit the goods to a particular price point, we must treat the goods as including inexpensive as well as high-end jewelry, and therefore presume that purchasers for these goods include ordinary consumers who may buy inexpensive jewelry on impulse. *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1282 (Fed. Cir. 1984). Thus, this factor favors a finding of a likelihood of confusion.

The identity in goods, trade channels and purchasers, and the conditions under which and buyers to whom sales are made are factors that weigh in favor of a finding of a likelihood of confusion.

Other Factors

Applicant argues that the coexistence of the two cited marks on the register is evidence that there is no likelihood of confusion between each of these marks and Applicant's mark. Long-standing precedent establishes that third-party registrations cannot assist an applicant in registering a mark that is likely to cause confusion with a previously registered mark. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010). As the Board stated in *In re Chica Inc.*, 84 USPQ2d 1845, 1849 (TTAB 2007):

[A]n applicant does not overcome a likelihood of confusion refusal by pointing to other registrations and arguing that they are as similar to the cited registration as applicant's mark. While third-party registrations may be used to demonstrate that a portion of a mark is suggestive or descriptive, they "cannot justify the registration of another confusingly similar mark." *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987), quoting *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983).

See also AMF Inc. v. American Leisure Prods., Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967); *In re Helene Curtis Indus., Inc.*, 305 F.2d 492, 134 USPQ 501, 503 (CCPA 1962). Moreover, the Board is not bound by the prior decisions of examining attorneys in allowing marks for registration. It is well established that each case must be decided on its own facts. *See In re Nett Designs Inc.*, 236 F.3d

1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“Even if some prior registrations had some characteristics similar to [applicant’s] application, the PTO’s allowance of such prior registrations does not bind the Board or this court.”); *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987). We are obligated to assess the registrability of Applicant’s mark on its own merits and not simply based on the existence of other registrations.

The purported lack of fame of Registrants’ marks, as argued by Applicant, is of little consequence. *See* TMEP § 1207.01(d)(ix). Because of the nature of the evidence required to establish the fame of a registered mark, the Board normally does not expect the Examining Attorney to submit evidence as to the fame of the cited mark in an *ex parte* proceeding. *See In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006). And, in an *ex parte* analysis of the *du Pont* factors for determining likelihood of confusion, the “fame of the mark” factor is normally treated as neutral when no evidence as to fame has been provided. *See id.*; *see also In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009) (noting that the absence of evidence as to the fame of the registered mark “is not particularly significant in the context of an *ex parte* proceeding”).¹⁰

¹⁰ Applicant’s fame or renown is another matter. The fame of *either* mark increases the likelihood of confusion by making it more likely that purchasers will remember the famous mark and think of it when encountering similar goods sold under a similar mark. Of course, such likelihood of confusion is only a reason to *refuse* a new registration, not grant one. To the extent that Mr. Adams and Applicant’s mark are well-known, such fact supports refusal of Applicant’s application, because when confusion is likely, it is the prior Registrant which must prevail. Even if it eclipses the renown of the prior Registrant, Applicant’s fame does not entitle it to usurp the cited Registrant’s rights in the mark.

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After considering all of the evidence properly of record and arguments pertaining to the *du Pont* likelihood of confusion factors, we find that there is a likelihood of confusion between Applicant's mark and each of the cited marks.

***Decision:* The refusal of registration is affirmed.**