

This Opinion is Not a
Precedent of the TTAB

Mailed: May 18, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Delux Advertising, LLC

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Serial No. 86513486

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Joseph D. Huser for Delux Advertising, LLC.

Kathleen M. Vanston, Trademark Examining Attorney, Law Office 107, J. Leslie Bishop, Managing Attorney.

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Before Kuczma, Greenbaum and Adlin, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Delux Advertising, LLC (“Applicant”) seeks registration of the mark ELITE TEST 360, in standard characters, for “dietary and nutritional supplements for endurance sports.”¹ The Examining Attorney refused registration under Section 2(d) of the Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles the registered mark 360 TEST for “nutritional supplements,”² that use of Applicant’s mark in

¹ Application Serial No. 86513486, filed January 25, 2015 under Section 1(a) of the Trademark Act, alleging first use dates of March 1, 2013.

² Registration No. 4408458, issued September 24, 2013.

connection with Applicant's goods is likely to cause confusion or mistake or to deceive. After the refusal became final, Applicant appealed and filed a request for reconsideration which was denied. Applicant and the Examining Attorney filed briefs.

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); *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. *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.").

Turning first to the goods, they are legally identical, as Registrant's "nutritional supplements" encompass Applicant's "dietary and nutritional supplements for endurance sports." Where, as here, Applicant's and Registrant's goods are legally identical, we must presume that the channels of trade and classes of purchasers for those goods are also 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); *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).

The legal identity of Applicant's and Registrant's goods and their overlapping channels of trade and classes of purchasers not only weigh heavily in favor of a finding of 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 Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

Turning to the marks, we must compare them "in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). That is, we may not dissect the marks into their various components. *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). However, one feature of a mark may be more significant than another, and it is not improper to give more weight to the dominant feature of a mark in determining its commercial impression. *In re Nat'l. Data Corp.*, 224 USPQ at 751 ("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 entireties. Indeed, this type of analysis appears to be unavoidable.”).

Here, the marks are similar because both contain “360” and “TEST.” In fact, the marks include what we have referred to as “reverse combinations” of the same words or elements or a “transposition” of the most important words comprising the marks. *See e.g., In re Wine Society of America Inc.*, 12 USPQ2d 1139, 1142 (TTAB 1989) (affirming refusal to register THE WINE SOCIETY OF AMERICA & Design based on registration of AMERICAN WINE SOCIETY 1967 & Design, finding that “the transposition of words does not change the overall commercial impression”) and *Bank of America National Trust and Savings Ass’n v. The American National Bank of St. Joseph*, 201 USPQ 842, 845 (TTAB 1978) (“the words ‘BANKAMERICA’ and ‘BANK OF AMERICA’, on the one hand, and ‘AMERIBANC’, on the other, convey the same meaning and create substantially similar commercial impressions”). In *In re Nationwide Industries, Inc.*, 6 USPQ2d 1882, 1884 (TTAB 1988), which affirmed the refusal to register RUST BUSTER for rust-penetrating spray lubricant based on the mark BUST RUST for penetrating oil, we held that “the reversal in one mark of the essential elements of another mark may serve as a basis for a finding of no likelihood of confusion only if the transposed marks create distinctly different commercial impressions.” However, where transposed marks do not convey different commercial impressions, likelihood of confusion is ordinarily found. *See Carlisle Chemical Works, Inc. v. Hardman & Holden*, 434 F.2d 1403, 168 USPQ 110 (CCPA 1970) (reversing dismissal of oppositions to registration of COZIRC based on use of ZIRCO for related

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goods, finding that the marks “are substantially similar, the difference being in a reversal of syllables which are essentially the same”); *In re General Tire & Rubber Company*, 213 USPQ 870 (TTAB 1982) (affirming refusal to register SPRINT STEEL RADIAL for pneumatic tires based on registration for RADIAL SPRINT for vehicle tires, finding that the marks “convey the same meaning, that is, a steel radial tire called ‘SPRINT’ or a radial tire called ‘SPRINT’ both of which could emanate from the same source”); *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111, 114 (TTAB 1978) (“... the use of identical terms in inverse order as we have in the present case is likely to cause confusion in trade when used on such closely related cosmetic products”); *Fisher Scientific Company v. Ipco Hospital Supply Corporation*, 165 USPQ 471, 472 (TTAB 1970) (sustaining opposition to MIX O THERM based on THERMIX used for identical goods, stating “they are in their essentials merely reverse combinations of the same words, and such being the case, would more than likely convey substantially the same commercial impressions”); *Royal Crown Cola Co. v. Bakers Franchise*, 150 USPQ 698 (TTAB 1966), *aff’d*, 404 F.2d 985, 160 USPQ 192 (CCPA 1969) (“... the applicant’s compound mark includes the same words which make up opposer’s mark, that is to say ‘RITE DIET’ is merely ‘DIET-RITE’ transposed. The marks of the parties create substantially the same commercial impressions ...”). In this case, it is clear that the marks create similar commercial impressions because, as Applicant argues, “TEST is commonly understood as shorthand for ‘testosterone’ in nutritional supplements,” and “360 is a common term when marketing nutritional supplements as a way to connote wholeness or

completeness, as in the 360 degrees of a circle.” Applicant’s Appeal Brief at 10; Office Action response of May 27, 2015 (exhibit depicting packaging of numerous nutritional supplement products from unrelated sources the marks for which include “TEST” to convey “testosterone”). Given these “commonly understood” meanings of the terms 360 and TEST, the connotation of 360 TEST is similar if not identical to TEST 360. No evidence of record suggests to the contrary.³

While Applicant’s mark begins with the word ELITE, which is absent from Registrant’s mark, this is not enough of a dissimilarity to prevent confusion. Indeed, as Applicant concedes, “elite” is laudatory, and therefore at best suggestive; it is not particularly significant in our analysis. Office Action response of May 27, 2015 (Applicant concedes that ELITE “suggests that the product is the best out there – that Applicant’s product is superior to all other testosterone-boosting supplements.”); Applicant’s Appeal Brief at 4 (“ELITE is a suggestive term that expresses the upper echelons of fitness that users of the product can reach.”). *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“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 Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (BINION’S, not descriptive word

³ Registrant’s use of the term 360 in several of its other marks only heightens the likelihood of confusion, as consumers may perceive ELITE TEST 360 as just one more of Registrant’s “360” marks.

ROADHOUSE, is dominant element of BINION'S ROADHOUSE); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001).

Even if the terms TEST and 360 are conceptually weaker than the term ELITE in Applicant's mark, that would not prevent confusion given Applicant's mere reversal of the terms in Registrant's mark. In fact, consumers familiar with Registrant's mark could believe that Applicant's mark is a modified version of Registrant's mark, or that Applicant's supplements for endurance sports are an extension of Registrant's brand of supplements into the endurance sports market. For example, the commercial impression of Applicant's mark on consumers familiar with Registrant's mark could be that of a select or superior nutritional supplement for "elite" athletes.

Applicant has introduced evidence that the terms 360 and TEST are commonly used and registered for nutritional supplements, and as indicated we accept that both terms have the connotations Applicant ascribes to them in the marketplace for nutritional supplements, and that they are accordingly conceptually and commercially weak. Nevertheless, there is no evidence that any nutritional supplements bear marks which include both terms together, other than Registrant's cited mark and Applicant's involved mark. In fact, Applicant's arguments to the contrary notwithstanding, its use of *both* terms together, in reverse order, with a weak prefix, makes confusion likely, even if the use of *only one* of these terms from Registrant's mark would not lead to confusion. *See generally, Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284-85 (Fed. Cir. 1984) ("Applicant introduced evidence of either third-party registrations for tea which

contain the word ‘SPICE,’ five of which are shown to be in use. None of these marks has a ‘SPICE (place)’ format or conveys a commercial impression similar to that projected by the SPICE ISLANDS mark, and these third-party registrations are of significantly greater difference from SPICE VALLEY and SPICE ISLANDS than either of these two marks from each other.”) (cited by Applicant). At most, this factor weighs only slightly against a finding of likelihood of confusion.

Applicant’s argument that confusion is unlikely because the relevant consumers exercise a “high degree of care” is not persuasive. Registrant’s identification of goods does not specify the types of purchasers therefor, and there is no evidence that all consumers of nutritional supplements necessarily exercise heightened care. While Applicant’s identification of goods specifies that its customers are engaged in endurance sports, there is also no evidence that all such athletes necessarily take extra care in purchasing dietary and nutritional supplements. We must presume that Applicant’s and Registrant’s identified goods encompass inexpensive and expensive varieties thereof, and that the goods are offered to all types of customers therefor. *See e.g., Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162-63 (Fed. Cir. 2014) (“Stone Lion effectively asks this court to disregard the broad scope of services recited in its application, and to instead rely on the parties’ current investment practices ... the Board properly considered *all* potential investors for the recited services, including ordinary consumers seeking to invest in services with no minimum investment requirement.”) (emphasis in original). In any event, even if we assume that consumers of nutritional supplements

exercise heightened care about what they ingest, it is settled that such purchasers are not immune from source confusion, especially where they are faced with similar marks used on legally identical goods. *See, In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986); *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970); *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); *see also, HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd, Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods). In the absence of actual evidence that the relevant consumers exercise a high degree of care, this factor is neutral.

The lack of actual confusion is irrelevant, because there is no evidence regarding the nature and extent of any contemporaneous use in the marketplace by Applicant and Registrant that would show that there has been an opportunity for confusion to occur if it were likely to occur. *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984).⁴ In any event, the lack of evidence of actual confusion carries little weight, especially in an *ex parte* context. *In re Majestic Distilling*, 65 USPQ2d at 1205. This factor is also neutral.

As often stated, 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

⁴ Neither Registrant's offering of its products online nor Applicant's receipt of thousands of inquiries about its products establishes the type of contemporaneous use that would present an opportunity for actual confusion.

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similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991). In this case, while we accept that the terms 360 and TEST are weak, Applicant and Registrant use their marks for legally identical goods which we presume to move in the same channels of trade. Moreover, Applicant has merely transposed the terms comprising Registrant's mark and added to them an admittedly weak prefix. As a result, confusion is likely.

Decision: The refusal to register Applicant's mark under Section 2(d) of the Act is affirmed.