

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
December 22, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Werbner

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Serial No. 87003366

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Gene Bolmarcich, Esq. for Jerry Werbner.

Charles L. Jenkins, Jr., Trademark Examining Attorney, Law Office 118
(Thomas G. Howell, Managing Attorney).

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Before Shaw, Adlin, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Jerry Werbner (“Applicant”) filed an application for registration on the Principal Register of the mark PRACTICE SAFE SIGHT in standard characters for the following goods:

Eyewear; Eyewear accessories, namely, straps, neck cords and head straps which restrain eyewear from movement on a wearer; Eyewear pouches; Eyewear, namely, sunglasses, eyeglasses and ophthalmic frames and cases therefor, Reading glasses, computer glasses, tv screen glasses, Lenses for computer glasses, Framed lenses, and Magnification lenses; Lorgnettes; Protective eyewear;

Protective eyewear and component parts thereof; Safety eyewear; Sports eyewear, in International Class 9.¹

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 used in connection with Applicant's goods, so resembles the registered mark SAFESITE in standard characters for "ophthalmic lenses" as to be likely to cause confusion, or to cause mistake, or to deceive.² When the refusal was made final, Applicant appealed. Applicant and the Examining Attorney have filed briefs.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion as set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). 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).

(a) The goods.

We first consider the similarity or dissimilarity of the goods as identified in the application and the cited registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-62 (Fed. Cir. 2014); *Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787

¹ Application Serial No. 87003366 was filed on April 16, 2016 under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), on the basis of Applicant's asserted *bona fide* intention to use the mark in commerce.

² Reg. No. 2251660, issued June 8, 1999. Section 8 affidavit accepted; Section 15 affidavit acknowledged; renewed.

(Fed. Cir. 1990). Registrant's goods are ophthalmic lenses. Applicant's goods include "lenses for computer glasses, framed lenses, and magnification lenses," which are types of ophthalmic lenses and are, therefore, legally identical goods. Applicant's argument, made during examination, that his goods are non-prescription eyewear, as opposed to the prescription lenses Registrant offers, is neither relevant nor persuasive.³ We must presume that Applicant's goods encompass all goods of the type identified, *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006), and there is nothing in Applicant's identification of goods to indicate that Applicant's lenses are not prescription lenses.

The Examining Attorney also argues that other goods identified by Applicant, namely sunglasses and eyeglasses, are commercially related to ophthalmic lenses. To prove this, he has submitted copies of the following use-based third-party registrations, all of which cover both ophthalmic lenses and sunglasses:⁴

<u>Reg. No.</u>	<u>Mark</u>	<u>Reg. No.</u>	<u>Mark</u>
0650499	RAY.BAN	2305031	RETROSPECS
4119929	H.A.N.A	3715053	MELAVISION
2641036	TOMMY BAHAMA	2745254	FATE
2721567	[design mark]	4388968	ADDISON WADE
4241456	OLP	4295107	MCCRAY
4541668	UNIQUELY YOU ... EYEWEARHAUS EXTRAORDINAIRE	4140406	SUNFISH

³ Response of June 2, 2016 at 6.

⁴ Office Action of June 27, 2016 at 8-68; Office Action of May 31, 2016 at 6-8, 19-21.

4570996	DEANT	4510507	MPF
4643642	HIPSTER	4581869	NEXT ISSUE
4737910	GARRETT LEIGHT	4715836	VINO
4984175	FOSTERPURE	4955564	UCSPA
4228204	POLAROID	3735384	KITON

Many of the registrations listed above also cover eyeglasses, which are listed among Applicant's goods.

Third-party registrations which individually cover different goods and services and are based on use in commerce may serve to suggest that the listed goods and services are of types which may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). We find these third-party registrations sufficient to establish that customers would readily believe that if offered under similar marks, Applicant's and Registrant's goods emanate from the same source.

For the reasons stated, we find that the *du Pont* factor of the similarity or dissimilarity of the goods weighs in favor of a finding of likelihood of confusion.

(b) The marks.

We next consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). Obviously, the two marks differ in appearance

and sound by virtue of the word PRACTICE in Applicant's mark. The terms SAFESITE in Registrant's mark and SAFE SIGHT in Applicant's mark are substantially similar in appearance and identical in sound. The space between the words SAFE and SIGHT in Applicant's mark does little to distinguish the marks' appearance or sound. Trademarks must be considered in light of the fallibility of memory, *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014), and this minor difference might well be overlooked or not remembered.

With respect to meaning, the term –SITE in Registrant's mark could be interpreted to mean a place or location, rather than a reference to eyesight. However, when the mark is used in the context of goods relating to eyesight, it is far more likely that customers will interpret–SITE as an alternative spelling of SIGHT.

Applicant argues that SAFE SIGHT in his mark means being safe by being “able to see well” while SAFESITE means “safety, or protection, of the eye itself.”⁵ This argument depends not upon the marks themselves, but upon Applicant's and Registrant's extraneous marketing materials, which may or may not be before consumers at a given time and in any event could change at any time. We do not agree that customers would perceive this rather subtle distinction in meaning; even if they did, the marks' similarities in appearance and sound render them more similar than dissimilar in their entireties.

Applicant's argument that PRACTICE SAFE SIGHT “utilizes a familiar grammatical structure of phrases comprising the word ‘PRACTICE SAFE’ followed

⁵ Applicant's brief, 5 TTABVUE 2.

by some activity,”⁶ such as the phrase “Practice Safe Sex,”⁷ is not persuasive. Even considered in this light, we do not perceive a substantial difference in meaning or overall commercial impression between the two marks. Both SAFE SIGHT and SAFESITE, when used in the context of goods relating to eyesight, would likely be interpreted to have the same meaning; and the addition of the word PRACTICE in Applicant’s mark merely serves to communicate an endorsement of trying to be safe. Such language of endorsement (similar to words like BUY or TRY preceding a brand name) does little to change the overall commercial impression of the rest of the mark.

Applicant contends – without evidence – that Registrant’s mark is weak and entitled to only a narrow scope of protection. Even if we assume that the mark is suggestive in the field of ophthalmic lenses, we must presume it to be a valid mark and entitled to protection. 15 U.S.C. § 1057(b). Applicant’s mark has little to distinguish it from the cited mark, and the two marks are suggestive in essentially the same way.

Overall, we find the marks, in their entirety, to be substantially similar in appearance, sound, meaning, and commercial impression. Accordingly, the *du Pont* factor of the similarity or dissimilarity of the marks weighs in favor of a finding of likelihood of confusion.

⁶ *Id.*

⁷ Response of June 2, 2016 at 5.

(c) Conclusion.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. The marks are very similar and the goods identified in the application and registration are legally identical or, at the very least, closely related as demonstrated by the Examining Attorney. We find that Applicant's mark so resembles the cited mark that confusion as to the source of Applicant's goods is likely.

Decision: The refusal under Section 2(d) is affirmed.