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Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Yang

Serial No. 87183891

Bobby Braxton of Braxton Hilton and Perrone PLLC,
for Yu Yang.

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Before Cataldo, Mermelstein and Kuczma,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Yu Yang (“Applicant”) seeks registration on the Principal Register of the mark
FURY OFF ROAD (in standard characters) for:

Tires in International Class 12.¹

The Trademark Examining Attorney refused registration of Applicant’s mark
under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), due to a likelihood of

¹ Application Serial No. 87183891 was filed on September 26, 2016, based upon Applicant’s claim of first use anywhere and first use in commerce since at least as early as May 4, 2016. “OFF ROAD” is disclaimed.

confusion with the mark GOLDEN FURY in Registration No. 2566645 registered for “tires” in International Class 12, owned by TBC Trademarks, LLC.²

When the refusal was made final, Applicant appealed and requested reconsideration. After the Request for Reconsideration was denied, the appeal was resumed. For the reasons set forth below, the refusal to register is affirmed.

I. Evidentiary Issue

Before proceeding to the merits of the refusal, we address an evidentiary matter. Applicant attached to its appeal brief copies of the same exhibits that were submitted with responses submitted during prosecution of the application. The Board discourages this practice. The appeal brief is associated with the application file, so papers that are already in the application should not, as a matter of course, be resubmitted as exhibits to the brief. *See e.g., In re Allegiance Staffing*, 115 USPQ2d 1319, 1323 (TTAB 2015); *In re Lorillard Licensing Co.*, 99 USPQ2d 1312, 1315 (TTAB 2011); *In re Thor Tech Inc.*, 85 USPQ2d 1474, 1475 n.3 (TTAB 2007) (attaching evidence from record to briefs is duplicative and is unnecessary); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 1203.01 (June 2018). Furthermore, any of the evidence submitted with Applicant’s appeal briefs that was not previously submitted during prosecution is untimely and will not be considered. See Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); TBMP §§ 1203.02(e) and 1207.01 and authorities cited therein.

² Registration No. 2566645 issued May 7, 2002; renewed.

II. Likelihood of Confusion

Our determination of likelihood of confusion under § 2(d) of the Trademark Act is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the 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 Co.*, 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 and/or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). “The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence, but may focus . . . on dispositive factors, such as the similarity of the marks and relatedness of the goods.” *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)) (internal quotation omitted).

We address these factors and any others for which Applicant or the Examining Attorney presented evidence or arguments, including the similarity of the trade channels and customers, the conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing, and the number and nature of similar marks in use on similar goods.

A. Similarity of the Goods, Channels of Trade and Classes of Customers

We first consider the *du Pont* factor involving the similarity or dissimilarity of Applicant’s goods to the goods in the cited registration. Applicant attempts to

distinguish its “off-road tires” from Registrant’s “traditional road tires”³ arguing that such goods are sufficiently different to avoid confusion. Notwithstanding Applicant’s argument and extrinsic evidence regarding the actual differences of his tires versus Registrant’s tires, we may not limit by resort to such evidence the scope of goods in the subject application or in the cited registration. It is the identification of goods that controls, not what extrinsic evidence may show about the specific nature of the goods. *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *In re Midwest Gaming & Entm’t LLC*, 106 USPQ2d 1163, 1165 (TTAB 2013) (quoting *In re La Peregrina Ltd.*, 86 USPQ2d 1645 at 1647 (TTAB 2008)); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764-65 (TTAB 1986). Inasmuch as Registrant’s “tires” are the same as the goods recited in Applicant’s application, the goods are identical.

Absent any restrictions in an application or registration, identical goods are presumed to travel in the same channels of trade to the same class of customers. *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); *see also In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Am. Cruise Lines, Inc.*, 128 USPQ2d 1157, 1158 (TTAB 2018).

Accordingly, the *du Pont* factors regarding the similarity of the goods as well as the trade channels and customers, strongly favor a finding of likelihood of confusion.

³ Applicant’s Appeal Brief pp. 2, 7 (7 TTABVUE 3, 8).

B. Buyers to Whom Sales Are Made

Next we consider the conditions under which the goods are likely to be purchased, e.g., whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers. Purchaser sophistication or degree of care may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005)).

Applicant contends that the relevant uses of Applicant's goods and Registrant's goods are different, and the target consumers for the goods are different. Thus, the purchasers of Applicant's and Registrant's tires are unlikely to be confused as to the source of the goods they are purchasing. In support, Applicant cites to an article reporting that consumers of tires are spending a significant amount of time researching and studying tires from which Applicant concludes that "[t]his negates a finding of a likelihood of confusion because the purchasers are sophisticated."⁴ Applicant further notes that the article states: "[t]he habits of online tire buyers have matured. The average buyer is doing more research and considering more dealers and brands" and that "[a]nother significant trend important to consumers is the desire for recommendations based on vehicle type," arguing that such statements

⁴ Applicant's Appeal Brief at p. 10 (7 TTABVUE 11); Request for Reconsideration at TSDR 10, 23-24. The article titled "Tire Buyers Spending Significantly More Time Researching and Purchasing Tires Online" says "[w]hat may be surprising to many tire dealers is the increasing sophistication of the consumer and the importance for high-quality, visual information on tire websites."

serve as proof that tire purchasers are sophisticated and that they understand the differences between Registrant's road tires and Applicant's off road tires.

Regardless of whether consumers of tires are doing more research and considering more dealers and brands, and desire recommendations based on vehicle type, the goods identified in the subject application and in the cited registration are identical. Nor are either Applicant's or Registrant's customers limited to the "online tire buyers" who are alleged to be sophisticated. Again, Applicant's and Registrant's identification of "tires" must be construed to include tires of all kinds, sold in all channels of trade normal for such goods, and to all usual purchasers of them.⁵

Additionally, even assuming purchasers of Applicant's and Registrant's products are sophisticated and knowledgeable about the goods does not necessarily mean that they are knowledgeable in the field of trademarks or immune to source confusion arising from the use of similar marks, on identical goods. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); *In re Integrated Embedded*, 120

⁵ Additionally, Applicant's own website supports the relatedness of Applicant's and Registrant's tires. Applicant's mission statement on its website says:

OUR MISSION

FURY OFF-Road Tires and Wheels was created to provide the off-road competitor, enthusiast and everyday driver with the highest quality of products and services to fulfill their every need.

Thus, Applicant markets its products as providing the "off-road competitor" as well as the "everyday driver" with high quality products and services "to fulfill their every need." Exhibit 2 to Request for Reconsideration, <<https://furyoffroadtires.com/>> at TSDR 19.

USPQ2d 1504, 1516 (TTAB 2016); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009).

The class of potential purchasers for Applicant's and Registrant's "tires" is particularly broad, including those who own automobiles or other vehicles with tires that need to be replaced periodically due to wear or other damage. *Cf. Fuji Jyukogyo KK v. Toyota Jidosha KK*, 228 USPQ 672, 675-76 (TTAB 1985) (purchasers of automobiles include unsophisticated individuals). While some consumers may be "adept at researching and vetting a correct tire," as a result of "spending significant amount of time research and studying tires,"⁶ the ordinary nature of "tires" identified in the subject application and cited registration, and Applicant's reliance on a single article on the Internet purporting to support the degree of care with which such purchases are made, is not enough for us to find that the consumers of Applicant's goods or Registrant's goods are necessarily sophisticated. *See Stone Lion Capital Partners*, 110 USPQ2d at 1163 (Board assesses likelihood of confusion from the perspective of the least sophisticated consumers of the goods). Thus, the sophistication of purchasers is a neutral factor in our likelihood of confusion determination.

C. Similarity of the Marks

We now turn to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, meaning and commercial

⁶ Applicant's Appeal Brief p. 10 (7 TTABVue 11).

impression. *Viterra*, 101 USPQ2d at 1908 (quoting *du Pont*, 177 USPQ at 567). Where the goods of applicant and registrant are identical, as they are in this case, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with diverse goods. *Viterra*, 101 USPQ2d at 1908; *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently 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. *Coach Servs. v. Triumph Learning*, 101 USPQ2d at 1721; *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Bay State Brewing*, 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)); *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015) (citing *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013)).

Applicant contends that purchasers would not confuse the two marks due to the placement of “fury” in a different order in the marks. The issue is not whether the people will confuse the marks, but whether — taking account of the identity of the goods and other factors — the marks will confuse the people into believing that the

goods come from or are associated with the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (CCPA 1972). Under the first *du Pont* factor, we therefore consider whether and to what degree the marks are similar, not whether the marks themselves would cause confusion.

Looking at the marks in their entirety, we find that Applicant's mark FURY OFF ROAD and the cited registered mark GOLDEN FURY are similar in sound, appearance and commercial impression, inasmuch as they both contain the identical dominant term "fury." The inclusion of the descriptive words "OFF ROAD" in Applicant's proposed mark does not create a strong enough impression to distinguish the source of Applicant's goods. While the public is unaware that Applicant has disclaimed the words "OFF ROAD" in his mark, due to the descriptiveness of this wording in relation to a characteristic of tires, "OFF ROAD" has less impact on the commercial impression formed by Applicant's applied-for mark where "FURY" is the first word and forms the dominant impression.⁷ See *In re Viterra*, 101 USPQ2d at 1908 (the court may place more weight on a dominant portion of a mark, for example if another feature of the mark is descriptive or generic standing alone, however, the

⁷ In support of the descriptiveness of "OFF ROAD," the Examining Attorney submitted evidence of 15 active third-party registrations for similar automotive goods where the term "OFF ROAD" or "OFFROAD" in the marks was disclaimed, registered under § 2(f), or registered on the Supplemental Register. These third party registrations support how the term "OFF ROAD" is used in ordinary parlance and show that it has descriptive significance as applied to the automotive goods including wheels, tires and off road vehicle parts identified in the registrations. *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016) (quoting *Inst. Nat'l des Appellations D'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, USPQ2d 1190, 1196 (Fed. Cir. 1992)); *In re Box Sols. Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006). Registration No. 5160007 is registered for trailers which are not similar to the goods of Applicant and Registrant, and thus has far less probative value.

ultimate conclusion nonetheless must rest on consideration of the marks in total); *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (“DELTA,” not the disclaimed generic term “CAFE,” is the dominant portion of the mark THE DELTA CAFE); *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (“[T]here 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.”).

Turning to Registrant’s GOLDEN FURY mark, “golden” serves as an adjective that modifies or describes “fury.” Despite the fact that Applicant’s proposed mark begins with the dominant word “FURY” and Registrant’s mark is GOLDEN FURY, where the dominant portion of its mark is presented as the second word in the mark, the overall commercial impression of both marks, which each contain the dominant word “fury,” are similar. Given the identity of Applicant’s and Registrant’s goods in their respective application and Registration, the word “fury” as used in each mark yields a similar commercial impression.

Considered in their entirety, we find Applicant’s mark similar to that in the cited registration. This factor supports a finding of likelihood of confusion.

D. Number and Nature of Similar Marks in Use on Similar Goods

Under the sixth *du Pont* factor, “extensive evidence of third-party use and registrations is ‘powerful on its face,’ even where the specific extent and impact of the usage has not been established.” *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) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)). Here, however, Applicant submits a list including 4 active third-party registrations for “FURY” marks for goods in Class 12, in addition to Registrant’s registration for GOLDEN FURY, in support of its argument that such wording is weak, diluted or so widely used that it should not be afforded a broad scope of protection.⁸ The weakness or dilution of a mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods and/or services. *See Nat’l Cable Television Ass’n Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424,

⁸ Applicant did not submit copies of the third-party registrations. Instead, Applicant submitted a listing that appears to be results provided in a TESS search, i.e., listing Serial Number, Registration Number, Word Mark, Check Status and Live/Dead status. While the August 7, 2017 Final Office Action incorrectly states that “Applicant has submitted printed or electronic copies of third-party registrations for marks containing the wording FURY,” in the March 22, 2018 Request for Reconsideration Denied the Examining Attorney correctly advised Applicant that in order to make third-party registrations of record, Applicant must submit copies of the registrations or the complete electronic equivalent from the USPTO’s automated systems prior to appeal. *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2064 (TTAB 2013); TBMP § 1208.02; TMEP § 710.03. Applicant did not submit copies of the registrations. Because the Examining Attorney discusses the registrations cited by Applicant in the Final Office Action and in the brief without objection (at 9 TTABVUE 6-8), the registrations are treated as stipulated into the record. However, the Board will not consider more than the information provided by Applicant. Because Applicant provided a listing of limited information regarding the registrations and marks, the listing has limited probative value. *In re 1st USA Realty Prof’ls Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007) (Board treated listing of particulars of third-party applications/registrations submitted by applicant as stipulated into record only to the extent that the specific data provided by applicant was considered).

Additionally, the cancelled registrations and third-party applications shown on the listing submitted by Applicant possess little, if any, probative value. Cancelled registrations are evidence only that the registrations issued, while pending applications are evidence only that they were filed; they are not evidence of use of the marks. Neither is evidence that the subject marks are or were valid trademarks or ever in use. *See, e.g., In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1745 (TTAB 2018); *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1606 (TTAB 2018).

1430 (Fed. Cir. 1991); *du Pont*, 177 USPQ at 567. Not only is there no evidence of what goods in Class 12 are covered by the 4 cited registrations, there is no evidence showing use of those registered marks. These few third-party registrations for marks containing the word FURY have little probative value under the sixth *du Pont* factor, especially in the absence of evidence that the marks are in use on a commercial scale or that the public has become familiar with them. See *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016). See also *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the USPTO); *In re Hub Distrib., Inc.*, 218 USPQ 284, 285 (TTAB 1983) (“[T]hird party registrations in this Office, absent evidence of actual use of the marks [that are the] subject[s] of the third-party registrations, ... are entitled to little weight on the question of likelihood of confusion.”).

Additionally, prior decisions and actions of other examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. *In re Midwest Gaming & Entm’t*, 106 USPQ2d at 1165 n.3 (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). It has been noted many times that each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009).

The few third-party registrations cited by Applicant do not impact the meaning of Applicant’s mark or the cited mark, nor do they support a finding that the cited mark

is weak or otherwise entitled to a narrow scope of protection. Thus, the third-party registration evidence is neutral.

III. Conclusion

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. We keep in mind that “[w]hen marks would appear on virtually identical goods . . . , as is the case here, the degree of similarity necessary to support a conclusion of likely confusion declines.” *In re Morinaga Nyugyo*, 120 USPQ2d at 1740-41; *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010) (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992)).

Given that Applicant’s goods and the goods in the cited Registration are identical and are therefore presumed to travel through the same channels of trade to the same classes of customers, the differences between the marks are insufficient to avoid a likelihood of confusion. Both marks feature “FURY” as the dominant portion, rendering the marks in their entireties more similar than dissimilar in appearance, sound and commercial impression. We therefore find that confusion is likely.

Decision: The refusal to register Applicant’s mark FURY OFF ROAD under § 2(d) of the Trademark Act is affirmed.