

This Opinion is Not a
Precedent of the TTAB

Mailed: October 31, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Don't Run Out, Inc.
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Serial No. 87344127
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Peter S. Sloane, Deirdre A. Clarke, and Chelsea Russel of Leason Ellis LLP,
for Don't Run Out, Inc.

Valerie Kaplan, Trademark Examining Attorney, Law Office 107
J. Leslie Bishop, Managing Attorney.

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Before Mermelstein, Lykos and Greenbaum,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Don't Run Out, Inc. ("Applicant") seeks registration on the Principal Register of
the mark PUBLIC GOODS (GOODS disclaimed) in standard characters for:

"Bar soap; deodorant for personal use; facial washes; hair
conditioner; shampoos; shaving creams; skin moisturizer;
tooth paste; toothpastes; face, body, and hand
moisturizers" in International Class 3;

"Toilet paper" in International Class 16; and

“Tooth brushes” in International Class 21.¹

Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s applied-for mark so resembles the registered marks below, all owned by the same entity, that when used on or in connection with Applicant’s identified goods, it is likely to cause confusion or mistake or to deceive.²

Registration No. 1382948 for the mark PUBLIX (typed)³ for “hair shampoo, denture cleanser, nail polish remover” in International Class 3.⁴

Registration No. 3688906 for the composite mark displayed below for “bath soap” in International Class 3.⁵

¹ Application Serial No. 87344127, filed February 21, 2017, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). On May 14, 2018, Applicant filed an amendment to allege use and amended the filing basis to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). The mark appears on the drawing page as “Public Goods” but this does not change the nature of the mark from a standard character mark to a special form mark. *See In re Calphalon Corp.*, 122 USPQ2d 1153 n.1 (TTAB 2017) (citing *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059 n.1 (TTAB 2013)). Our reference to the mark in all uppercase letters reflects the fact that a term registered as a mark in “standard character” form is not limited to any particular font style, size, or color.

Citations to the prosecution file refer to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system and identify documents by title and date. Specific citations are to the page number in the .pdf version of the TSDR records. References to the briefs and other materials in the appeal record refer to the Board’s TTABVUE docket system.

² The Section 2(d) refusal did not apply to the International Class 8 goods “razors and razor blades” which were subsequently divided into a “child” application.

³ Prior to November 2, 2003, standard character marks were known as typed marks. A typed mark is the legal equivalent of a standard character mark. TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 807.03(i) (Oct. 2018).

⁴ Registered February 18, 1986; renewed.

⁵ Registered September 29, 2009; renewed. The description of the mark is as follows: “The mark consists of a vertical rectangle, with a circle overlapping the rectangle and extending halfway into the rectangle. The circle contains the word ‘PUBLIX’, centered horizontally in the circle.” Color is not claimed as a feature of the mark.



The remaining three cited registrations are for the same composite mark below:⁶



Registration No. 3717922 for “laundry bleach, laundry detergent, fabric softeners, anti-static dryer sheets, dishwashing detergents, hand and bath soaps, liquid soaps for hands and bodies, sunscreen lotion, hand lotion, denture cleansers, shampoo, cosmetic pads, cotton balls for cosmetic purposes, cotton swabs for cosmetic purposes, baby powder, petroleum jelly for cosmetic purposes, pre-moistened cosmetic wipes, mouthwash, nail polish remover, drain openers, glass cleaners, all-purpose cleaners” in International Class 3.⁷

Registration No. 3334340 for “plastic trash bags; paper towels; toilet paper; paper napkins; and facial tissues” in International Class 16.⁸

Registration No. 3789338 for “dental floss; disposable gloves for home use; pre-moistened towelettes for household cleaning; household utensils, namely, graters, serving forks, serving spoons, ladles, spatulas, turners,

⁶ The description of the mark is as follows: “The mark consists of a horizontal rectangle, with a circle overlapping the rectangle and extending halfway into the rectangle. The circle contains the word ‘PUBLIX’, centered horizontally in the circle.” Color is not claimed as a feature of the mark.

⁷ Registered December 1, 2009; renewed.

⁸ Registered November 13, 2007; renewed.

scoops, strainers and non-electric hand mixers”
International Class 21.⁹

When the refusal was made final, Applicant appealed and requested reconsideration. After the Trademark Examining Attorney denied the Request for Reconsideration, the appeal was resumed and is now briefed.

For the reasons set forth below, we reverse.

I. Likelihood of Confusion - Applicable Law

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *du Pont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). When analyzing these factors, the overriding concern is not only to prevent buyer confusion as to the source of the goods, but also to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc.*

⁹ Registered May 18, 2010; renewed.

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.”). Varying weights may be assigned to each *du Pont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 26 USPQ2d at 1688 (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”). These factors, and the other relevant *du Pont* factors, are discussed below.

A. The Goods and Established, Likely-to-Continue Channels of Trade

Insofar as the Examining Attorney’s refusal applies to all three classes of goods, we shall consider the second and third *du Pont* factors as applied to each individual class.

In comparing the goods as they are identified in the application and the cited registrations, *see Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014), it is undisputed, and Applicant effectively concedes,¹⁰ that two of the three classes involve identical goods and the remaining class involves highly related, complementary items. The application and cited Registration Nos. 1382948 and 3717922 include “shampoo” in International Class 3 or the legal equivalent thereof;¹¹ the application and cited Registration No. 3334340

¹⁰ In its appeal brief, Applicant presented no arguments regarding the second and third *du Pont* factors.

¹¹ “Shampoo” encompasses all types of shampoos, including “hair shampoo.”

include “toilet paper” in International Class 16. Thus, on their face, Applicant’s and Registrant’s goods are in-part identical for these two classes. Because the International Class 3 and 16 goods are in-part identical and unrestricted as to trade channels, we must also presume that these particular goods travel in the same ordinary trade and distribution channels and will be marketed to the same potential consumers. *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); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011). Thus, the second and third *du Pont* factors favor a likelihood of confusion with respect to Applicant’s International Class 3 and 16 goods.

With regard to Applicant’s International Class 21 “toothbrushes,” it is well established that the goods need not be identical or even competitive to find a likelihood of confusion, *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000), but need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

Applicant's "toothbrushes" in International Class 21 and Registrant's "dental floss" in cited Registration No. 3789338 are complementary items used together by consumers as part of their daily oral care routine. In addition, the Examining Attorney has submitted evidence demonstrating that it is common for these goods to be sold under the same mark (e.g., Oral-B, Colgate, Reach, and Plackers) by entities manufacturing both sets of goods. *See* August 26, 2017 Office Action, pp. 2-16 and March 30, 2018 Office Action pp. 17-28. Accordingly, these goods are also commercially related.

Because the Applicant's International Class 21 goods and the goods identified in cited Registration No. 3789338 have no restrictions on channels of trade, we must presume that they travel in all channels of trade appropriate for such goods, which the record shows include direct business-to-consumer ("B2C") manufacturer operated web sites. *See In re Viterra*, 101 USPQ2d at 1908 (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 62 USPQ2d at 1005). In addition, from common knowledge we know that both parties' goods may be encountered by the same prospective consumers shopping for these items in brick-and-mortar retail outlets such as drugstores and grocery stores. *See Hyde Park Footwear Co. v. Hampshire Designers, Inc.*, 197 USPQ 639, 641-42 (TTAB 1977) ("some of these facts will be self-evident, a matter of common knowledge or matters to be presumed from the identifications of goods"). As

such, both the second and third *du Pont* factors for Applicant's International Class 21 goods also favor a finding of likelihood of confusion.

B. The Marks

We now direct our attention to “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. 2005) (quoting *du Pont*, 177 USPQ at 567). Because we have found that the goods in cited Registration Nos. 1382948, 3334340, 3717922, and 3789338 are either in-part identical or related, we compare Applicant's standard character mark PUBLIC GOODS to Registrant's typed mark PUBLIX and composite



mark It is well-settled that where the goods are identical in part, as is the case here with two of the three classes of goods, less similarity between the marks is needed for us to find a likelihood of confusion. *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (“When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.”). That being said, a single *du Pont* factor may be dispositive, and when we compare the marks, we

find that to be the case here. *See Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991).

The Examining Attorney, relying on the proposition that similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar, contends that PUBLIX in the cited marks is identical in sound to the PUBLIC portion of Applicant's mark. As she asserts, PUBLIX is merely the plural version of PUBLIC. *See, e.g., Swiss Grill Ltd., v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2011 n.17 (TTAB 2015) (holding "it is obvious that the virtually identical marks [the singular and plural of SWISS GRILL] are confusingly similar"); *Weider Publ'ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1355 (TTAB 2014) (finding the singular and plural forms of SHAPE to be essentially the same mark) (citing *Wilson v. Delaunay*, 245 F.2d 877, 878, 114 USPQ 339, 341 (CCPA 1957) (finding no material difference between the singular and plural forms of ZOMBIE such that the marks were considered the same mark). The Examining Attorney also invokes the principle that there is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. *See Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1835 (TTAB 2013) (quoting *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012)); *In re Belgrade Shoe Co.*, 411 F.2d 1352, 162 USPQ 227, 227 (CCPA 1969)). Finding that the word PUBLIC is the dominant portion of the applied-for mark since it is the first element and the remaining wording, GOODS, is disclaimed, the Examining Attorney focuses on PUBLIC as being similar to the term PUBLIX.

Applicant counters that the Examining Attorney has improperly dissected the marks. Applicant argues that when considered as a whole, the marks project different connotations and commercial impressions -- PUBLIX is a coined term with no recognized meaning whereas the addition of the word GOODS to the applied-for mark PUBLIC GOODS conveys a meaning of societal benefit.

We find critical the distinctions between the marks in connotation and commercial impression. In making our determination, we are guided by the principle that “[t]he 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). *See also Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797 (Fed. Cir. 2018); *Midwestern Pet Foods, Inc., v. Societe Des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). The record shows the following Google search results for the term “public good:”

Google dictionary: A commodity or service that is provided without profit to all members of society, either by the government or a private individual or organization.

WIKIPEDIA: In economics, a public good is a good that is both non-excludable and non-rivalrous in that individuals cannot be effectively excluded from use and where use by one individual does not reduce availability to others.

INVESTOPEDIA: A product that one individual can consume without reducing its availability to another individual and from which no one is excluded. Economists refer to public goods as “non-rivalrous” and “non-excludable.”

February 26, 2018 Response to Office Action, pp. 29-30. *Compare In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1715 (TTAB 2011) (search engine results submitted by examining attorney not considered because they did not provide sufficient context to have any probative value). The record further shows Applicant's mission is to "[m]ake healthy products affordable to all" by changing the conventional supply chain to avoid price mark-ups. *Id.* at 31 (excerpt from www.publicgoods.com). Thus the words PUBLIC GOODS taken together project the connotation and commercial impression that Applicant's personal care products are available to all consumers due to their affordability, and beneficial to the public because they are environmentally safe. By contrast, Registrant's typed mark PUBLIX and the composite mark incorporating this term have no well-recognized meaning. As a result, when confronted with both marks, prospective consumers are unlikely to assume that Applicant's and Registrant's respective goods originate from the same source, despite use in part on identical and highly related goods.

II. Conclusion – Balancing the *du Pont* Factors

Any of the *du Pont* factors may play a dominant role. *du Pont*, 177 USPQ at 567. In fact, in some cases, a single factor may be dispositive, "especially when that single factor is the dissimilarity of the marks." *See Oakville Hills Cedar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 119 USPQ2d 1286, 1290 (Fed. Cir. 2016). *See also Odom's Tenn. Pride Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 93 USPQ2d 2030, 2032 (Fed. Cir. 2010). In the present *ex parte* appeal, the record evidence shows that the dissimilarity of the marks in meaning and commercial impression are so

great as to outweigh the other *du Pont* factors, discussed above. For that reason, we find the first *du Pont* factor to be pivotal, and the Trademark Examining Attorney's Section 2(d) refusal is reversed.

Decision: The Section 2(d) refusal to register Applicant's mark is reversed as to all three classes of goods.

Mermelstein, Administrative Trademark Judge, dissenting:

While I agree with much of the majority's findings, I respectfully dissent from the conclusion that confusion is not likely.

As my colleagues correctly find, all three classes of Applicant's goods include goods identical or closely related to goods set out in the cited registrations, and that those goods travel in the same channels of trade to the same purchasers. I would add that the goods at issue — shampoo, toilet paper, and toothbrushes — are common, inexpensive items purchased by virtually all adults without extensive investigation. While “[p]urchaser sophistication may tend to minimize likelihood of confusion, 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's mark is PUBLIC GOODS. I agree that this phrase appears to have a particular meaning in the field of economics¹ as a product which is "non-rivalrous" and "non-excludable." But the meaning of a mark must be determined in light of the goods on which it appears, and from the perspective of the relevant purchaser, not in the abstract. It is far from clear that purchasers of Applicant's goods — even those purchasers who may be aware of the economics definition of PUBLIC GOODS — would ascribe that meaning to the mark when it is encountered on shampoo, toilet paper, and toothbrushes. I believe it more likely that relevant purchasers would consider Applicant's mark to simply refer to goods available to the public.

The mark in the cited registrations is the word PUBLIX, both as a typed mark and in composite word-and-design marks. While PUBLIX is not a properly spelled word, I cannot agree with Applicant's contention that PUBLIX is a coined term with no recognized meaning. PUBLIX is a homophone and an obvious misspelling of the plural or possessive of PUBLIC. *Elizabeth Arden Sales Corp. v. Faberge, Inc.*, 304 F.2d 891, 134 USPQ 186, 187 (CCPA 1962) ("it seems to us that the words Extraordinaire and Extrordinaire are the same for all practical purposes and that they are used by both parties to suggest an asserted quality of the product upon which the marks are used"). Although not orthographically correct, a final letter "x" can be used to form the plural of a word ending in "c" or "k." See *Flow Tech. Inc. v. Picciano*, 18 USPQ2d 1970, 1972 (TTAB 1991) ("Opposer's mark is spelled with a final letter

¹ I note that Applicant disclaimed the term GOODS apart from the mark as shown. The disclaimer is inconsistent with the argument that PUBLIC GOODS has a particular meaning as a phrase.

“k.” Applicant’s is spelled with a final letter “x” which causes applicant’s mark to sound like the plural of opposer’s, OMNITRAK and OMNITRAX.”). I conclude that the word PUBLIX in Registrant’s mark looks and sounds similar to the word PUBLIC in Applicant’s mark, and would be perceived as a plural or possessive of it. “While each trademark must always be evaluated individually, pluralization commonly does not alter the meaning of a mark.” *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1637 (Fed. Cir. 2016).

Of course, Applicant’s mark is not PUBLIC, but the phrase PUBLIC GOODS. The addition of the word GOODS somewhat distinguishes Applicant’s mark from Registrant’s in appearance and sound. Nonetheless, I assign the term GOODS relatively little weight in my analysis. First, the term is disclaimed, no doubt because it is descriptive of Applicant’s goods. While a disclaimer does not remove matter from a mark, and we must consider the marks in their entirety, the “descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.” *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)). Second, GOODS is the last word in Applicant’s mark, while PUBLIC is first. “[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered. . . .” *Presto Prods., Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers must first notice the identical lead word).

Likewise, four of the cited registrations include design elements not present in Applicant's mark. Again, while these elements provide some visual distinction between the marks, the design elements at issue here are entitled to little weight. In each case, the design consists of a rectangular bar intersecting with a circle which contains the minimally stylized word PUBLIX. Background designs and carriers in simple geometric shapes typically possess little distinctiveness, and are rarely sufficient to distinguish otherwise similar marks. *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) ("Neither the design element nor the generic term "cafe" offers sufficient distinctiveness to create a different commercial impression. Indeed, as the board found, the design is an ordinary geometric shape that serves as a background for the word mark."). Such is the case here. The design elements in Registrant's marks are simple geometric shapes and do little to distinguish the marks. Finally, I note that where a mark comprises both words and a design, "the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed." *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (cleaned up).

Considering the marks in their entireties, I find that Applicant's mark PUBLIC GOODS is substantially similar to the Registrant's PUBLIX marks. While the marks are not identical, they are sufficiently similar given the identical and closely related goods at issue. "When trademarks would appear on substantially identical goods, the degree of similarity necessary to support a conclusion of likely confusion declines." *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722

(Fed. Cir. 2012) (cleaned up); *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018), *cert. denied*, 139 S. Ct. 1550 (Apr. 15, 2019).

I would accordingly affirm the refusal to register on the ground of likelihood of confusion, and I respectfully dissent from the majority's contrary conclusion.