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Precedent of the TTAB

Mailed: May 3, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Denver Mattress Co., LLC

Serial No. 87369490

David E. Sipiora and Brian P. O'Donnell of Kilpatrick Townsend & Stockton LLP,
for Denver Mattress Co., LLC

David I, Trademark Examining Attorney, Law Office 114,
Laurie Kaufman, Managing Attorney.

Before Mermelstein, Kuczma, and Heasley,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Denver Mattress Co., LLC (“Applicant”) seeks registration on the Principal Register of the mark NU DOWN (in standard characters, with “DOWN” disclaimed) for “pillows made in whole or substantial part of synthetic down or down alternatives,” in International Class 20, and “bed blankets; bed sheets; bed skirts; bed spreads; blanket throws; comforters; coverlets; duvet covers; duvets; mattress

pads; pillow shams; bed blankets; lap blankets; all of the foregoing made in whole or substantial part of synthetic down or down alternatives,” in International Class 24.¹

The Trademark Examining Attorney has refused registration of the applied-for mark under Section 2(a) of the Trademark Act on the ground that it “consists of or comprises ... deceptive ... matter” when used in connection with the identified goods, 15 U.S.C. § 1052(a), and under Section 2(d), 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with the registered mark NU PERCALE (in standard characters, with “PERCALE” disclaimed) for “bed linen; bed sheets; bedsheets; contour sheets; fitted bed sheets; flat bed sheets; pillow cases; pillowcases; sheet sets; all of the foregoing comprised in whole or significant part of percale fabric” in International Class 24.²

When the refusals were made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal resumed. We affirm the refusals to register.

I. Deceptiveness

Section 2(a) of the Lanham Act bars registration of a mark that consists of or comprises deceptive matter. *In re Calif. Innovations, Inc.*, 329 F.3d 1334, 66 USPQ2d

¹ Application Serial No. 87369490 was filed on March 13, 2017, based on Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

Page references to the application record are to the downloadable .pdf version of the USPTO’s Trademark Status & Document Retrieval (TSDR) system. References to the briefs, motions and orders on appeal are to the Board’s TTABVUE docket system.

² Registration No.4979832, issued on the Principal Register on June 14, 2016. The English translation of the word “NU” in the mark is “naked.”

1853, 1854 (Fed. Cir. 2003); *In re Budge Mfg. Co.*, 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988). A deceptive mark cannot be registered on the Principal or Supplemental Register, and neither acquired distinctiveness nor a disclaimer of the deceptive matter can make it registrable. *In re White Jasmine LLC*, 106 USPQ2d 1385, 1391 (TTAB 2013). This absolute bar to registration is designed to protect consumers from “deception that comes from trademarks themselves when they falsely suggest characteristics of goods or services.” See A. LaLonde, “You Aren’t Going to Believe This! Deception, Misdescription and Materiality in Trademark Law” 102 TRADEMARK REPORTER 883, 886, 901 (May-June 2012).

The Examining Attorney has the initial burden of putting forth a *prima facie* case that a trademark falls within the prohibition of Section 2(a). *In re Budge*, 8 USPQ2d at 1260; *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1592 (TTAB 2018). If he meets that burden, then Applicant may come forward with rebuttal evidence in an effort to overcome any or all of the elements of the Section 2(a) test for deceptiveness. See *In re E5 LLC*, 103 USPQ2d 1578, 1584 (TTAB 2012). Under that test, a proposed mark consists of or comprises deceptive matter if: (1) it consists of or comprises³ a term that misdescribes the character, quality, function, composition, or use of the goods; (2) prospective purchasers are likely to believe that the misdescription actually describes the goods; and (3) the misdescription is likely to affect the purchasing decision of a significant or substantial portion of relevant

³ In Section 2(a), “comprises” means “includes.” *In re Fox*, 702 F.3d 633, 105 USPQ2d 1247, 1250 (Fed. Cir. 2012).

consumers. *In re Budge*, 8 USPQ2d at 1260; *see also In re Spirits Int'l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1493, 1495 (Fed. Cir. 2009);⁴ *In re Tapco Int'l Corp.*, 122 USPQ2d 1369, 1371 (TTAB 2017).

We examine the three parts of the test in turn.

A. Whether NU DOWN consists of or contains a term that misdescribes the composition of the goods

“As the starting point for our analysis, we note that for a term to misdescribe goods, the term must be merely descriptive of a significant aspect of the goods which the goods could plausibly possess but in fact do not.” *In re White Jasmine*, 106 USPQ2d at 1392 (citing *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1051 (TTAB 2002)). “Deceptive marks may include marks that falsely describe the material content of a product (*see In re Intex Plastics Corp.*, 215 USPQ 1045, 1048 (TTAB 1982))....” TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1203.02(a) (Oct. 2018).

Here, the Examining Attorney contends that the applied-for mark includes the word “DOWN,” indicating that the identified goods—pillows and bedding, such as comforters, duvet covers, and mattress pads—have a filling made wholly or substantially of down.⁵ “Down” is defined as “[f]ine, soft, fluffy feathers forming the

⁴ *In re Spirits Int'l* uses the terms “significant” and “substantial” interchangeably, holding that “the appropriate inquiry for materiality purposes is whether a substantial portion of the relevant consumers is likely to be deceived...,” requiring that “a significant portion of the relevant consuming public be deceived,” and stating that “[i]n this case, as in every case, in order to establish a prima facie case of materiality there must be some indication that a substantial portion of the relevant consumers would be materially influenced in the decision to purchase the product or service....” 90 USPQ2d at 1493, 1495.

⁵ Examining Attorney’s brief, 14 TTABVUE 5-6.

first plumage of a young bird and underlying the contour feathers in certain adult birds.”⁶ “In a nutshell, down is the layer of delicate feathers or undercoat that lies under the sturdier exterior feathers. It’s made of the fluffy filaments whose purpose is to trap air and keep the bird[]s warm.”⁷ Down is used as a filling in, for example, “goose down pillows.”⁸ According to one source, “[a] real down pillow contains down only—no feathers. Frequently ‘down’ is sold as a combination of down and feather fill.”⁹ Another source describes down comforters: “Like a duvet, a comforter is a filled bed covering. These comforters are stuffed with down feathers.”¹⁰

The application identifies the goods, however, as “made in whole or substantial part of **synthetic** down or down **alternatives**.” (Emphasis added.) Synthetic down, invented in the mid-1970s, is a fibrous body or material simulating bird down in its physical and functional aspects.¹¹ Because Applicant’s identified goods are filled with “synthetic down or down alternatives,” the Examining Attorney maintains, the word “DOWN” in the applied-for mark misdescribes them, as they are not filled with the fine, soft, fluffy bird feathers that constitute “down.”

⁶ AMERICAN HERITAGE DICTIONARY (5th ed. 2018), AHDictionary.com 7/6/2018, July 10, 2018 Response to Office Action at 70.

⁷ Survival-Mastery.com 7/6/2018 July 10, 2018 Response to Office Action at 101.

⁸ Merriam-Webster.com/dictionary/down 6/21/2017, June 21, 2017 Office Action at 46-47.

⁹ HulloPillow.com 6/21/2017, June 21, 2017 Office Action at 8-9.

¹⁰ Overstock.com 1/10/2018, Jan. 10, 2018 Office Action at 10.

¹¹ Applicant’s brief, 12 TTABVUE 12-13; Abstract in Patent No. 3,892,909 July 10, 2018 Response to Office Action at 153-183.

Applicant does not deny that DOWN is descriptive. It has, in fact, disclaimed that term, thereby conceding its descriptiveness. *See Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1375 (Fed. Cir. 2018); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2014 (TTAB 1988).

It insists, however, that the term, taken as part of its mark, is not **mis**descriptive of its goods. Definitionally, it argues, “down” can mean “something soft and fluffy like down,” as in “a trace of down on his cheeks,”¹² or “a soft, silky, or feathery substance, such as the first growth of a human beard.”¹³ Commercially, it argues, “down” can “mean either natural down, synthetic down, or a blend of both, given the nearly 30 years that home furnishing products containing natural and/or synthetic down have been marketed and sold together in the same prominent trade channels.”¹⁴ More significantly, it argues, its mark is not “DOWN” but “NU DOWN,”¹⁵ and DOWN-formative marks must be considered in their entirety.

Specifically, Applicant contends:

DOWN-formative marks that do not change or lessen the meaning of “DOWN” as natural down are unregistrable.

See In re Perry Textiles, 2016 WL 3566123 (TTAB June 8, 2016) (WONDER DOWN & Swan Design for down alternative pillows and mattress toppers deceptive because WONDER simply implies that applicant’s “DOWN” has “unexpected or superior properties” and the

¹² Merriam-Webster.com 6/21/2017, June 21, 2017 Office Action July 10, 2018 Response to Office Action at 47.

¹³ AMERICAN HERITAGE DICTIONARY, AHDictionary.com 7/6/2018, at 70; Applicant’s brief, 12 TTABVUE 11, 14.

¹⁴ Applicant’s brief, 12 TTABVUE 12-14; *see also* Applicant’s reply brief, 15 TTABVUE 6-8.

¹⁵ Applicant’s brief, 12 TTABVUE 15.

“image of a waterfowl” promotes the notion that “DOWN” is a reference to down feathers “because it is known that such birds are a source”);

see also In re Fisi Fibre Sintetiche S.p.A., 2007 WL 4287241 (TTAB Nov. 27, 2007) (ECODOWN for pillows that do not contain down feathers deceptive because prefix ECO does not detract from meaning of “DOWN” as “fine soft fluffy feathers” or serve to indicate goods do not include down so defined and qualities of natural down pillows are attractive to consumers and thus materially affect the purchasing decision).¹⁶

By contrast, DOWN-formative marks sought to be registered in connection with goods that contain down alternatives that do change the meaning of “DOWN” to mean or suggest something other than natural down or down feathers are registerable.

See, e.g., Reg. No. 4932908 for DOWNALTERNA for “pillows” and “bed blankets; comforters” (Applicant overcame deceptiveness refusal because ALTERNA component clearly connoted “alternative” and thus conveyed not natural down, but an alternative down product);

see also Reg. No. 3245279 for BEYOND DOWN for “mattress pads, comforters and fiber beds in the nature of synthetic fiber feather beds, all made in whole or substantial part of synthetic down” (Applicant successfully traversed deceptiveness refusal because term BEYOND suggested applicant’s products are something more than natural down);

Reg. No. 3455021 for BETTER THAN DOWN for “pillows; mattress toppers” and “comforters; bed linen; bed blankets; blanket throws; duvet covers; duvets” (No deceptively misdescriptive or deceptive refusal issued where specimen of use clearly shows products are “microfiber down alternative shell and filling”);¹⁷

¹⁶ Applicant’s brief, 12 TTABVUE 8-9 (bullets added for emphasis).

¹⁷ Applicant’s brief, 12 TTABVUE 9-10 (bullets added for emphasis). Indeed, Applicant notes, “[t]he Trademark Office recognizes these different meanings of ‘down’ having accepted them as goods descriptions in registrations for products containing ‘down’ of one or more type.” Applicant’s brief, 12 TTABVUE 12 n. 2 (e.g., “down feather beds” and “natural down,” or, as in the present application, “synthetic down or down alternatives”).

Like ALTERNA, BEYOND, and BETTER THAN in the latter three registered marks, Applicant argues, the NU in its applied-for NU DOWN mark suggests a “new” product—something other than natural down. *See Armstrong Paint & Varnish Works v. Nu-Enamel Corp.*, 305 U.S. 315, 39 USPQ 402, 406 (1938) (NU held equivalent of “new” in the mark NU-ENAMEL because “[o]bviously this slight variation from the orthographic normal is not unusual”); *see also Corn Prods. Co. v. Vegetable Oil Prods. Co., Inc.*, 126 USPQ 21 (TTAB 1960) (“NU-SOYA’ might suggest a new soya product ...”).¹⁸ And since “new” or “nu” mean “different from one of the same category that existed previously”¹⁹ or “indicating an updated or modern version of something,”²⁰ Applicant suggests, that signals to consumers that pillows and bedding bearing the mark NU DOWN contain a different and modern version of natural down, namely, synthetic down.²¹

We find, however, that the applied-for mark, NU DOWN, does not change or lessen the meaning of “DOWN” as natural down. In the dictionary definitions, “down” presumptively means natural down, i.e., fine, soft, fluffy feathers.²² Its alternative definition as “something soft and fluffy like down” arises only by comparison with down itself. In the examples of use of the term in commerce, “down,” as used on

¹⁸ Applicant’s brief, 12 TTABVUE 15.

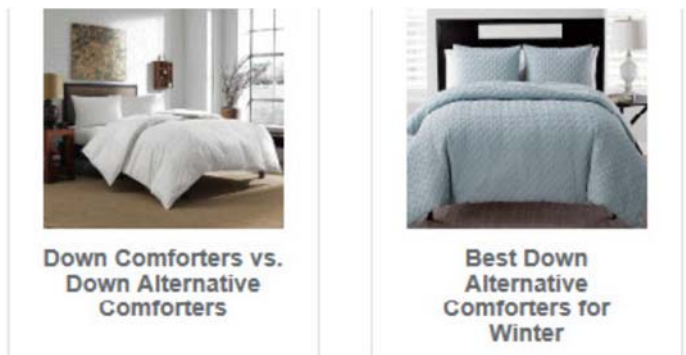
¹⁹ MERRIAM-WEBSTER DICTIONARY, Merriam-Webster.com 7/6/2018, July 10, 2018 Response to Office Action at 665.

²⁰ Dictionary.com, July 10, 2018 Response to Office Action at 685.

²¹ Applicant’s brief, 12 TTABVUE 15.

²² AMERICAN HERITAGE DICTIONARY (5th ed. 2018) AHDictionary.com 7/6/2018, July 10, 2018 Response to Office Action at 70.

pillows and bedding, presumptively means natural down unless otherwise stated. For example:



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Down or Synthetic Fill

Down comforters are made of the little bits of fluff that sit underneath a bird's feather rather than a full feather, which is often harvested from ducks and geese. Its natural ability to keep birds warm in icy water and cold temperatures makes it valuable for filling comforters that will hold plenty of warmth. The quality of natural down is determined by fill power, which measures how many cubic inches one ounce of down can fill. For example, one ounce of goose down that is 800 fill power is capable of filling 800 cubic inches. A higher fill power usually indicates a larger down cluster.

Down alternative comforters, in contrast, feature a mixture of synthetic materials such as rayon or polyester in an effort to mimic down. Down tends to breathe more and be warmer, while down alternative tends to be more affordable and more comfortable for people with allergies.

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²³ Overstock.com 1/10/2018 Jan. 10, 2018 Office Action at 12.

²⁴ Overstock.com 6/19/2018 July 10, 2018 Response to Office Action at 250.



We acknowledge Applicant’s argument that a mark’s wording, taken as a whole, may at times indicate that the goods to which it is attached are synthetic, not natural. *See, e.g., A.F. Gallun & Sons Corp. v. Aristocrat Leather Prods., Inc.*, 135 USPQ 459, 460 (TTAB 1962) (holding COPY CALF not misdescriptive of wallets and billfolds of synthetic and plastic material made to simulate leather, but rather suggests a copy or imitation of calf skin), *cited in In re Budge*, 8 USPQ2d at 1261; TMEP § 1203.02(a). In this case, however, we find that the term “NU” fails to achieve that end. A similar case arose in *Caldwell Lace Leather Co., Inc. v. Western Filament, Inc.*, 173 USPQ 695 (TTAB 1972), an opposition proceeding in which the applicant sought to register NEOHIDE for synthetic plastic material processed to simulate leather shoelaces. The Board found that “whereas the significance of the term ‘COPY CALF’ would be readily apparent to purchasers of wallets and billfolds, the meaning or suggestiveness of ‘NEOHIDE’ would not be so clear. ‘NEOHIDE’ can signify ‘a new or different form’ of leather as well as possibly that the shoe laces are made of some ‘new’ and/or different

²⁵ July 10, 2018 Response to Office Action at 326.

form of material other than the hide of a cow or a horse.” *Id.* at 699. The Board accordingly found NEOHIDE deceptive and deceptively misdescriptive. *Id.* Here, as in that case, the term “NU,” even if it is taken as the phonetic equivalent of “new,” could also be taken to mean “indicating an updated or modern version” of natural down, and not a new and different material.

The proposed mark in this case is thus much closer to NEOHIDE, WONDER DOWN and ECODOWN than it is to BEYOND DOWN, DOWN ALTERNA, and BETTER THAN DOWN, as the three latter marks clearly indicate that the goods have a material content other than natural down. Applicant’s proposed mark is merely descriptive of a significant aspect of the goods, down, that the goods could plausibly possess but in fact do not. The addition of NU to the word DOWN in Applicant’s mark would not inform purchasers with any clarity that Applicant’s goods are not filled with down. The proposed mark therefore misdescribes the identified goods. *In re White Jasmine*, 106 USPQ2d at 1392.

B. Whether consumers are likely to believe the misdescription

We turn next to the second *Budge* factor: whether prospective purchasers are likely to believe that the misdescription actually describes the goods. *In re Hinton*, 116 USPQ2d 1051, 1052 (TTAB 2015).

The Examining Attorney states, “the evidence shows that it is common in the applicant’s industry for manufacturers to make pillows, comforters, duvets and

mattress pads filled with down.”²⁶ Consequently, he maintains, “consumers have come to expect the goods labeled as such exhibit this particular feature or product characteristic.”²⁷

Applicant states:

Applicant concedes the Examining Attorney has made of record numerous examples of home furnishing products made of natural bird down. However, while it may be true that it ‘is common in the applicant’s industry for manufacturers to make pillows, comforters, duvets and mattress pads filled with [natural bird] down’ ..., it is equally true that it is common in Applicant’s industry for these same items to be made of synthetic down and down alternatives.²⁸

For example:



About Duvets

A duvet is a bed covering that consists of a flat fabric bag stuffed with fill. A duvet may also be called a duvet insert; others are sold under the general “comforter” category. Many models feature lines of stitching that help keep the fill material from gathering in one part of the duvet. Duvets come in a wide range of fill options, including down, synthetic down, polyester, wool, and silk.

As you are choosing a model, keep in mind that the sizes of duvets correspond to the size of your mattress. For more coverage, go up to the next size.

[Shop Queen Duvets](#)

Top Sellers



Soft Essentials Ultra Soft 3-piece Duvet Cover Set

Sale: \$21.99 - \$26.99

(1063)

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²⁶ Examining Attorney’s brief, 14 TTABVUE 6, *citing* June 21, 2017 Office Action at 2-28; January 10, 2018 Office Action at 2-106; August 21, 2018 Office Action at 2-40.

²⁷ *Id.*

²⁸ Applicant’s reply brief, 15 TTABVUE 7-8.

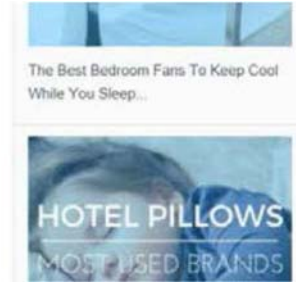
²⁹ Applicant’s brief, 12 TTABVUE 18, Overstock.com 1/10/2018, Aug. 21, 2018 Office Action at 9.

What is a down pillow?

Down pillows are basically just pillows **stuffed with feathers**. For natural down pillows, the most common type of stuffing is duck feathers, although other feather types are used from time to time, especially by smaller, boutique manufacturers.

In natural down pillows, feathers from a duck's chest, back and wing regions are used most often, since they're typically the softest.

That said, natural down pillows need a bit more care and offer far less support, which is why lots of folks opt for **synthetic-filled pillows and down-alternative**.



What About Down Alternative?

Down alternative is a type of synthetic filling. It's designed to emulate the fluffiness of a down pillow without causing allergic reactions.

Because it's synthetic, it's got a lot of the same benefits of other synthetic-filled pillows: it's a bit cooler, it still performs well when wet, and it's much easier to take care of.

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Because the natural and synthetic products have been marketed together for nearly 30 years, Applicant argues, consumers “readily recognize and understand the differences in natural and synthetic down.”³¹

“Furthermore,” Applicant contends, “consumers are not likely to believe that the NU DOWN product comprises natural down because Applicant’s packaging clearly discloses that the product is a down alternative.”

³⁰ Applicant’s brief, 12 TTABVUE 19, EliteRest.com 1/10/2018 Aug. 21, 2018 Office Action at 40-43.

³¹ Applicant’s brief, 12 TTABVUE 17-18.



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“Moreover,” Applicant maintains, “federal law requires manufacturers to indicate on product labeling the precise nature of the contents of bedding materials, which must be available for inspection by the consumer.”³³ For these reasons, it concludes, even if its applied-for mark misdescribes its goods, consumers would be unlikely to believe the misdescription.

We agree with the Examining Attorney, however, that prospective purchasers, consumers of bedding products, would be likely to believe the misdescription that inheres in the proposed mark. As the evidence makes clear, and as Applicant admits, the term “down” is commonly used in the industry to refer to products containing natural down. Where, as here, a product such as natural down is commonly used in the industry, consumers will tend to believe a mark that misdescribes the product.

³² Applicant’s brief, 12 TTABVUE 16-17.

³³ Applicant’s brief, 12 TTABVUE 17, citing FTC article, “Threading Your Way Through Labeling Requirements Under the Textile and Wool Acts,” July 10, 2018 Response to Office Action at 720.

See, e.g., In re E5, 103 USPQ2d at 1583 (“We find that, because the evidence shows that copper is a common supplement or ingredient in dietary supplements, consumers will believe, based on the mark [α CU] and the goods at issue, that applicant’s goods contain copper. Thus, the second prong of the Section 2(a) deceptiveness test has also been satisfied.”); *In re Tapco*, 122 USPQ2d at 1373 (evidence that “some adhesives are, in fact, clear and that this feature is touted to consumers” sufficient to satisfy burden that proposed mark KLEER ADHESIVES satisfied second element of *Budge* test).

The marketing materials to which Applicant refers, showing natural down and synthetic down products marketed together, merely serve to underscore the different terminology used in advertising and promoting the different goods. According to one “Duvets come in a wide range of fill options, including **down, synthetic down**, polyester, wool, and silk.”³⁴ According to another, “**Down** pillows are basically just pillows stuffed with feathers,” whereas “[**d**]own **alternative** is a type of synthetic filling.”³⁵ Hence, consumers would be likely to believe that NU DOWN, a DOWN-formative mark that does not change or lessen the meaning of “DOWN,” refers to natural down.

Although Applicant’s packaging and labeling explains that the product is a down alternative, this does not overcome the misdescriptiveness of its applied-for mark, on which consumers would tend to rely. As the Federal Circuit held in *Budge*,

³⁴ Overstock.com 1/10/2018, Aug. 21, 2018 Office Action at 9 (emphasis added).

³⁵ EliteRest.com 1/10/2018, Aug. 21, 2018 Office Action at 40-43 (emphasis added).

“explanatory statements in advertising or on labels which purchasers may or may not note and which may or may not always be provided” are of little probative value.

Rather:

The statutory provision bars registration of a mark comprising deceptive matter. Congress has said that the advantages of registration may not be extended to a mark which deceives the public. Thus, the mark standing alone must pass muster, for that is what the applicant seeks to register, not extraneous explanatory statements.

In re Budge, 8 USPQ2d at 1261.

As noted in *Budge*, Applicant could remove the explanatory language on the front of its packaging at any time. And consumers, especially the substantial and growing number of consumers who shop online, may not note the fine print labeling required under the federal Textile and Wool Acts. The mark standing alone must pass muster, and this it fails to do. *Id.*; *In re E5 LLC*, 103 USPQ2d at 1581. Consumers are likely to believe the misdescription in the proposed mark.

C. Whether the misdescription is material

We turn next to the third *Budge* factor: whether the misdescription is likely to affect the purchasing decision of a significant or substantial portion of relevant consumers. *In re Spirits Int'l*, 90 USPQ2d at 1493, 1495; *In re Tapco*, 122 USPQ2d at 1375. This materiality requirement is the key difference between “deceptively misdescriptive” marks under Section 2(e)(1), which may overcome their bar to registration by acquired distinctiveness, and “deceptive” marks under Section 2(a), which are absolutely barred from registration. *See In re Cal. Innovations, Inc.*, 329 F.3d 1334, 66 USPQ2d 1853, 1856 (Fed. Cir. 2003); *In re Hinton*, 116 USPQ2d at 1055

n. 24.

The third *Budge* factor may be satisfied by circumstantial evidence that the misdescription would make the product more appealing or desirable to prospective purchasers. *In re White Jasmine*, 106 USPQ2d at 1392 (citing *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1698-99 (TTAB 1992)). “A product or service is usually more desirable because of objective standards or criteria that provide an objective inducement to purchase the goods and/or services beyond that of mere personal preference”—objective criteria such as superior quality, enhanced performance or function, price difference, or health benefits. TMEP § 1203.02(d)(i).

The Examining Attorney contends that:


[G]oods filled with down are generally high priced goods that are perceived as desirable by consumers. Some of the benefits of down include down pillows holding their loft up to 3 times longer than synthetic alternatives, down pillows lasting substantially longer than pillows made with synthetic filling, comforters made with down filling being superior in warmth and durability and that bedding products made from down are good for allergy sufferers. ... Other benefits of goods made from down are its ability to form to the curve of your head and neck, providing customized support, down pillows breathe easily and allow airflow around your head and neck, down provides approximately three times the warmth per ounce compared to even the best synthetics, down is also the most eco-friendly product on the market.³⁶

In support of this position, the Examining Attorney submitted printouts from websites to show that down is a desirable filling for pillows and other bedding. For example:

³⁶ Examining Attorney’s brief, 14 TTABVUE 7.

ASK MARTHA

What are the advantages of down pillows? Are they hard to clean?

Email | Print | Text size  

November 8, 2007

For softness, nothing is better than down pillows. Filled with the delicate fluff from the bellies of waterfowl, they're especially popular with stomach sleepers, who tend to like their pillows cushiony, not firm. (If you prefer a firm pillow, consider one filled with feathers. For a medium-firm pillow, try one filled with down and feathers.) Expect to pay at least twice as much for down pillows as for synthetic-fill ones. Down pillows, like feather ones, can last up to a decade if properly maintained, while even the highest-grade synthetics will likely need replacing after a few years.

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Contrary to a lot of people's conceptions, down is the best choice for asthmatics and people with allergies. This is because allergy to down and feathers is very rare, whilst allergy to mites is the main problem for asthmatics and people with various allergies. Recent medical studies show that synthetic pillows may contain eight times more allergens (from mite) than down and feather filled pillows. The dust mites are killed at around 57°C, when washing the down products or restoring them in our service department.

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A goose down comforter is easy to maintain and keeps its composure for longer than that of synthetic filling comforters. Some people will argue that synthetic fill is comparable to goose down comforter. This is not the case by any means, they may appear equal when first purchased, however, the synthetic fill, after time, will start to lose its loft. This means the synthetic fill comforter will fail to keep you dry and warm at night. If you are looking for a comforter that keeps you dry and warm, as well as maintains its loft for longer periods, you should definitely be thinking

³⁷ Archive.boston.com 6/21/2017, June 21, 2017 Office Action at 18.

³⁸ Norvegr.com 6/21/2017, June 21, 2017 Office Action at 21.

about a goose down comforter. It may be cheaper to go with a synthetic fill comforter, but the real value lies within the quality. It is for this reason, the real value lies within a goose down comforter.

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Advantages of Down Comforters

Down comforters are often expensive, but the price tag comes with a variety of benefits. Down fill is lightweight but delivers efficient warmth, making it an ideal choice for cold climates. The feathers resist clumping and ensure consistent coverage. Down is breathable, so it helps evaporate perspiration and keeps you dry at night.

If you're interested in a comforter that lasts, down fits the bill. The feathers bounce back after repeated washing, so the comforter retains its loft and insulating powers for years.

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Benefits of Down Pillows

1. They're warm. Down pillows are super-duper warm. Humans have been trying to create materials that can match down's warmth-to-weight ratios for some time, but we haven't been able to do it yet. It's nature's best insulator by far, and a down pillow will keep you plenty warm on cold nights.

2. They provide customized support. Down pillows are very pliable, and they'll kind of... *mold themselves* around your head when you use them. It's part of what makes them so comfortable. When used correctly, a down pillow can conform to your neck and shoulders almost as well as a memory foam pillow.

3. They provide a "thin pillow" effect. When you sleep on a down pillow, the weight of your head will naturally pack the feathers down a bit, which reduces the lift and gets your head closer to the bed. This, can help your neck and spine retain much of its natural curvature, which is especially good for back sleepers.

4. Down pillows are really, really soft. The biggest and most obvious benefit of down pillows is probably just that they're super-soft. There's just something about laying down in bed and letting your head sink into a down pillow that can knock you out in the blink of an eye. Plus, it feels luxurious.

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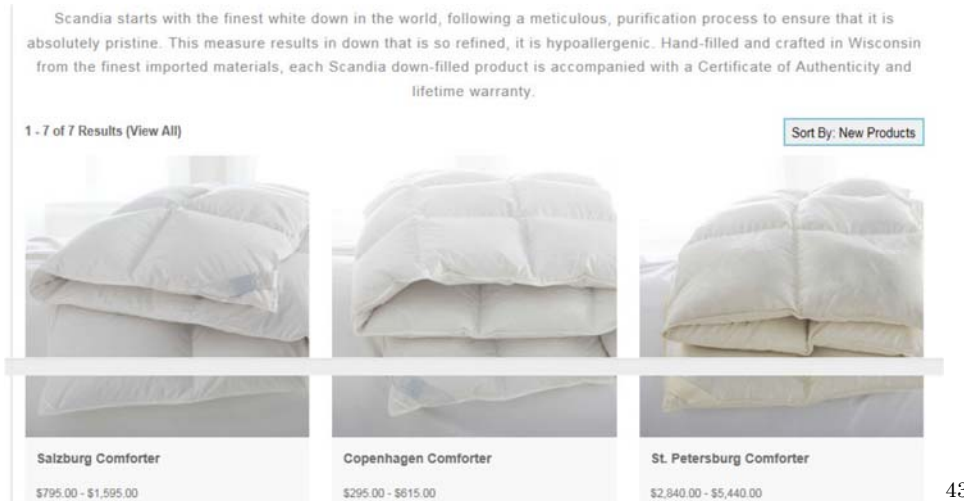
Applicant counters that the "evidence of record shows that natural down bedding materials generally are more expensive, but only if taking into account the high end range of natural down bedding products."⁴² For example:

³⁹ StreetDirectory.com 6/21/2017, June 21, 2017 Office Action at 24-26.

⁴⁰ Overstock.com 1/10/2018, Jan. 10, 2018 Office Action at 11.

⁴¹ EliteRest.com 1/10/2018, Jan. 10, 2018 Office Action at 41-43.

⁴² Applicant's brief, 12 TTABVUE 21-22.



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Applicant argues that these high-end prices would not reflect purchasing decisions of a significant portion of relevant consumers, and that if these high-priced bedding products are disregarded, the price points for down and synthetic down are within the same relative range.⁴⁴

Applicant also points out that each of the supposed advantages of natural down has contrary evidence in the record. For instance, natural down is supposed to maintain its loft longer than other bedding materials, but requires constant fluffing to maintain its loft; natural down is purportedly better for allergy sufferers, but some people are allergic to them; natural down provides warmth, but synthetic down can

⁴³ ScandiaHome.com 1/10/2018, Jan. 10, 2018 Office Action at 32.

⁴⁴ Applicant's brief, 12 TTABVUE 21 & n. 4: "See, e.g., First OA at p. 27 (\$229 for "down blend" mattress pad); Final OA at p. 14 (\$149 for "down mattress pad"), at p. 20-22 (\$31.99-\$43.99 for partially down pillow; \$79.99-\$183.99 for all down pillow), at p. 23 (prices ranging from \$24.29 for 2 "white goose down and feather pillows" to \$386.99 for a Hungarian goose feather down" pillow), at p. 32 (prices ranging from \$295 to \$5,440 for down-filled comforters), at p. 38 (prices ranging from \$120 to \$1,165 for down-filled pillows), at p. 64 (\$106-\$450 for alternative down comforter), and at p. 72 (\$20-\$60 for down alternative pillows); see also RFR Ex. 37, higher-end down alternative comforters priced on Amazon.com from \$504-\$999; see also RFR Ex.38, down alternative pillows priced on Amazon.com from \$32-75."

provide almost equal levels of warmth, depending on how much bulk synthetic down one purchases; and while down is naturally occurring, “harvesting natural bird down causes harm, and even death, to the birds,” such that some consumers would prefer synthetic products.⁴⁵ Support of this position can be found, for example, in online advertisements and articles:

Disadvantages of Down Pillows:

- requires consistent fluffing to maintain its loft
- difficult to clean
- lack of firm options
- some are allergic to them
- good ones are very pricey (see below)

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Downsides of Down Pillows

Down pillows can be a great option, especially for back sleepers, but they're not without their drawbacks. Here are a few things you should consider.

1. They're warm. Yes, this is both a benefit and a drawback. If you're in Chicago in the middle of the winter, a down pillow is really nice. If you're in Arizona in the middle of the summer, a down pillow is likely going to find itself on the floor. Down feathers are built to insulate heat, and they'll do it no matter what temperature it is outside.

2. They don't work as well when wet. Sweaty sleepers may want to steer clear of down pillows. Getting down wet causes it to (1) lose almost all of its loft and (2) lose its ability to retain heat. Basically, sleeping on wet down is like sleeping on wet leaves. It's gross, cold and uncomfortable.

3. It needs some maintenance. Down needs a bit of extra love to stay in good shape. That means you'll need to find a good zip cover, and, if you want your pillow to last for a really long time, you probably need to give it a daily (or at every other day) fluffing.

4. It can wreak havoc on allergies. Down comes from an animal, so it really can make allergies go crazy. And, obviously, if that's you, the last thing you want is to bury your face in something that'll trigger an allergic reaction.

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⁴⁵ Applicant's brief, 12 TTABVUE 21-23.

⁴⁶ HulloPillow.com 6/21/2017, June 21, 2017 Office Action at 8-9.

⁴⁷ EliteRest.com 1/10/2018 Jan. 10, 2018 Office Action at 41-43.

There are three ways the feathers are gathered: after slaughter, live plucking and brushing the molted feathers off the birds or gathering them from the nests after they've fallen off. There's much controversy about live plucking, for obvious reasons, and many animal rights activist organizations seek to ban it, viewing it as animal cruelty.

Manufacturers, on the other side, claim that the majority of down is collected post mortem, which doesn't expose the geese to any additional suffering (besides having their head chopped off). The debate is still on.

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We find that the evidence of record, considered in its entirety, indicates that a significant, substantial portion of relevant consumers would want to know whether the bedding products they consider purchasing are filled with natural down or synthetic down. Consumers who favor warm, soft, customized support from a thinner pillow would purchase natural down, even if it required fluffing; consumers who favor a more consistent fill would purchase synthetic, even if it were somewhat bulkier. Consumers who are allergic to one kind of fill would purchase the other kind. Consumers who are socially conscious would purchase one kind to avoid animal cruelty, or the other kind to avoid use of synthetic materials. Consumers who favor natural down would be willing to invest a higher amount, even at high-end prices, for its long-term quality, whereas more cost-conscious consumers might not.⁴⁹ All in all, the difference between natural down and synthetic down would be important to those

⁴⁸ Survival-Mastery.com 7/6/2018 July 10, 2018 at 106.

⁴⁹ As one source put it, "Buying a quality down comforter can be an investment you will be happy you made. Though the cost is higher, it provides better insulating value and will outlast any synthetic alternative. Over time, it will even pay for itself with lower heating bills. With all of the benefits of a down comforter, it may be the last blanket you ever buy for yourself. ... A well-cared for quality down comforter can last for generations." Ehow.com 8/21/2018, Aug. 21, 2018 Office Action at 9-10.

favoring each kind of fill. Accordingly, the misdescription in the applied-for mark is likely to affect the purchasing decision of a significant or substantial portion of relevant consumers. *In re Spirits Int'l*, 90 USPQ2d at 1493, 1495; *In re Tapco*, 122 USPQ2d at 1375.

D. Conclusion

For these reasons, we find that all three of the *Budge* factors are met, and that the applied-for mark consists of or comprises deceptive matter within the meaning of Section 2(a) of the Trademark Act.

II. Likelihood of Confusion

The Examining Attorney's second ground for refusal is likelihood of confusion under Section 2(d) of the Trademark Act between the applied-for mark, NU DOWN, and the cited registered mark, NU PERCALE. We base our determination of likelihood of confusion under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. ___, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019).

In applying the *DuPont* factors, we bear in mind the fundamental purposes underlying Section 2(d), which are to prevent confusion as to source, and to protect registrants from damage caused by registration of confusingly similar marks. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985);

Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *DuPont*, 177 USPQ at 566. We have considered each *DuPont* factor that is relevant, and have treated any other factors as neutral. *See Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) (“Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.”)); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). Varying weights may be assigned to each *DuPont* 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.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”). Two key considerations are the similarities between the marks and the similarities between the goods. *See 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 (Fed. Cir. 2002) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”)); *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.”).

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

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration,” and the third *DuPont* factor concerns the “similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). A proper comparison of the goods “considers whether ‘the consuming public may perceive [the respective goods or services of the parties] as related enough to cause confusion about the source or origin of the goods and services.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002)), *quoted in In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018).

Again, the subject application identifies “pillows made in whole or substantial part of synthetic down or down alternatives” and “bed blankets; bed sheets; bed skirts; bed spreads; blanket throws; comforters; coverlets; duvet covers; duvets; mattress pads; pillow shams; bed blankets; lap blankets; all of the foregoing made in whole or substantial part of synthetic down or down alternatives.” The cited registration identifies “bed linen; bed sheets; bedsheets; contour sheets; fitted bed sheets; flat bed sheets; pillow cases; pillowcases; sheet sets; all of the foregoing comprised in whole or significant part of percale fabric.”

As the Examining Attorney observes, Applicant concedes that the goods are related, prefacing its comments “Although applicant’s goods are related to the goods in the Cited Mark....”⁵⁰ The goods are, in fact, identical in part, as both identify “bed sheets.” And where they are not identical, they are closely related. The application identifies “pillows” and the registration identifies “pillow cases”—as complementary a pair of goods as can be imagined. *See In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984) (“In the instant case, we take notice that the products ‘bread’ and ‘cheese’ are often used in combination. Such complementary use has long been recognized as a relevant consideration in determining a likelihood of confusion.”) *quoted in In re Davia*, 110 USPQ2d 1810, 1815 (TTAB 2014). And all of the goods are bedding materials, which, as the third-party evidence demonstrates, are often offered for sale by the same retailers, e.g.:

- Ralph Lauren Pillows and pillow cases, with other bedding goods;
- Macy’s pillows and pillow cases, as part of bedding collections;
- Tommy Hilfiger pillows and pillow cases, with other bedding goods.⁵¹

See Hewlett-Packard v. Packard Press, 62 USPQ2d at 1004 (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to the relatedness analysis”).

⁵⁰ *See Applicant’s Brief*, 12 TTABVUE 23-24.

⁵¹ RalphLauren.com 1/10/2018, Jan. 10, 2018 Office Action at 55-64; Macys.com 1/10/2018, Jan. 10, 2018 Office Action at 65-88.

Applicant's identified bedding goods are therefore identical or very closely related to the Registrant's identified bedding goods, and are sold in the same channels of trade to the same classes of consumers. *See Cai v. Diamond Hong*, 127 USPQ2d at 1801 (“[T]he TTAB properly followed our case law and “presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods....”) (citing *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)); *see also In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, (TTAB 2016) (identical or very closely related goods presumed to be sold in same establishments to same customers).

The second and third *DuPont* factors thus weigh in favor of finding a likelihood of confusion.

B. Similarity of the Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant's and Registrant's marks in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1160; *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d at 1812.

Applicant argues that the marks NU DOWN and NU PERCALE are visually, aurally and connotatively distinct. If the marks are compared in their entireties, as they must be, Applicant urges, each mark's second element, DOWN and PERCALE,

differs from the other in sight, sound and meaning.⁵² “DOWN” has been defined above, and “PERCALE” is defined as “a fine closely woven cotton cloth variously finished for clothing, sheeting, and industrial uses.”⁵³

Although both marks begin with the word “NU,” Applicant argues that the “NU” in the registered mark is in French, and translates (under the doctrine of foreign equivalents) as “naked,” whereas “the meaning of NU in Applicant’s Mark is a deliberate, common re-spelling of ‘new.’”⁵⁴ Furthermore, Applicant argues, given the prevalence of NU and NU-formative marks, the common element NU is weak.⁵⁵ “A search of Examining Attorney [sic] records shows nearly 1,000 NU and NU-formative marks,” Applicant contends, citing a Trademark Electronic Search System (TESS) search results page listing (*see* excerpt below):

189	86297458	5055067	NU-SAFE	TSDR	LIVE
190	86745524		NUVIEW HEALTH	TSDR	DEAD
191	86925016		NUS ONE NATION UNDER SOCCER	TSDR	DEAD
192	86247435	4637064	HU.NU	TSDR	LIVE
193	86598428	5191796	NU PARADIGM	TSDR	LIVE
194	86592035	5182181	41NU40	TSDR	LIVE
195	86548444		FU NAN FU NU	TSDR	DEAD
196	86821203	5163950	NU STREAM	TSDR	LIVE
197	86562476	5166956	NU	TSDR	LIVE
198	86896592		NU VUE LIGHTING	TSDR	DEAD
199	86846318	5157414	NUAIR	TSDR	LIVE
200	86794149	5152161	NUWAY	TSDR	LIVE

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Applicant cites three live registrations for NU formative marks for related goods:

Mark and Reg. No.	Pertinent Goods
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⁵² Applicant’s brief, 12 TTABVUE 24-25.

⁵³ Merriam-Webster.com/dictionary/percale 7/7/2018 July 10, 2018 Response to Office Action at 769.



⁵⁴ Applicant’s brief, 12 TTABVUE 24-25.

⁵⁵ Applicant’s brief, 12 TTABVUE 25-26.

⁵⁶ Excerpt of TESS search results page for “NU,” July 10, 2018 Response to Office Action at 784-787.

NUAIR Reg. No. 5157414	Allergen barrier fabric for pillow shells, comforters, mattress pads and down-alternative blankets IC 24
NUPRIMARY Reg. no. 5133739	Fabrics for textile use IC 24
NU-WIPES Reg. No. 1173344	Non-woven cloth cut in various sizes and used as towels, toweling, dish cloths, and wiping, cleaning, drying, straining and filtering cloths IC 24

And three cancelled registrations:⁵⁷

Mark and Reg. No.	Pertinent Goods
 Reg. No. 3921537, Cancelled Sept. 29, 2017.	Beds, bedding, namely mattresses, pillows and bolsters; cots IC 20
NU-MAT Reg. No. 3655091 Cancelled Feb. 19, 2016.	Mattress covers IC 24
 Reg. No. 2793877 Cancelled July 24, 2010.	Bed linens, namely, comforters, bedspreads, quilt covers, mattress pads, blankets, and sheet sets comprised of pillow cases, flat sheets, and fitted sheets; IC 24

Applicant concludes from this evidence that the common element “NU” is so weak that consumer confusion of the two marks is unlikely. A mere possibility of confusion is insufficient to refuse registration, it insists.⁵⁸

We agree with the Examining Attorney, however, that the marks are more similar

⁵⁷ July 10, 2018 Response to Office Action at 788-800.

⁵⁸ Applicant’s brief, 12 TTABVUE 25-27, *citing, e.g., Knapp-Monarch Co. v. Poloron Prods., Inc.*, 134 USPQ 412 (TTAB 1962) (THERMEX—THERM-A-JUG: no likelihood of confusion, as common “THERM” is suggestive of heat-insulating); Applicant’s reply brief, 15 TTABVUE 8-9, *citing Corn Prods. v. Vegetable Oil Prods.*, 126 USPQ 21 (no likelihood of confusion between NU-SOYA and NUCOA, both for margarine).

than dissimilar. When marks appear on identical or closely related goods, the degree of similarity between the marks necessary to support a finding of likely confusion declines. *See Cai v. Diamond Hong*, 127 USPQ2d at 1801 (quoting *In re Viterro*, 101 USPQ2d at 1908); *Bridgestone Ams. Tire Operations LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012). So too here.

The marks must be considered in their entireties, but “in articulating reasons for reaching a conclusion on the issue of confusion, 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.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)); *accord TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1116 (TTAB 2018).

In this case, it is proper to give less weight to the disclaimed generic or descriptive element of each mark, DOWN and PERCALE, as customers could not rely upon these elements to identify or distinguish sources of the goods. *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (disclaimed matter that is descriptive of or generic for a party’s goods is typically less significant or less dominant when comparing marks); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (“This tribunal also has found that disclaimed matter is often “less significant in creating the mark’s commercial impression.”).

The distinctive element NU, placed prominently at the beginning of each mark, is more likely to be recognized and impressed upon a consumer than the disclaimed descriptive suffixes. See *In re Detroit Athletic*, 128 USPQ2d at 1049; *TiVo Brands v. Tivoli*, 129 USPQ2d at 1115 (citing *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 will first notice the identical lead word); *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”).

Indeed, given the similar structure of the marks in their entirety—each beginning with NU and each ending with a disclaimed descriptive term—Applicant’s mark appears to be a variation of Registrant’s mark, suggesting another line of bedding materials emanating from the same source. See *In re Collegian Sportswear, Inc.*, 224 USPQ 174, 176 (TTAB 1984). “[C]areful purchasers who do notice the difference in the marks will not necessarily conclude that there are different sources for the goods, but will see the marks as variations of each other, pointing to a single source.” *In re Hitachi High-Techs. Corp.*, 109 USPQ2d 1769, 1774 (TTAB 2014). The marks are thus “sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between [Applicant and Registrant].” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citing *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007)).

Applicant's efforts to demonstrate that the commercial impression of the prefix NU is weak are unavailing. With respect to the "doctrine of foreign equivalents" argument, the Examining Attorney correctly points out that, "If a French speaking consumer were to see both the applicant's and the registrant's marks, it is highly likely that they would provide the same translation of 'NAKED' to each of the marks. In the same vein if a non-French speaking consumer were to see both the applicant's and the registrant's marks they would most likely not translate the term."⁵⁹ In either event, they would interpret the NU prefix in Applicant's and Registrant's mark the same.

Applicant's reliance on third-party NU-formative registrations is similarly unavailing. It is true that we must adequately account for the apparent force of third-party use and registration evidence in determining the degree of weakness, if any, of the shared term "NU". See *In re I-Coat Co., LLC*, 126 USPQ2d 1730, 1735 (TTAB 2018) (citing *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) and *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)).⁶⁰

⁵⁹ Examining Attorney's brief, 14 TTABVUE 13.

⁶⁰ For example, in a decision relied upon by Applicant, where no likelihood of confusion was found between NU-SOYA and NUCOA, both for margarine, the Board considered record evidence showing "that applicant has used and registered the marks 'NU-MAR' and 'NU MELLO' for margarine[, and t]here is testimony that other sellers of margarine have used marks comprising the term 'NU' as the initial portion thereof." *Corn Prods. v. Vegetable Oil Prods.*, 126 USPQ at 22 (finding NU-SOYA suggestive of a new soy product and NUCOA coined and arbitrary, having no specific meaning or suggestion).

But in this case, Applicant’s evidence falls short of proving weakness of the shared term in connection with bedding goods. To begin with, “[c]onsistent with well-established decisional law, the cancelled registrations submitted by Applicant have little, if any, probative value.” *TiVo Brands v. Tivoli*, 129 USPQ2d at 1117; *In re Wal-Mart*, 129 USPQ2d 1148, 1159 (TTAB 2019). Similarly, the TESS listings submitted by Applicant do not serve to introduce the listed registrations or applications, and have little, if any, probative value. *See Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012); *Truescents LLC v. Ride Skin Care LLC*, 81 USPQ2d 1334, 1337 (TTAB 2006); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012). Beyond that, third-party registrations for unrelated goods and services have little or no bearing on the strength of Registrant’s mark in the field of bedding goods. *See Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693-94 (Fed. Cir. 2018) (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)).

We are left, then, with evidence of three live third-party registrations, for NUAIR, NUPRIMARY, and NU-WIPES, for goods in International Class 24. Only one of these third-party registrations, for NU-WIPES, has the same structure as the applied-for and registered marks—i.e., “NU” preceding a descriptive term, “WIPES” for cloth wipes. And there is no evidence of these registered marks’ use in commerce on a commercial scale or that the relevant purchasers are familiar with them. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973). “This is a far cry from the large quantum of evidence of third-party use and third-party

registrations that was held to be significant in both *Jack Wolfskin v. New Millennium Sports*, 116 USPQ2d at 1136, and *Juice Generation v. GS Enters.*, 115 USPQ2d at 1674.” *In re Inn at St. John’s*, 126 USPQ2d 1742, 1746 (TTAB 2018). By comparison, in *Juice Generation*, there were at least twenty-six relevant third party uses or registrations of record, *see* 115 USPQ2d at 1672 n. 1, and in *Jack Wolfskin*, there were at least fourteen, 116 USPQ2d at 1136 n. 2. As the Federal Circuit stated in *In re i.am.symbolic*, “Symbolic’s evidence of third-party use of I AM for the same or similar goods falls short of the ‘ubiquitous’ or ‘considerable’ use of the mark components present in its cited cases. *See Jack Wolfskin*, 797 F.3d at 1374; *Juice Generation*, 794 F.3d at 1339...” *In re i.am.symbolic*, 123 USPQ2d at 1751.

The totality of the evidence presented by Applicant fails to show that the term NU is significantly weak in connection with the involved bedding goods. As a result, the evidence fails to show that the cited mark should be afforded a narrow scope of protection. *See In re I-Coat*, 126 USPQ2d at 1735-36. The first *DuPont* factor thus weighs in favor of finding a likelihood of confusion.

C. Conclusion

We have considered of all of the evidence of record and all of the arguments of the Examining Attorney and Applicant, as they pertain to the relevant *DuPont* likelihood of confusion factors. We find that the goods are identical or closely related, that they are presumed to travel in the same channels of trade to the same classes of consumers, and that the overall similarity of the marks renders confusion likely.

Decision: The refusals to register Applicant’s proposed mark NU DOWN are affirmed under Sections 2(a) and 2(d) of the Trademark Act.