

This Opinion is not a
Precedent of the TTAB

Oral Hearing June 5, 2019

Mailed: November 6, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Telecom (CHINA) Ltd.
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Serial No. 87440925
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Robert N. Cook of Whitham & Cook PC,
for Telecom (CHINA) Ltd.

Kevin G. Crennan, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.

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Before Shaw, Goodman and Coggins,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Telecom (CHINA) Ltd. (“Applicant”) seeks registration on the Principal Register
of the mark DIRTY LAUNDRY (in standard characters) for

Hooded sweatshirts; Jackets; Jeans; Pants; Shirts; Shorts;
T-shirts in International Class 25.¹

¹ Application Serial No. 87440925 was filed on May 8, 2017, based upon Applicant’s assertion of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Page references to the application record refer to the online database of the USPTO’s Trademark Status & Document Retrieval (TSDR) system. References to the briefs on appeal refer to the Board’s TTABVUE docket system.

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the registered marks DIRTY LAUNDRY (in standard characters), owned by an individual and an unrelated entity, for "footwear" in International Class 25 and for "luggage" in International Class 18 as to be likely to cause confusion.²

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. A request for oral hearing was made and the hearing scheduled. The Examining Attorney then requested a remand and suspension pending cancellation of one of the cited registrations, Registration No. 4275485, under Section 8 of the Trademark Act, 15 U.S.C. § 1058. However, the Applicant indicated that it wished to proceed without suspension, and the oral hearing was held on June 5, 2019. Registration No. 4275485 was cancelled for failure to file a Section 8 affidavit of continued use on August 16, 2019. Accordingly, the Section 2(d) refusal as to this registration is moot and will not be addressed on the merits. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1212 (2019). We affirm the refusal to register based on the remaining cited registration, Registration No. 4117028.

² Registration No. 4117028 and Registration No. 4275485, respectively.

I. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). 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 or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors, and the other relevant *DuPont* factors now before us, are discussed below. *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.”).

A. Similarity or Dissimilarity of the Marks

We must compare the marks in their entirety as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1690 (Fed. Cir. 2005), (quoting *DuPont*, 177 USPQ at 567).

In this case both marks are DIRTY LAUNDRY in standard characters and are identical in sound, appearance, meaning and commercial impression. The overall commercial impression is the same. We find this *DuPont* factor weighs heavily in favor of a finding of likelihood of confusion.

B. Similarity or Dissimilarity of the Goods, Channels of Trade and Classes of Purchasers

We turn next to the *DuPont* factors regarding the similarity or dissimilarity of the respective goods, channels of trade and classes of purchasers. Because the marks are identical, Applicant's goods need not be closely related to Registrant's goods in order for there to be a likelihood of confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) (“[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source.”). It is only necessary that there be a “viable relationship” between Applicant's goods and Registrant's goods to support a finding of likelihood of confusion. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009).

Applicant's goods are “Hooded sweatshirts; Jackets; Jeans; Pants; Shirts; Shorts; T-shirts” while Registrant's goods are “footwear.” In support of the refusal to register, the Examining Attorney submitted third-party registration evidence. Fourteen registrations cover footwear and at least two or more of the clothing items identified by Applicant's application. July 29, 2017 Office Action at TSDR 16-30; January 30, 2018 Office Action at TSDR 22-63. Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that the

identified goods are products which are produced and/or marketed by a single source under a single mark. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). The Examining Attorney also submitted Internet website evidence showing that clothing and footwear are sold together under the same mark (katespade.com, calvinklein.com, nautica.com, tommybahama.com, timberland.com, tedbaker.com, thenorthface.com, michaelkors.com). July 29, 2017 Office Action at TSDR 7, 9, 10, 11, 13, 14; January 30, 2018 Office Action at TSDR 5, 6, 8, 9, 12, 14, 15, 17, 18, 20, 21. While only one website displays clothing and footwear on the same page, the other websites provide descriptive links on the top of each web page to other sections of the same website (e.g., men's and women's clothing and shoes) to locate the clothing and footwear.

Based on the record before us, we find Applicant's and Registrant's goods are sufficiently related. *See In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991) (ESSENTIALS in stylized form for women's shoes against ESSENTIALS for women's clothing, namely, pants, blouses, shorts, and jackets); *In re Apparel Ventures, Inc.*, 229 USPQ 225 (TTAB 1986) (SPARKS BY SASSAFRAS in stylized form for women's separates, namely blouses, skirts and sweaters against SPARKS in stylized form for shoes, boots and slippers); *In re Pix of America, Inc.*, 225 USPQ 691 (TTAB 1985) (NEWPORTS for women's shoes against NEWPORT for outer shirts); *In re Alfred Dunhill Ltd.*, 224 USPQ 501 (TTAB 1984) (DUNHILL in stylized lettering for various items of men's clothing including belts against DUNHILL for shoes); and *In re*

Kangaroos U.S.A., 223 USPQ 1025 (TTAB 1984) (BOOMERANG for athletic shoes against BOOMERANG and design for men's shirts).

As to the channels of trade and classes of purchasers, neither the registration nor the application contains any limitation or restriction as to trade channels or classes of purchasers for the respective goods, and we accordingly presume that the goods are sold in all normal trade channels for such goods and to all normal classes of purchasers of such goods. *See In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). In addition, the Internet website evidence provided by the Examining Attorney is probative to show that clothing and footwear are sold in the same channels of trade to the same class of purchasers.

We find that the *DuPont* factors regarding the similarity of goods, channels of trade, and classes of purchasers favor a finding of likelihood of confusion.

C. Number and Nature of Similar Marks for Similar Goods

The Federal Circuit has held that evidence of the extensive registration and use of a term by others can show the term's weakness. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363 , 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015).

Applicant argues that DIRTY LAUNDRY is weak and entitled to a narrow scope of protection due to the prior existence of one third-party registration, Registration No. 4275485, now cancelled during the pendency of this appeal. In particular, to support its argument that Applicant's mark can coexist with Registrant's mark

without causing consumer confusion, Applicant points to the Examining Attorney's original citation of two coexisting DIRTY LAUNDRY marks owned by an individual and an unrelated entity, one for footwear and one (now cancelled) for luggage, that were cited against Applicant's DIRTY LAUNDRY mark. Applicant submits that the coexistence of those registrations on the register shows that Applicant's mark should also be allowed to coexist on the register with the cited registration since the goods in each of the cited registrations "are at least as closely related to each other as to Applicant's goods."³ 7 TTABVUE 6. Applicant argues that "there are two-separately owned registrations for goods that are not identical to Applicant's goods, and there is no evidence that the two registrants' marks are confused with each other." 7 TTABVUE 7. Applicant submits that "the same facts relied on to refuse registration actually show that the potential scope of coverage of the mark DIRTY LAUNDRY is inherently narrow and that Applicant's mark can coexist in the marketplace with U.S. Trademark Registration Nos. 4117028 and 4275485 without confusion." 13 TTABVUE 3.

Applicant's contention presumes that the prior registration of a particular term should be of some persuasive authority in handling later applications involving similar marks. However, decisions on prior applications do not dictate a particular result; we are bound to make a decision based on the record before us. *See In re Nett*

³ To support this argument, Applicant points to the third-party registration evidence submitted by the Examining Attorney which involves use of a single mark for luggage, footwear and clothing. 7 TTABVUE 5.

Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); *Mattel, Inc. v. Funline Merch. Co., Inc.*, 81 USPQ2d 1372, 1375 (TTAB 2006).

To the extent that Applicant is arguing that the prior coexistence of the two DIRTY LAUNDRY marks on the register shows that consumers knew these marks and were able to distinguish between them, the relevant consideration is whether the marks are in use in commerce. Third-party registrations are not evidence of the use of the marks. *See AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). “Evidence of third-party registrations is relevant to ‘show the sense in which a mark is used in ordinary parlance,’ ... that is, some segment that is common to both parties’ marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.’” *Jack Wolfskin*, 16 USPQ2d at 1136, (quoting *Juice Generation*, 115 USPQ2d at 1674). During prosecution, Applicant pointed only to the now cancelled DIRTY LAUNDRY registration and did not submit evidence of other third-party registrations for DIRTY LAUNDRY for related goods. “One existing third-party registration is manifestly insufficient either to demonstrate” that DIRTY LAUNDRY is, in fact, a “weak” mark for footwear “or to justify the registration sought by Applicant.” *In re Johns-Manville Corp.*, 180 USPQ 661, 662 (TTAB 1973).

In addition, Applicant did not submit evidence of third-party use of similar DIRTY LAUNDRY marks on similar goods to show that Registrant’s DIRTY LAUNDRY mark is relatively weak and entitled to only a narrow scope of protection. *Palm Bay Imports*, 73 USPQ2d at 1693. Absent evidence of actual use of DIRTY LAUNDRY in

the marketplace, a single third-party registration has little probative value, especially absent evidence that the mark is in use on a commercial scale or that the public has become familiar with it.⁴ See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (purchasing public unaware of registrations residing in the USPTO); see also *In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983) (“[T]hird party registrations in this Office, absent evidence of actual use of the marks subject of the third-party registrations, they are entitled to little weight on the question of likelihood of confusion.”). Thus, the fact that the cited mark and the cited but now-cancelled mark at one time coexisted on the register does not prove that they coexisted during that time without confusion in the marketplace. In any event, the DIRTY LAUNDRY registration for luggage is now cancelled, and there are presently no coexisting DIRTY LAUNDRY registrations. The now-cancelled DIRTY LAUNDRY registration has little or no probative value other than to show that it once issued. See *Action Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“[A] cancelled registration does not provide constructive notice of anything.”).

We find this *DuPont* factor neutral.

⁴ There might be a reason that the marks coexist on the register, but that reason is not readily apparent from the face of the registrations. Additionally, even if purchasers were aware of coexisting marks, this does not negate the fact that purchasers may presume that the goods, luggage and footwear, identified under the same mark, are offered by the same entity.

II. Conclusion on Likelihood of Confusion

We have considered all of the arguments and evidence of record, and all relevant *DuPont* factors. We conclude that confusion is likely to occur between Applicant's mark and Registrant's mark.

Decision: The refusal to register Applicant's mark DIRTY LAUNDRY is affirmed.