

This Opinion is not a
Precedent of the TTAB

Oral Hearing:
September 4 and 13, 2018

Mailed: October 1, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Paradyce Clothing Company, Inc.
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Serial No. 87562296
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Rebecca Gan of Wenderoth LLP,
for Paradyce Clothing Company, Inc.

Susan A. Richards, Trademark Examining Attorney, Law Office 103,
Stacy Wahlberg, Managing Attorney.

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Before Kuhlke, Taylor and Wolfson,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Paradyce Clothing Company, Inc. (“Applicant”) seeks registration on the Principal
Register of the mark PARADYCE in standard characters for

bandanas; bathing suits; belts; boots; caps being headwear;
collared shirts; dress shirts; dresses; golf shirts; hats;
headbands; headwear; hooded sweat shirts; jackets; jeans;
jerseys; pants; polo shirts; scarves; shirts; shoes; shorts;
sneakers; socks; sports jerseys; suits; sweat pants; sweat
shirts; t-shirts; ties as clothing; none of the foregoing for
sale by or in casino or hotel establishments

in International Class 25.¹

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when used in connection with the identified goods, so resembles the mark PAR-A-DICE HOTEL - CASINO in standard characters, registered on the Principal Register for "wearing apparel, namely, caps, hats, visors, t-shirts, golf shirts, collared shirts, polo style shirts, long sleeve shirts, jackets, sweat shirts and sweat pants" in International Class 25,² as to be likely to cause confusion, mistake or deception.

After the Examining Attorney made the refusal final, Applicant appealed and filed a Request for Reconsideration. Following the Examining Attorney's denial of the Request for Reconsideration, the Board resumed the appeal and briefs were filed. For the reasons discussed below, we reverse the refusal to register.

Likelihood of Confusion

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). Even within the *du Pont* list, only factors that are "relevant and of record" need be considered. *M2 Software, Inc. v. M2 Commc'ns, Inc.*,

¹ Application Serial No. 87562296 was filed on August 9, 2017, under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), based upon Applicant's allegation of first use and first use in commerce on October 19, 2013.

² Registration No. 3457929, issued on July 1, 2008; renewed. The mark registered with a claim of acquired distinctiveness to the mark in whole under Section 2(f), 15 U.S.C. §1052(f), and with a disclaimer to 'HOTEL – CASINO.'

450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *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.”). In any likelihood of confusion analysis, 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) (“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.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 303 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *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 Consumers

With regard to the goods, channels of trade, and classes of consumers, we must make our determinations based on the goods as they are identified in the application and cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Here, the goods are in-part identical. Both the application and cited registration include “collared shirts,” “golf shirts,” “hats,” “jackets,” “sweat shirts,”

“sweat pants,” and “t-shirts.” In addition, several of the goods are legally identical: Registrant’s “long sleeve shirts” and “polo style shirts” are legally identical to Applicant’s “dress shirts” and “polo shirts” and Applicant’s “hooded sweat shirts” and “caps being headwear” are legally identical to Registrant’s “sweat shirts” and “caps.”

Because the goods are identical and legally identical in part, they are a fortiori related, and we need not discuss the other goods listed in the application and cited registration. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any item encompassed by the recitation of goods in the application. *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126, n.5 (TTAB 2015); *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1397 (TTAB 2007).

In addition, because there are no limitations or restrictions in Registrant’s identification of goods, we must presume that Registrant’s goods are marketed in all normal trade channels for those goods and to all normal classes of purchasers for such goods, regardless of what any extrinsic evidence might show to be the actual trade channels and purchasers for the goods. *In re Jump Designs LLC*, 80 USPQ2d 1370 (TTAB 2006); *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); *In re Elbaum*, 211 USPQ 639 (TTAB 1981). As a result, while Applicant’s goods are restricted to exclude sales by or in hotels or casinos, Registrant’s goods are presumed to move in all normal channels of trade and be available to all classes of potential consumers, including those also available to Applicant, such as department stores,

boutique clothing stores, big box stores and over the Internet. *See In re Elbaum*, 211 USPQ at 640.

Accordingly, we find that the second and third *du Pont* factors weigh in favor of a finding of likelihood of confusion.

B. Similarity of the Marks; Strength of Registrant's Mark

We next consider Applicant's mark PARADYCE and Registrant's mark PAR-A-DICE HOTEL – CASINO and compare them “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)). Further, marks “must be considered ... in light of the fallibility of memory ...” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ

335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). “[S]imilarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 113 USPQ2d at 1085 (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003)).

The Examining Attorney argues that consumers are likely to view Applicant’s mark as a shortened form of the cited mark, when discounting for the appearance of the words “Hotel - Casino.” Since these words have been disclaimed apart from the mark as a whole in recognition of their descriptive connotations, we agree that the disclaimed words “Hotel – Casino” are less significant. *See Citigroup Inc., v. Capital City Bank Group, Inc.*, 98 USPQ2d 1253, 1257 (Fed. Cir. 2011); *In re Dixie Rests., Inc.*, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). Thus, we agree with the Examining Attorney that PAR-A-DICE would be considered to be the “critical” or “dominant” term in the mark. Nonetheless, we do not find PARADYCE to so resemble PAR-A-DICE that confusion, deception or mistake is likely among relevant purchasers. While Registrant’s and Applicant’s marks look and sound somewhat alike because they both start with the syllable “PAR” or “PAR[-]A” and end with a phonetic equivalent of “-dise,” i.e., “DYCE” or “DICE,” the hyphenation in the cited mark draws attention to itself, creating a pause between the terms forming Registrant’s mark, and breaking up the syllables into separate terms: the word “par,” suggesting a “par sheet,”³ the article “a” and the word “dice.” The hyphenation thus creates a differing look and

³ A glossary of gambling terms at The Wizard of Odds website defines a “par sheet” as “a document that details how a particular slot machine is designed....” Applicant’s February 5, 2018 Request for Reconsideration TSDR 6.

cadence that distinguishes it from Applicant's mark. In connotation, the marks are different; the cited mark brings to mind the phrase "pair of dice," emphasizing the connection with gambling and casinos. There is no similar connotation in Applicant's mark, which would be perceived as a misspelling of the word "paradise."

We have also given some weight to Applicant's argument that Registrant's mark is weak, in light of the nine third-party registrations submitted by Applicant for marks containing the word PARADISE or variations thereof, for clothing items. While third-party registrations are not evidence that the marks are in use in the marketplace, they can be used to demonstrate that a term may have a commonly accepted meaning, "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, Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917 (CCPA 1976) (even if there is no evidence of actual use of third-party registrations, such registrations "may be given some weight to show the meaning of a mark in the same way that dictionaries are used"); *Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d 1163, 1173 (TTAB 2011) (third-party registrations indicate term CLASSIC has suggestive meaning as applied to tobacco products). To the extent the cited mark would be perceived as an alternate spelling of "paradise," the third-party registrations support a finding that the term "paradise" has some significance for clothing items. For example, Applicant submitted copies of

the mark PARADIES (translated as “PARADISE” in the application) for “clothing; namely, pajamas, night gowns, and robes;”⁴ PARADISO (translated as “PARADISE” in the application) for “sportswear, namely, jerseys in the nature of sweaters, caps for men and women;”⁵ and PARADISE COLLECTION (“Collection” disclaimed) for, inter alia, “sweaters, jackets.”⁶

Finally, the fact that the cited mark has been registered with a claim under Section 2(f) may be construed as a concession that the matter to which it pertains is not inherently distinctive. *See Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) (“Where an applicant seeks registration on the basis of Section 2(f), the mark’s descriptiveness is a nonissue; an applicant’s reliance on Section 2(f) during prosecution presumes that the mark is descriptive.”) (citing *Int’l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (reliance by an applicant on Section 2(f) assumes that the mark has been shown or conceded to be merely descriptive); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1212.02(b).

In sum, despite sharing the same first four letters, the meanings and commercial impressions of the parties’ marks are sufficiently dissimilar to weigh against a conclusion of likelihood of confusion. Consumers will likely enunciate three separate syllables or terms in the beginning portion of the cited mark, PAR-A-DICE HOTEL –

⁴ Reg. No. 1722981, issued October 6, 1992; renewed. December 20, 2017 Response to Office Action TSDR 2.

⁵ Reg. No. 4350373, issued June 11, 2013. *Id.* at TSDR 7.

⁶ Reg. No. 4361044, issued July 2, 2013. *Id.* at TSDR 19.

CASINO, while Applicant's mark PARADYCE will likely be pronounced as one word, sounding like "paradise." To the extent consumers are familiar with the spelling of the cited mark, the hyphen will be understood as a separation or "stop" between the three terms, PAR, A, and DICE. When spoken in their entirety, the marks are noticeably different aurally. However, even if PAR-A-DICE is phonetically pronounced as the word "paradise," the connotation and overall commercial impression of the cited mark still suggests a "pair of dice," due to the inclusion of the terms "HOTEL – CASINO, which bolster the connection with a hotel and casino and the connotation of a gambling and casino theme. Such connotation is markedly different from the connotation of Applicant's mark.

The first *du Pont* factor thus weighs against a finding of likelihood of confusion.

C. Balancing of Factors

We find, notwithstanding the fact that the parties' goods are identical and the goods sold in the same channels of trade to the same classes of consumers that the marks in this case are simply too dissimilar to support a finding of likelihood of confusion. A single *du Pont* factor may be dispositive on the issue of likelihood of confusion, especially when that single factor is the dissimilarity of the marks. *Kellogg Co. v. Pack'em Ent., Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (citing *du Pont*, 177 USPQ at 567) (stating that "[w]e know of no reason why, in a particular case, a single [*du Pont*] factor may not be dispositive" and holding that "substantial and undisputed differences" between two competing marks justified a conclusion of no likelihood of confusion on summary judgment). Simply put, the

dissimilarity of the marks, and the somewhat weak nature of the word “paradise” (including its phonetic equivalents) as applied to clothing, outweighs all other factors. *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998) (CRYSTAL CREEK for wine has different connotation than CRISTAL for champagne; marks found to be dissimilar).

Decision: The refusal to register Applicant’s mark is reversed.