

**This Opinion is Not a
Precedent of the TTAB**

Mailed: January 16, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re KC Investment Inc.
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Serial No. 87897588
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Michael W. Schroeder of Reyes and Schroeder Associates PC for KC Investment Inc.

Kaile Reid, Trademark Examining Attorney, Law Office 123, Susan Hayash,
Managing Attorney.
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Before Thurmon, Deputy Chief Administrative Trademark Judge, Bergsman and
Pologeorgis, Administrative Trademark Judges.

Opinion by Thurmon, Deputy Chief Administrative Trademark Judge:

Applicant, KC Investment Inc., seeks registration on the Principal Register of the
mark DADDY GANG (in standard characters) for the following goods in International

Class 25:¹

Clothing, namely, shirts, t-shirts, tank tops, polo shirts,
button down shirts, tops, baby tee shirts, sweaters,
sweatshirts, hooded sweatshirts, jackets, jerseys, coats,
sweat suits, bodysuits, dresses, bottoms, jeans, pants,
sweatpants, shorts, socks, robes, swimwear, activewear in
the nature of shirts, jackets, shorts and pants, rainwear,

¹ Application Serial Number 87897588, filed on April 27, 2018, based on an alleged bona fide intent to use the mark in U.S. commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

sleepwear, pajamas, loungewear, underwear, leggings, vests, gloves, scarves, layettes, shawls, sleep masks, beanies, bandanas, hats, headbands and caps being headwear; Footwear, namely, shoes, sneakers, flip flops, sandals and boots; Children's and infants' cloth bibs and aprons; Infant wear; Infant wearable blankets; Infant sleepers.

The Examining Attorney refused registration under Section 2(d), 15 U.S.C. § 1052(d), (likelihood of confusion) based on the registered mark GOOD DAD GANG for "Clothing, namely, t-shirts, hats, sweat suits," in International Class 25.² The sole issue before the Board in this appeal is whether there is a likelihood of confusion. The appeal has been fully briefed. We affirm the refusal to register.

I. The Record and the Prosecution History

The Examining Attorney submitted evidence with the first Office Action of dictionary definitions of the words "daddy," "dad," and "gang."³ Relying on this evidence, the marks and goods as shown in the application and cited registrations, the Examining Attorney found a likelihood of confusion and refused registration

² Registration Number 4817036, registered on the Principal Register on September 22, 2015, based on an application filed January 26, 2015. The Examining Attorney also based the Section 2(d) refusal on a second registered mark owned by the same registrant, i.e., GOOD DAD GANG + design, for "Hats, T-shirts" in International Class 25 (Registration Number 5395552). As explained below, we rely only on the registered standard character mark in our determination herein.

³ Office Action dated August 20, 2018 at 11-13. 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. Coming before the designation TTABVUE is the docket entry number; and coming after this designation are the page references, if applicable.

under Section 2(d). Applicant responded by arguing against the refusal and submitting the following evidence:⁴

- records of 22 active third-party registrations of marks that include the word “dad” for clothing goods in International Class 25;⁵
- Internet screen shots allegedly showing use of 19 marks that include the word “dad” for clothing goods, where 17 of the 19 marks are also from the group of registered “dad” marks identified by Applicant;
- records of 46 active third-party registrations of marks the include the word “gang” for clothing goods in International Class 25;
- Internet screen shots allegedly showing use of 33 marks that include the word “gang” for clothing, where 28 of the 33 marks are also from the group of registered “gang” marks identified by Applicant; and
- registration records and Internet screen shots that allegedly show “a total of (15) separate examples of pairs of coexisting live, federal registrations for otherwise identical marks for use in connection with clothing goods in International Class 25, that coexist on the Principal Register, with the only difference being the inclusion of the dominant, first term GOOD.”⁶

The Examining Attorney did not object to Applicant’s evidence, but found that Applicant’s arguments and evidence unpersuasive.⁷ The Section 2(d) refusal was

⁴ Response to Office Action dated October 12, 2018. Applicant submitted a corrected Response to Office Action on October 24, 2018 to correct a typographical error in its October 12 submission. The corrected Response did not resubmit the evidence, but we conclude the evidence is still of record as the correction related solely to the arguments submitted by Applicant.

⁵ Applicant submitted records from the Trademark Electronic Search System (TESS) showing the status and title, as well as other information, about each registration.

⁶ 7 TTABVUE 25.

⁷ The Examining Attorney later objected when Applicant submitted a dictionary definition of the word “connotation” with its appeal brief. We deem the objection moot because we can take judicial notice of a dictionary definition and because the term connotation, as used when comparing marks within the likelihood of confusion analysis, is already well-defined in the precedents of this Board and our primary reviewing court.

made final.⁸ Applicant requested reconsideration,⁹ but that request was denied and this appeal followed.¹⁰

II. Applicable Law

We base our determination of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(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) (“*du Pont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider each *du Pont* factor for which there is evidence or argument. See, e.g., *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). However, “each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973).

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.*, 992 F.2d 1204, 26 USPQ2d

⁸ Office Action dated December 6, 2018.

⁹ Request for Reconsideration dated February 19, 2019. Applicant submitted additional evidence with this Request that it argued showed the words “dad” and “daddy” are used in different ways. *Id.* at 14-26.

¹⁰ Applicant filed two separate requests for reconsideration. The first one was filed on February 19, 2019, prior to the filing of Applicant’s Notice of Appeal. The second request was filed on the date the Notice of Appeal was filed, i.e., April 25, 2019. 4 TTABVUE. Both requests were denied.

1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”). Two key considerations in most cases are the similarities between the marks and the similarities between the goods or services. *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 *du Pont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”).

III. Analysis

The Examining Attorney based the Section 2(d) refusal on two registered marks owned by the same registrant.¹¹ One mark is GOOD DAD GANG in standard characters, and the second mark is shown below:



12

These two registrations cover similar clothing goods.

¹¹ *See* registrations identified in n.2, *supra*.

¹² Registration Number 5395552. The application for the mark contained the following description: “The mark consists of the silhouette of a father, on the right hand side, holding hands with his child, on the left hand side, where both of the figures are inside and thick-bordered circle, which has the words ‘Good Dad Gang’ spaced out inside the top half of the thick-bordered circle.”

Where multiple registered marks are cited as the basis for a Section 2(d) refusal, it is sufficient to affirm the refusal if there is a likelihood of confusion as to any of the cited registered marks. *See Fiserv, Inc. v. Elec. Transaction Sys. Corp.*, 113 USPQ2d 1913, 1917 (TTAB 2015). In this case, we limit our analysis to the standard character GOOD DAD GANG mark cited by the Examining Attorney because “if we find a likelihood of confusion as to this [cited] registration, we need not find it as to the others.” *Fiserv*, 113 USPQ2d at 1917. References to the cited mark in the remainder of this decision refer to the standard character mark GOOD DAD GANG.

A. Strength of the Cited Mark

The fifth *du Pont* factor, “[t]he fame of the prior mark (sales, advertising, length of use),” and the sixth *du Pont* factor, the number and nature of similar marks in use for similar goods, *du Pont*, 177 USPQ at 567, may be considered in tandem to determine the strength of the cited mark and the scope of protection to which it is entitled. *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017). “In determining strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition.” *Bell’s Brewery*, 125 USPQ2d at 1345 (citing *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014)); *see also In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”).

In an ex parte appeal such as this, the owner of the cited registration is not a party, and the Examining Attorney is under no obligation to demonstrate the exposure or recognition of the cited mark in the marketplace. *In re Integrated Embedded*, 120 USPQ2d 1504, 1512 (TTAB 2016). For that reason, “in an ex parte analysis of the DuPont factors for determining likelihood of confusion ..., the ‘fame of the mark’ [fifth] factor is normally treated as neutral when no evidence as to fame has been provided.” TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1207.01(d)(ix) (Oct. 2018). Thus, because there is no evidence of record regarding the fame of the cited mark, the fifth *du Pont* factor is neutral.

The sixth *du Pont* factor requires us to consider the number and nature of similar marks in use on similar goods. *du Pont*, 177 USPQ at 567; *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1033 (TTAB 2016). Third-party registrations and use of similar marks can bear on the strength or weakness of a registrant’s mark in two ways: commercially and conceptually. First, if a mark, or an element of a mark, is used extensively in commerce by a number of third parties, that could undermine its commercial strength, as the consuming public may have become familiar with a multiplicity of the same or similar marks, and can distinguish them based on minor differences. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). “Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps., 73 USPQ2d at 1693*, quoted in *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). “The weaker [a registrant’s] mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Juice Generation*, 115 USPQ2d at 1674.

Second, if there is evidence that a mark, or an element of a mark, is commonly adopted by many different parties, that may indicate the common element has some non-source identifying significance that undermines its conceptual strength as an indicator of a single source. *Jack Wolfskin*, 116 USPQ2d at 1136 (“[E]vidence 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’”) (quoting *Juice Generation*, 115 USPQ2d at 1674 (quoting 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:90 (5th ed. 2015))).

The Applicant and the Examining Attorney made arguments about the strength of the cited GOOD DAD GANG mark. The Examining Attorney contends this mark is “inherently strong for clothing goods,” because only four registered marks were found that included the term “dad” or “daddy” together with the term “gang.”¹³ Two of the four are owned by the Registrant and both are cited as the basis for the Section 2(d) refusal. The two remaining third-party registrations are hardly sufficient to show

¹³ 10 TTABVUE 10.

common use or registration of the wording “dad gang” or “daddy gang” or that such wording is weak in relation to clothing items.

The Applicant, on the other hand, submitted evidence showing numerous third-party registrations and use of the terms “dad” and “gang” separately for clothing. Applicant’s argument is that each term is commonly used in marks for clothing and therefore each term is weak when used in connection with such goods. Applicant then argues that a combination of two weak terms also results in a weak mark. Though Applicant has taken the mark apart to conduct this analysis, it is proper to consider separately the distinctiveness of the different elements of a multi-element mark. *See, Juice Generation*, 115 USPQ2d at 1674 (weak marks are less likely to be confused with other similar marks) and *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004) (it may be proper to “ascertain the meaning of each of the words or components that make up the entire mark” to determine whether the mark is distinctive); *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016) (same).

The evidence Applicant relies upon shows almost 20 “dad” marks registered and apparently in use for clothing and almost 30 “gang” marks registered and apparently in use for clothing. This evidence shows these individual terms are somewhat commonly used in marks for clothing. But as the Examining Attorney notes, the combination of “dad” or “daddy” with “gang” in a single mark for clothing is not common. Accordingly, the evidence, taken as a whole, does not demonstrate that the wording “dad gang” or “daddy gang” for clothing is weak. We find the GOOD DAD

GANG mark is entitled to the normal scope of protection accorded inherently distinctive marks.

B. Similarity of the Marks

We next compare the marks in their entireties as to appearance, sound, connotation and commercial impression. *du Pont*, 177 USPQ at 567. “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); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods or services offered under the respective marks is likely to result. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (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 focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Because the goods at issue are clothing, specifically t-shirts, hats, and sweat suits, the average purchaser is an ordinary consumer.

In comparing the marks, we are mindful, where as here, the goods are in part identical, the degree of similarity to find the marks similar need not be as great as where there is a recognizable disparity between the goods. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). *See* the discussion regarding the similarity or dissimilarity and nature of the goods below.

The marks at issue here are similar in appearance and sound, and are similar in connotation and commercial impression. The marks share the word “gang” and use the similar terms “dad” and “daddy.” The visual and aural impressions made by these marks, taken in their entireties, are similar. We agree with Applicant that there are differences in the marks. The use of the word “good” as the first term in the registered mark is a point of distinction and bears noting given that the first word of a multi-word mark may be more noted and remembered by consumers. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *In re Integrated Embedded*, 102 USPQ2d 1504, 1513 (TTAB 2016); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988)).

Laudatory terms are typically less distinctive and may create less of an impression on consumers for that reason. *In re Place, Inc.*, 76 USPQ2d 1467, 1468-69 (TTAB 2005) (“the courts of appeal and this Board have held that other marks which arguably denote ‘high quality,’ ‘excellence’ and ‘superior quality’ are laudatory and

thus merely descriptive”); *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824-25 (TTAB 2015) (“it is beyond dispute that descriptive or generic terms ... serve little source-identifying function”). The word “good” as used in the cited mark is the first term, but it is also a laudatory term. These considerations pull in different directions.

The word “good” as used in the registered mark may serve to modify the meaning of the words “dad gang,” rather than conveying anything about the quality of the clothing goods. Applicant argues, and offered some evidence in support, that the word “gang” has negative connotations and that adding the word “good” to “gang” creates a meaning contrary to the normal meaning of the word “gang.”¹⁴ There may be some truth to this argument, but it ignores two other facts. First, gang is not solely defined as a negative group or a group up to no good. The dictionary evidence also shows neutral meanings of the word “gang.” Second, both marks include a word for father just prior to gang. A gang of fathers may be less likely to be viewed as a negative group. We again have considerations that pull in different directions, and we are left with two marks that have similar meanings.

There is no separate evidence regarding the commercial impression created by these marks, so we look collectively at the other types of similarity—sight, sound, and meaning. We have found at least some degree of similarity in each of these forms, and we, therefore, conclude the marks also create a similar commercial impression. Thus, we find the marks DADDY GANG and GOOD DAD GANG are similar for

¹⁴ Response to Office Action dated October 12, 2018 at 15-18.

likelihood of confusion purposes. The similarity of the marks, therefore, weighs in favor of a finding that confusion is likely.

C. Similarity of Goods, Trade Channels, and Buying Conditions

“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.” *Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Paula Payne Prods. v. Johnson Publ’g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). We group these three *du Pont* factors because of the shared focus on the identification of the goods.¹⁵

The goods are legally identical in part because the Application includes each of the three specific types of clothing identified in the cited registration, that is, “t-shirts, hats, sweat suits.” *See Inter IKEA Sys. B.V. v. Akea, LLC*, 110 U.S.P.Q.2D 1734, 1745 (TTAB 2014) (“In the context of likelihood of confusion, it is sufficient to find likelihood of confusion as to the entire class if likelihood of confusion is found with

¹⁵ Our analysis here covers the second, third and fourth *du Pont* factors: “The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;” “The similarity or dissimilarity of established, likely-to-continue trade channels;” and, “The conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *du Pont* 177 USPQ at 567.

respect to use of the mark on any item in a class that comes within the description of goods.”) (citing *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) and *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007)). Thus, this *du Pont* factor favors a finding of likelihood of confusion.

Because the goods in the application and the cited registration are in part identical and there are no restrictions as to trade channels or classes of purchasers in either the involved application or cited registration, we must presume that the channels of trade and classes of purchasers at least in part are the same. *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (“We must presume that Applicant’s and Registrant’s goods will be sold in the same channels of trade and will be bought by the same classes of purchasers, because the goods are identical and legally identical in part and there are no limitations as to channels of trade or classes of purchasers in either the application or cited registration.”); *see also Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) (“Given the in-part identical and in-part related nature of the parties’ goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade”); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers”).

Because the goods include t-shirts, hats, and sweat suits, products that may be inexpensive and purchased on impulse, and because we are required to analyze the conditions under which sales are made as including the “least sophisticated consumer in the class,” *Stone Lion Capital*, 110 USPQ2d at 1163-64, we find that some relevant consumers may not exercise a high degree of consumer care when making their purchasing decision.

These three *du Pont* factors weigh heavily in favor of a likelihood of confusion finding.

D. Conclusion

We have considered all *du Pont* factors for which there is evidence or argument and find that confusion is likely. Every factor we considered weighs in favor of this finding. Because we have found that (1) the marks at issue are similar; (2) Applicant’s identified goods are identical in part to Registrant’s goods; (3) the goods are presumed to move in similar or overlapping trade channels and that they would be offered to the same or similar classes of purchasers; and (4) the Registrant’s mark is inherently distinctive, we conclude that Applicant’s DADDY GANG mark, as used in connection with its goods identified in its involved application, so resembles the cited mark GOOD DAD GANG as to be likely to cause confusion or mistake, or to deceive under Section 2(d) of the Trademark Act.

Decision: The refusal to register based on Section 2(d) is affirmed.