

This Opinion Is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Rod's Western Palace, Inc.
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Application Serial No. 87914427
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Leon David Bass of Taft Stettinius & Hollister, LLP for Rod's Western Palace, Inc.

Saima Makhdoom, Trademark Examining Attorney, Law Office 101,
Ronald R. Sussman, Managing Attorney.
—

Before Bergsman, Goodman and Dunn, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Rod's Western Palace, Inc. (Applicant) seeks registration on the Principal Register
of the mark ROD'S, in standard character form, for the services listed below:

Retail store services featuring Apparel, clothing, boots, hats, tack supplies, home furnishings, bedding, jewelry, wallets, knives, accessories, mobile device cases, handbags, luggage, perfume, bags, watches, cologne, home décor, lighting, home and garden furnishings and supplies, kitchen furnishings and supplies, furniture; and bath furnishings and supplies; On-line retail store services featuring a wide variety of consumer goods of others; On-line retail store services featuring Apparel, clothing, boots, hats, tack supplies, home furnishings, bedding, jewelry, wallets, knives, accessories, mobile device cases, handbags, luggage, perfume, bags, watches, cologne, home décor, lighting, home and garden furnishings and supplies,

kitchen furnishings and supplies, furniture; and bath furnishings and supplies, in International Class 35.¹

The Examining Attorney refused to register 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 mark ROD'S AMERICAN MARKET PUTTING AMERICA BACK TO WORK and design, reproduced below, for "Retail apparel stores; Retail furniture stores; Retail gift shops; Retail variety stores; Referrals in the field of hunting and outdoor gear; Retail gift shops [sic]," in Class 35, as to be likely to cause confusion.²



The description of the mark reads as follows:

The color(s) Red, Blue, White, Grey, Pink-beige skin is/are claimed as a feature of the mark. The mark consists of "ROD'S AMERICAN MARKET" in blue on top of a flag that contains a blue rectangle with three white stars in it with three red stripes and two white stripes. Below the flag are the words "Putting America Back to Work." in blue. To the left is Uncle Sam with white hair and pink-beige skin, wearing a flag top hat that has red and white stripes on top of a blue hat band with 3 white stars. He has on red and white striped pants with red suspenders, a white shirt and a blue vest with white stars on it, he also has a white goatee

¹ Serial No. 87914427, filed May 9, 2018, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1052(a), based on Applicant's claim of first use of its mark anywhere and in commerce as of April 1976.

² Registration No. 5117559 registered January 10, 2017.

and a blue tattoo on his left upper arm with “US” and a bar with a star in it.

Registrant disclaimed the exclusive right to use “American Market.”

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *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. 138, 113 USPQ2d 2045, 2049 (2015). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019), quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997), quoting *DuPont*, 177 USPQ at 567. “Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *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)). See also *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 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.”). “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).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *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.”). *See also 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.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

I. Similarity or dissimilarity and nature of the services.

Registrant’s description of services is “Retail apparel stores; Retail furniture stores; Retail gift shops; Retail variety stores; Referrals in the field of hunting and outdoor gear; Retail gift shops [sic].”

“Under standard examination practice, a semicolon is used to separate distinct categories of goods or services.” *In re Midwest Gaming & Entm’t LLC*, 106 USPQ2d 1163, 1166 (TTAB 2013) (citing TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1402.01(a) (2018) (“commas should be used in the identification to separate items within a particular category of goods or services” and semicolons “should generally be used to separate distinct categories of goods or services within a single

class.”).³ We find that here, the semicolons in Registrant’s identification separate Registrant’s “Referrals in the field of hunting and outdoor gear” into a discrete category of services that is neither connected to nor dependent on “Retail apparel stores,” “Retail furniture stores,” “Retail gift shops,” or “Retail variety stores.” We further find that Registrant’s “Retail apparel Stores” and “Retail furniture stores” as separately set out in the identification of services by means of the semicolons, stand alone, and are an independent basis for our likelihood of confusion findings under the second and third *DuPont* factors.

Therefore, Registrant’s description of services includes, inter alia, retail apparel stores and retail furniture stores without any restrictions or limitations as to the type of apparel or furniture. Likewise, Applicant is seeking to register its mark for, inter alia, retail store services featuring apparel and furniture without any limitation or restriction as to the type of apparel or furniture. Accordingly, we find that the services are in part identical.

Under this *DuPont* factor, the Examining Attorney need not prove, and we need not find, similarity as to each activity listed in the description of services. It is sufficient for a refusal based on likelihood of confusion that we find any activity

³ The TMEP gives the following example:

For example, “cleaners, namely, glass cleaners, oven cleaners, and carpet cleaners; deodorants for pets” is an acceptable identification in Class 3. In this example, the word “cleaners” names the category covering “glass cleaners, oven cleaners, and carpet cleaners.” The semicolon prior to “deodorants for pets” indicates that the deodorants are a separate category of goods from the cleaners.

encompassed by the identification of services in a particular class in the application and registration related. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015), *aff'd* 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (“it is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application.”).

Applicant contends that the services are not related because the types of goods sold by Applicant and Registrant in their retail stores are “very different.”⁴

Applicant’s retail services as listed on the application are for a highly specific type of goods; namely Western-themed merchandise including clothing, boots, and tack supplies, and other related home furnishings. The registered mark’s application identifies the relevant services as “retail variety stores; hunting and outdoor gear and gift shops.” The types of stores and merchandise are unrelated, and as a result, there is little chance that someone looking for Applicant’s merchandise would be in danger of confusing the two sources when the Registrant is selling generic gifts and hunting supplies. In short, the relevant goods and services are not similar and are marketed to two distinctive, niche markets: hunting and gifts versus western themed home furnishings and tack supplies. These niche-market goods are not the type that a discerning hobbyist would confuse.⁵

The problem with Applicant’s contention is that we must consider the services as Applicant and Registrant describe them in the application and registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d

⁴ Applicant’s Brief, p. 8 (9 TTABVUE 9).

⁵ *Id.* at pp. 8-9 (9 TTABVUE 9-10).

1157, 1161 (Fed. Cir. 2014); *Octocom Sys, Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“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.”); *Paula Payne Prods. v. Johnson Publ’g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods”). Notwithstanding Applicant’s argument and evidence regarding the actual scope of its own and the cited Registrant’s commercial use of its mark, we may not limit, by resort to extrinsic evidence, the scope of the services as identified in the cited registration or in the subject application. *E.g.*, *In re Dixie Restaurants Inc.*, 41 USPQ2d at 1534; *In re Fisher Scientific Co.*, 440 F.2d 43, 169 USPQ 436, 437 (CCPA 1971); *In re La Peregrina Ltd.*, 86 SPQ2d 1645, 1646 (TTAB 2008); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986). As noted above, neither Applicant’s retail store services featuring apparel and furniture, nor Registrant’s retail apparel stores and retail furniture stores, are restricted or limited to any particular type of apparel or furniture.

II. Established, likely-to-continue channels of trade and classes of consumers.

Because the services described in the application and the cited registration are in part identical, we presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir.

2012) (identical goods are presumed to travel in same channels of trade to same class of purchasers) (cited in *Cai v. Diamond Hong*, 127 USPQ2d at 1801 (“With respect to similarity of the established trade channels through which the goods reach customers, the 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....”)); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1745 (TTAB 2018), *aff’d mem.* (No. 18-2236) (Fed. Cir. September 13, 2019) (“Because the services described in the application and the cited registration are identical, we presume that the channels of trade and classes of purchasers are the same.”).

Again, Applicant contends, “the markets are entirely different – western themed home furnishings and tack versus hunting supplies and gift shops.”⁶ However, because the description of services do not include those restrictions or limitations as to channels of trade, we may not read those restrictions into them. *See In re i.am.symbolic, LLC*, 123 USPQ2d at 1748 (“It is well established that the Board may not read limitations into an unrestricted registration or application.”); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) (“There is no specific limitation and nothing in the inherent nature of Squirtco’s mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board,

⁶ Applicant’s Brief, p. 9 (9 TTABVUE 10).

thus, improperly read limitations into the registration”); *In re Thor Tech*, 90 USPQ2d 1634, 1638 (TTAB 2009) (“We have no authority to read any restrictions or limitations into the registrant’s description of goods.”). Therefore, we must presume that Registrant offers its retail apparel and furniture stores and Applicant offers its retail stores featuring apparel and furniture in all channels of trade and to all classes of consumers interested in apparel and furniture.

III. Conditions under which sales are made.

Applicant asserts that the customers for Applicant’s “Western culture and horseback riding” products and Registrant’s “hunting” products exercise a high degree of consumer care.⁷ This argument is unavailing, as there is no restriction or limitation in the respective descriptions of services restricting Applicant’s retail store services to “Western culture and horseback riding” and Registrant’s retail store services to “hunting.”⁸ *See In re Bercut-Vandervoort & Co.*, 229 USPQ at 764 (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration).

We find this *DuPont* factor to be neutral.

⁷ Applicant’s Brief, p. 10 (9 TTABVUE 11).

⁸ *Id.*

IV. The lack of any reported instances of actual confusion.⁹

Applicant argues that because Applicant has used its mark since 1976 and Registrant claims use since 2016, there has been nearly four years with no instances of any marketplace confusion.¹⁰ Even if that is true, the absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a significant period in the same markets as those served by Registrant under its marks. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to occur. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown Am. Enter. Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. N. Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) (“[T]he absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring.”).

⁹ Our analysis of the lack of any reported instances of confusion includes *DuPont* factor 7 (the nature and extent of any confusion) and *DuPont* factor 8 (the length of time during and conditions under which there has been concurrent use without evidence of actual confusion).

¹⁰ Applicant's Brief, p. 12 (9 TTABVUE 13).

As noted above, we base our analysis as to the second, third, and fourth *DuPont* factors, discussing the similarity or dissimilarity of the services, channels of trade, and relevant consumers, as dictated by precedent from the Federal Circuit, on the identifications as set forth in the application and the cited registration. *See Stone Lion*, 110 USPQ2d at 1162. As such, we may not consider, in assessing these *DuPont* factors, evidence of how Applicant and Registrant are actually rendering their services in the marketplace. *Id.*

The seventh and eighth *DuPont* factors, by contrast — “[t]he nature and extent of any actual confusion” and “[t]he length of time during and conditions under which there has been concurrent use without evidence of actual confusion,” *see DuPont*, 177 USPQ at 567 — requires us to look at actual market conditions, to the extent there is evidence of such conditions of record. In this regard, we consider all of the evidence of record that may be relevant to the seventh and eighth *DuPont* factors. *See In re Gould Mortg. Co.*, 2020 USPQ2d 10279 *6, 2020 BL 120829 *6 (TTAB 2020).

Applicant’s lack of testimony and evidence regarding the extent of its sales, advertising and marketing, as well as the extent of Registrant’s sales, advertising and marketing, prevents us from determining whether there has been a reasonable opportunity for confusion to occur. In fact, counsel’s contention that the parties market their services in entirely different markets weighs against finding that there has been a reasonable opportunity for confusion to occur because if the retail store services of Applicant and Registrant are offered in different channels of trade to different classes of consumers, then the same consumers will not encounter both

marks under circumstances likely to give rise the mistaken belief that the services emanate from the same source.

Finally, in this *ex parte* context, there has been no opportunity to hear from Registrant about whether it is aware of any reported instances of confusion. We therefore are getting only half the story. *See, e.g., In re Opus One, Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001) (“The fact that an applicant in an *ex parte* case is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis, inasmuch as the Board in such cases generally has no way to know whether the registrant likewise is unaware of any instances of actual confusion, nor is it usually possible to determine that there has been any significant opportunity for actual confusion to have occurred.”) (citations omitted); *In re Wilson*, 57 USPQ2d 1863, 1869 (TTAB 2001) (“[I]nasmuch as we have heard from neither registrant nor the Highland Orange Association in this appeal, we cannot conclude that, in fact, no instances of actual confusion ever occurred.”); *In re Cruising World, Inc.*, 219 USPQ 757, 758 (TTAB 1983) (“Concerning the lack of actual confusion argument, in an *ex parte* hearing where only the applicant’s position is expressed and there is no way to assess what the experience of the registrant has been, it is impossible to conclude that actual confusion has never occurred.”). This constraint inherent in the *ex parte* context necessarily limits the potential probative value of evidence bearing on the seventh and eighth *DuPont* factors, compared with an *inter partes* proceeding, where the registrant has an opportunity to present argument and evidence in response.

Upon full consideration of the record, we find these *DuPont* factors to be neutral.

V. The similarity or dissimilarity of the marks.

We now turn to the *DuPont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d at 1746 (quoting *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).

In comparing the marks, we are mindful that where, as here, the services are in part legally are identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Prod. Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai*, 127 USPQ2d at 1801 (quoting *Coach Servs.*, 101 USPQ2d at 1721). See also *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685

F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd mem.*, 972 F.2d 1353 (Fed. Cir. 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *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). Because the services at issue are retail apparel and furniture store services, the average customer is an ordinary consumer.

Applicant is seeking to register the mark ROD'S in standard character form and the mark in the cited registration is ROD'S AMERICAN MARKET PUTTING AMERICA BACK TO WORK and design, reproduced below:



While the registered mark has a distinctive design element, the dominant part of the mark is the words ROD'S AMERICAN MARKET because that is how consumers will refer to Registrant's services and remember them. Although we assess each mark in its entirety, wording often is considered the dominant feature of a mark comprising

both literal and design elements because it is most likely to indicate the source of the services. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 982 (2016) 1908 (“the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.”); *In re Viterra Inc.*, 101 USPQ2d at 1908 (same). There is nothing improper in stating that, for rational reasons, we give more or less weight to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re Viterra Inc.*, 101 USPQ2d at 1908; *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

With respect to the term ROD’S AMERICAN MARKET, the name “Rod’s” is the dominant element of the name of Registrant’s store(s) because the term “American Market” is descriptive. It is well settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 41 USPQ2d at 1533-34); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re Nat’l Data Corp.*, 224 USPQ at 752); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

Further reinforcing the importance of the name “Rod’s” in ROD’S AMERICAN MARKET is “Rod’s” location as the first word of the term. As we often have held, the lead element in a mark has a position of prominence; consumers are likely to notice and remember the lead element and, thus, it plays a dominant role in the mark. *See In re Detroit Athletic Co.*, 128 USPQ2d at 1049 (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”); *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of Am.*, 23 USPQ2d at 1700 (upon encountering the marks, consumers will first notice the identical lead word); *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016) (noting that the dominance of BARR in the mark BARR GROUP is reinforced by its location as the first word in the mark); *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”).

While we do not ignore the impact that “Putting America Back To Work” has on the way the cited mark looks and sounds, we find that its visual impression is considerably smaller than the other elements of the mark, and that its meaning reinforces the meaning conveyed by the disclaimed term “AMERICAN MARKET,” and so does not alter the dominance of ROD’S in creating the overall commercial

impression of the cited mark. Because the dominant element of Applicant's mark is essentially identical to the dominant element of the cited mark, we find that the parties' marks are similar when considered in their entirety.

In this appeal, the dominant part of Registrant's mark ROD'S is the entirety of Applicant's mark. Thus, Registrant's mark incorporates Applicant's entire mark. While there is no explicit rule that we must find marks similar where the registrant's mark incorporates the entirety of an applicant's mark, the fact that Registrant's mark subsumes Applicant's mark increases their similarity. *See In re Mighty Leaf Tea*, 601 USPQ2d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (applicant's mark ML is similar to opposer's mark ML MARK LEES both for personal care and skin products); *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660 (TTAB 2014) (applicant's mark PRECISION is similar to opposer's mark PRECISION DISTRIBUTION CONTROL). *See also Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967) (THE LILLY as a mark for women's dresses is likely to be confused with LILLI ANN for women's apparel including dresses); *In re U.S. Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (CAREER IMAGE for women's clothing stores and women's clothing likely to cause confusion with CREST CAREER IMAGES for uniforms including items of women;s clothing).

We find that Applicant's mark ROD'S is similar to Registrant's mark ROD'S AMERICAN MARKET PUTTING AMERICA BACK TO WORK and design in terms of appearance, sound, connotation and commercial impression.

VI. Conclusion

Because the marks are similar, the services are in part identical and there is a presumption that the services are offered in the same channels of trade to the same classes of consumers, we find that Applicant's mark ROD'S for, inter alia, retail store services featuring apparel and furniture is likely to cause confusion with the registered mark ROD'S AMERICAN MARKET PUTTING AMERICA BACK TO WORK and design for, inter alia, "Retail apparel stores; Retail furniture stores."

Decision: The refusal to register Applicant's mark ROD'S is affirmed.

Bergsman, Administrative Trademark Judge, additional views.

With respect to the similarity or dissimilarity of the marks, another reason that the name "Rod's" is the dominant part of Registrant's mark is that consumers are likely to refer to ROD'S AMERICAN MARKET PUTTING AMERICA BACK TO WORK and design as "Rod's." In another words, common sense dictates that when someone asks where are you going shopping, a consumer is likely to say "Rod's," rather than ROD'S AMERICAN MARKET. "[U]sers of language have a universal habit of shortening full names – from haste or laziness or just economy of words. Examples are: automobile to auto; telephone to phone; necktie to tie; gasoline service station to gas station." *In re Abcor Dev. Corp.*, 588 F.2d 511, 200 USPQ 215, 219 (CCPA 1978) (J. Rich, concurring) (explaining that it is "inevitable" that consumers will call a gas monitoring badge a gas badge).

[C]ompanies are frequently called by shortened names, such as Penney's for J.C. Penney's, Sears for Sears and Roebuck (even before it officially changed its name to Sears

alone), Ward's for Montgomery Ward's, and Bloomies for Bloomingdales.

Marshall Field & Co. v. Mrs. Fields Cookies, 25 USPQ2d 1321, 1333 (TTAB 1992).
See also In re Mighty Leaf Tea, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (“ML is likely to be perceived as a shortened version of ML MARK LEES when used on the same or closely related skin care products.”); *In re Bay State Brewing*, 117 USPQ2d 1958, 1961 (TTAB 2016) (holding it is reasonable for consumers to drop the highly descriptive term “Blonde” when calling for TIME TRAVELER BLONDE beer); *Big M Inc. v. The U.S. Shoe Co.*, 228 USPQ 614, 616 (TTAB 1985) (“[W]e cannot ignore the propensity of consumers to often shorten trademarks and, in the present case, this would be accomplished by dropping the ‘T.H.’ in referring to registrant’s stores [T.H. MANDY].”); *Nina Ricci S.A.R.L. v. Haymaker Sports, Inc.*, 134 USPQ 26, 28 (TTAB 1962) (“it is common knowledge that various couturiers such as Christian Dior, Huber de Givenchi, and Jacques Fath are frequently referred to by their surnames alone.”). Likewise, Applicant’s mark ROD’S is likely to appear to be a shortened form of Registrant’s ROD’S AMERICAN MARKET and consumers will not include the advertising tagline “Putting America Back To Work” when referring to Registrant’s services.