

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: May 19, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Outdoor Cap Company, Inc.

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Serial No. 88013497

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Mark G. Kachigian of Head, Johnson, Kachigian, & Wilkinson PC,
for Outdoor Cap Company, Inc.

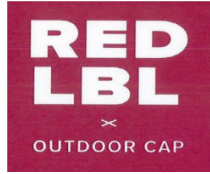
Tarah Hardy Ludlow, Trademark Examining Attorney, Law Office 110,
Chris A. F. Pedersen, Managing Attorney.

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Before Wellington, Kuczma and Johnson,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Outdoor Cap Company, Inc. (“Applicant”) seeks registration on the Principal Register of the mark shown below for “headwear” in International Class 25:¹

¹ Application Serial No. 88013497 filed on June 25, 2018, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a bona fide intention to use the mark in commerce. The mark is described in the application as consisting of a red rectangle containing the wording "RED LBL X OUTDOOR CAP" in white; the colors red and white are claimed as features of the mark.



The terms LBL and CAP are disclaimed and Applicant asserted a claim of acquired distinctiveness, in part, as to OUTDOOR CAP.

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as applied to headwear, so resembles the registered mark:



for "shirts; t-shirts" in International Class 25,² on the Principal Register, as to be likely to cause confusion, to cause mistake, or to deceive.

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567

² Registration No. 5417831, issued March 6, 2018. The mark is described in the registration as "consist[ing] of the stylized words RED and LABEL above an arrow pointing to the upper left corner."

(CCPA 1973) (“*DuPont*”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor for which there is evidence and argument of record. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

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) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the relatedness of the goods. *See In re Chatam Intl 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 Intl, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. The similarity or dissimilarity of the marks

Under the first *DuPont* factor, we compare Applicant's mark with the cited registered mark "in their entirety as to appearance, sound, connotation and commercial impression." *In re Viterra*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *DuPont*, 177 USPQ at 567); see also *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. Johns, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff'd mem.*, 777 F. App'x (Fed. Cir. 2019). (citation omitted). *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 in a side-by-side comparison, but instead whether their overall commercial impressions are so similar that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quotation omitted). 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, 3 (CCPA 1977)). The proper focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *St. Helena Hosp.*, 113

USPQ2d at 1085; *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971). In this case, the average purchaser is anyone in the general public shopping for apparel.

Here, we find the marks are overall similar because they share virtually the same dominant element, RED LABEL or its near equivalent RED LBL. That is, in viewing Applicant's mark, it is the stylized literal term RED LBL that appears at the top in much larger lettering whereas the remaining words, OUTDOOR CAP, appear at the bottom in significantly smaller letters. Inasmuch as LBL is a recognized abbreviation for the word "label," it will likely be pronounced like the word when verbalized.³ Applicant's claim that the colors red and white are features of its mark does little to distinguish it from the cited registered mark which does not claim any color as a feature and thus may appear in a similar color scheme.

As already noted, Applicant made a Section 2(f) claim of acquired distinctiveness, in part, as to the wording OUTDOOR CAP in its mark.⁴ While this wording may have acquired distinctiveness for Applicant's headwear, we again point out its diminutive

³ In requiring a disclaimer of LBL, the Examining Attorney attached evidence to the first Office Action showing that this term is a known abbreviation for "label." Office Action dated October 15, 2018, at TSDR p. 7 (printout from "Acronym Finder" website, www.acronymfinder.com).

Citations to the prosecution file refer to the USPTO Trademark Status & Document Retrieval ("TSDR") system and identify documents by title and date. Specific citations are to the page number in the .pdf version of the TSDR records. References to the briefs and other materials in the appeal record refer to the Boards TTABVUE docket system.

⁴ See Response to Office Action filed on February 6, 2019 (claim made based on alleged five years of substantially exclusive and continuous use in commerce of OUTDOOR CAP and ownership of Reg. No. 2054435 for OUTDOOR CAP). The Examining Attorney accepted this claim in the Office Action issued on February 12, 2019.

presence in the overall mark. We further note that the disclaimed term CAP, by itself, is generic for headwear.⁵ Likewise, OUTDOOR describes an intended use for the goods, i.e., caps for wearing outdoors.⁶ For these reasons, we find consumers are less likely to focus on the additional wording OUTDOOR CAP, even if these two words have acquired distinctiveness as a unit. In sum, viewing Applicant's mark in its entirety, we find RED LBL certainly makes the strongest impression on consumers encountering this mark and is more likely to be retained in their memories.

Similarly, as to the cited registered mark, the sole literal portion, RED LABEL (stylized with the letter E facing backward), dominates this mark visually, aurally and in terms of conveying a commercial impression. The backward-facing letter E will not prevent consumers from identifying and perceiving the word LABEL, nor does this alter the meaning conveyed by this word. Although there is a large stylized arrow that appears below this wording in the registered mark, we also keep in mind that with marks "consisting of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used to request the goods." *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *In re Viterra Inc.*, 101 USPQ2d at 1908). For instance, in this case, consumers familiar with the registered mark are likely to use the wording "Red Label" when calling for or referring to the

⁵ Definition of word "cap" showing the term means "a head covering especially with a visor and no brim," attached to Office Action issued October 15, 2019, at TSDR p. 30.

⁶ Definition of word "Outdoor" showing the term means "of or relating to outdoors," attached to Office Action issued October 15, 2019, at TSDR p. 24.

goods rather than trying explaining a backward letter E or attempting to verbalize the arrow design. *See In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (Board held “if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services” and “because applicant’s mark shares with registrant’s mark that element responsible for creating its overall commercial impression, the marks are confusingly similar.”).

In terms of connotation or commercial meaning, the wording which we find dominates the two marks, RED LBL in Applicant’s mark and its near equivalent RED LABEL in the registered mark, may be understood by consumers as suggestive of a red colored label (or tag) that is placed on the goods, respectively, headwear and shirts. In this regard, we further note the Examining Attorney required the entered disclaimer of LBL because it is an abbreviation for “label,” being defined as “the brand name of a retail store selling clothing, a clothing manufacturer, or a fashion designer.”⁷

Viewing the marks in their entirety, as we must, we find they are overall more similar than not. The two marks are aurally very similar and possess an overall very similar commercial impression based on the near identical elements that begin and dominate each mark. This outweighs the points of dissimilarity between the marks. Accordingly, this *DuPont* factor supports a finding of a likelihood of confusion.

⁷ See Note 3.

B. Purported Weakness of RED LABEL

In its brief, Applicant acknowledges that the Examining Attorney “has correctly identified that the Applicant’s mark and the Registrant’s mark share the word term RED and share the similar terms LBL or LABEL.”⁸ However, Applicant argues that this “common element” is weak because of the “presence of all of the other “RED LABEL type marks in the same or closely related field” and therefore the cited mark is entitled “only to the narrowest and most limited scope of protection.”⁹ In support, Applicant relies on a printout from the USPTO’s Trademark Electronic Search System (TESS) database listing third-party applications and registrations with the term RED LABEL.¹⁰

Third-party registrations may not be made of record by merely listing them in response to an Office Action. See TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 1207.03 and 1208.02 (June 2019) and cases cited therein. Rather, “[i]t is well-established that in order to make third-party registrations properly of record, ‘applicant should submit copies of the registrations themselves, or the electronic equivalent thereof from the USPTO’s electronic databases.’ *In re City of Houston*, 101 USPQ2d 1534, 1536 n.5 (TTAB 2012) (quoting *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1560 n.6 (TTAB 1996)). However, we will consider the list in view of the facts that the Examining Attorney did not object to the list nor

⁸ 4 TTABVUE 9.

⁹ *Id.* at 8.

¹⁰ Attached to Responses to Office Actions filed February 6, 2018, and May 28, 2019.

inform Applicant that it could cure the insufficiency by submitting copies of the registrations prior to filing its appeal. *See* TBMP § 1208.02 (under such circumstances, “the examining attorney will be deemed to have waived any objection to consideration of the list itself”).

Although the list of applications and registrations is of record, we hasten to point out that “the Board will not consider more than the information provided by the applicant” and “if the applicant has provided only a list of registration numbers and/or marks, the list will have very limited probative value.” *Id.* We further point out that third-party applications, as opposed to registrations, have no probative value other than as evidence that the applications were filed. *Id.*

The list submitted by Applicant only provides the serial or registration numbers of the applications and registrations, the wording in the marks, and whether they are live or dead. Put simply, this list does not support Applicant’s contention that there are other registered marks with the term RED LABEL for goods “in the same or closely related field.” *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (disregarding third-party registrations for other types of goods where the proffering party had neither proven nor explained that they were related to the goods in the cited registration). Accordingly, on this record, we do not find that RED LABEL is weak in connection with shirts or hats.

C. Relatedness of the Goods, Their Trade Channels and Classes of Purchasers

We now consider the relatedness of the goods, their trade channels and the classes of purchasers. In doing so, we make our determination based on the goods as they are identified in the application and cited registration. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *see also 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 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

As to the relatedness of the goods, in particular, “[t]his factor considers whether ‘the consuming public may perceive [the respective goods of the parties] as related enough to cause confusion about the source or origin of the goods and services.’” *St. Helena Hosp.*, 113 USPQ2d at 1086 (quoting *Hewlett Packard*, 62 USPQ2d at 1004). It is not necessary that the respective goods be identical or even competitive in order to find that they are related. The respective goods need only be “‘related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

Again, the application is for “headwear” and the cited registration covers “shirts.”

In support of the refusal, the Examining Attorney attached copies of approximately 40 third-party registrations, each registration covering the same types

of goods identified in the involved application and cited registration, namely, shirts and headwear.¹¹ In addition to any inherent relationship of these goods given they are both articles of apparel, these use-based registrations help establish that the involved goods are of a type which may emanate from a single source. *See In re RiseSmart, Inc.*, 104 USPQ2d 1931, 1934 (TTAB 2012) (citing *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993)). Furthermore, the Examining Attorney also entered into the record Internet evidence showing various online retailers offering both headwear (caps) and shirts (mainly t-shirts) under the same brand or house mark.¹² While it may be obvious that headwear and shirts will be found in the same retail clothing stores, the printouts from various online retail clothing outlets that the Examining Attorney submitted actually show these goods flowing through identical trade channels and offered to the general public under the same marks.

Based on the aforementioned evidence, we find that Applicant's headwear is closely related to Registrant's shirts and these goods may be offered in the same trade channels to the same types of purchasers. Accordingly, these *DuPont* factors favor finding confusion likely.

¹¹ See October 15, 2018 Office Action, TSDR pp. 36–63; February 12, 2019 Office Action, TSDR, pp. 2–50; and May 30, 2019 Office Action, TSDR pp. 3–27.

¹² See February 12, 2019 Office Action, TSDR pp. 51–85; and May 30, 2019 Office Action, TSDR pp. 28–52.

D. Summary and Conclusion

After considering all of the arguments and evidence of record as they pertain to the relevant *DuPont* factors, we find that Applicant's mark, RED LABEL OUTDOOR CAP (stylized with design) is similar to Registrant's mark, RED LABEL (stylized with design), and because Applicant's headwear and Registrant's shirts are related and may travel through the same channels of trade and be available to same classes of purchasers, there is a likelihood of confusion between the marks.

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