

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

Mailed: September 30, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*Boot Royalty Company, L.P.*

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Serial No. 88727081

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David Chen of IP Attorneys Group LLC for Boot Royalty Company, L.P.

Marc J. Leipzig, Trademark Examining Attorney, Law Office 115,  
Daniel Brody, Managing Attorney.

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Before Taylor, Wellington, and Dunn, Administrative Trademark Judges.

Opinion by Dunn, Administrative Trademark Judge:

Applicant, Boot Royalty Company, L.P., seeks registration on the Principal Register of the mark shown below for “insoles, footwear” in International Class 25.<sup>1</sup>

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<sup>1</sup> Application Serial No. 88727081 was filed December 13, 2019, 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.

References to the application are to the downloadable .pdf version of documents available from the TSDR (Trademark Status and Document Retrieval) database. The TTABVue citations refer to the Board’s electronic docket, with the first number referring to the docket entry and the second number, if applicable, referring to the page within the entry.



The application states “The mark consists of the term ‘R2G’ within an oval, where the ‘2’ features an arrow design on the lower-right portion of the number. The wording ‘ROOM 2 GROW’ appears upon a chevron-shaped banner below the oval.”

The Trademark Examining Attorney has 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 ROOM TO GROW (in standard characters), registered on the Principal Register for “charitable services, namely the collection and distribution to the needy of clothing and other usable goods,” in International Class 42,<sup>2</sup> as to be likely to cause confusion, mistake or deception.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed.

We reverse the refusal to register.

### **I. Preliminary Matter**

In its brief Applicant refers to matter located at Respondent’s website (6 TTABVue 13) and six third party registrations (five cancelled) attached to its brief

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<sup>2</sup> Registration No. 2384143 issued September 5, 2000; renewed.

(6 TTABVUE 15-16, 20-26). We sustain the Examining Attorney’s objections to the evidence. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), provides that “[t]he record in an application should be complete prior to the filing of an appeal” and “[e]vidence should not be filed with the Board after the filing of a notice of appeal.” Evidence that Applicant did not submit during prosecution is untimely and will not be considered. *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018), *aff’d mem.*, 777 F. App’x. 516 (Fed. Cir. 2019).

## **II. 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. (DuPont)*, 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). We consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

### **A. Similarities between the Marks**

We consider Applicant’s mark  and the registered standard character mark ROOM TO GROW, and compare them “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve*

*Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). Although we consider the marks as a whole, “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. . . .” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The marks also “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 consumer, who retains a general rather than specific impression of the marks. *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018). *Accord Grandpa Pidgeon’s of Mo., Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973) (noting that the marks in question had “a difference not likely to be recalled by purchasers seeing the marks at spaced intervals”). Here, because the goods and services at issue are footwear and charitable services collecting and distributing clothing and other usable goods to the needy, the average customer is an ordinary consumer who wears and donates clothing and usable goods, including footwear.

Considering Applicant’s mark as a whole, we find the dominant commercial




impression of the mark is created by the large and stylized characters R2G and design. In addition to being some two or three times larger than the wording

below, the large and stylized characters R2G and design are the first part of the mark encountered by the eye or the ear. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison 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). Moreover, the large and stylized characters R2G suggest the phrase which follows (ROOM 2 GROW), but the characters are fanciful as applied to Applicant’s footwear and insoles. *Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1181 (Fed. Cir. 2004) (defining a fanciful mark as “a non-dictionary word concocted by the trademark holder for its product” and observing that such marks are typically strong); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 n.18 (TTAB 2014) (“Whether AKEA is a coined term or a Sardinian greeting, it is an inherently strong mark.”).

We address the Examining Attorney’s argument that the registered mark ROOM




TO GROW essentially is incorporated in Applicant’s mark . While not always the case, “[l]ikelihood of confusion often has been found where the entirety of one mark is incorporated within another.” *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660 (TTAB 2014) (Opposer’s mark PRECISION DISTRIBUTION CONTROL contains the entirety of Applicant’s mark PRECISION). We find the substitution of the numeral “2” in Applicant’s mark for the word “to” in the registered mark does not alter the commercial impression of the phrases ROOM 2 GROW and ROOM TO GROW, which is the same. The use of numbers or special characters to

represent letters is often inconsequential to the sound and meaning of a word. *See In Home Federal Savings and Loan Association*, 213 USPQ 68, 69 (TTAB 1982) (applicant's mark TRAN\$FUND is similar to TRANSFUND). *See also In re ING Direct Bancorp*, 100 USPQ2d 1681, 1687 (TTAB 2011) ("to the extent applicant is claiming that its replacing the preposition 'to' with the numeral '2' ("person-2-person") is so unique in this [e-finance] field as to take away the genericness of 'person-to-person,' we also disagree.").

However, despite these similarities, the relatively insignificant display of ROOM 2 GROW in Applicant's mark, and the different connotation the term has when



applied to Applicant's goods, persuade, us that  does not create a similar overall commercial impressions to the registered mark ROOM TO GROW.

When the term ROOM TO GROW is used in connection with the registered charitable services for distributing clothing and other usable goods to the needy, we agree with Applicant that it connotes that the donation may, in general, provide room for growth because the donation means the recipient is not confined to doing without such donated items, or having to obtain them on their own. Applicant calls this the "figurative connotation" of the words."<sup>3</sup> We also agree with Applicant that when ROOM 2 GROW is used on footwear and insoles, it connotes goods "designed to provide wearers with room for their feet to grow. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) ("Opposer's

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<sup>3</sup> 6 TTABVUE 13.

COACH mark, when applied to fashion accessories is clearly either arbitrary or suggestive of carriage or travel accommodations [e.g., stagecoach, train, motor coach, etc.] thereby engendering the commercial impression of a traveling bag [e.g., a coach or carriage bag] On the other hand, applicant's COACH marks call to mind a tutor who prepares a student for an examination.”).

Considering the marks in their entireties, while they have some similarities in



terms of appearance and sound, we find that Applicant's mark provides a different connotation when applied to footwear and insoles than the mark ROOM TO GROW provides when applied to charitable services. The difference in connotation of the common term, in combination with the addition of large stylized characters against a background design in Applicant's mark, results in two marks which create overall different commercial impressions. We accordingly weigh the *DuPont* factor concerning the similarities between the marks against finding likelihood of confusion.

#### **B. Relationship between the Goods and Services**

With regard to the relationship between Applicant's goods and the services in the cited registration, we must make our determination based on the goods and services as they are identified in the application and cited registration. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017). In assessing the similarity or dissimilarity and nature of the goods, the Board “considers whether ‘the consuming public may perceive [the respective goods or services of the parties] as related enough to cause confusion about the source or origin of the goods

and services.” *In re St. Helena Hosp.*, 113 USPQ2d at 1086 (quoting *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002)). The issue is not whether the goods and services will be confused with each other, but rather whether the public will be confused as to their source. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000).

As stated, Applicant seeks registration of its mark for “insoles, footwear” and the registered mark is used on “charitable services, namely the collection and distribution to the needy of clothing and other usable goods.” We acknowledge that there is evidence of record showing six entities that manufacture footwear also donate some of their goods, e.g., to healthcare workers, or have a charitable program involving the collection and distribution of footwear.

The shoe manufacturer Crocs issued a press release announcing their “Free Pair for Healthcare” program to donate up to 10,000 pairs of shoes per day to individual healthcare workers across the United States and to donate 100,000 pairs of shoes to be distributed through healthcare facilities and organization.<sup>4</sup> Similarly, the shoe and insole manufacturer Dr. Scholl’s issued a press release announcing their donation of \$1.3 million in insoles to support healthcare workers on the front lines of the COVID-19 response.<sup>5</sup>

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<sup>4</sup> September 8, 2020 Office Action TSDR 15-16.

<sup>5</sup> September 8, 2020 Office Action TSDR 25.



The website for the sock manufacturer and retailer Bombas has a “Giving back” webpage which shows the company also donates socks to the needy:<sup>6</sup>



Bombas was founded on the philosophy of donating socks to those in need, but has evolved to go deeper into the community. The more clothing items we sell, the more we donate. As we grow, our giving and community efforts will continue to grow right alongside us. One purchased = one donated.

The shoe manufacturer and retailer UGG issued a press release announcing their \$1 million donation plan to donate 500 pairs of slippers a week to coronavirus caregivers, to stock hotel rooms put aside for exhausted caregivers with Ugg robes and slippers, and to give away footwear to the 145 workers coordinating the COVID-19 response of the Sansum Clinic in Ugg’s hometown of Santa Barbara, California.<sup>7</sup>

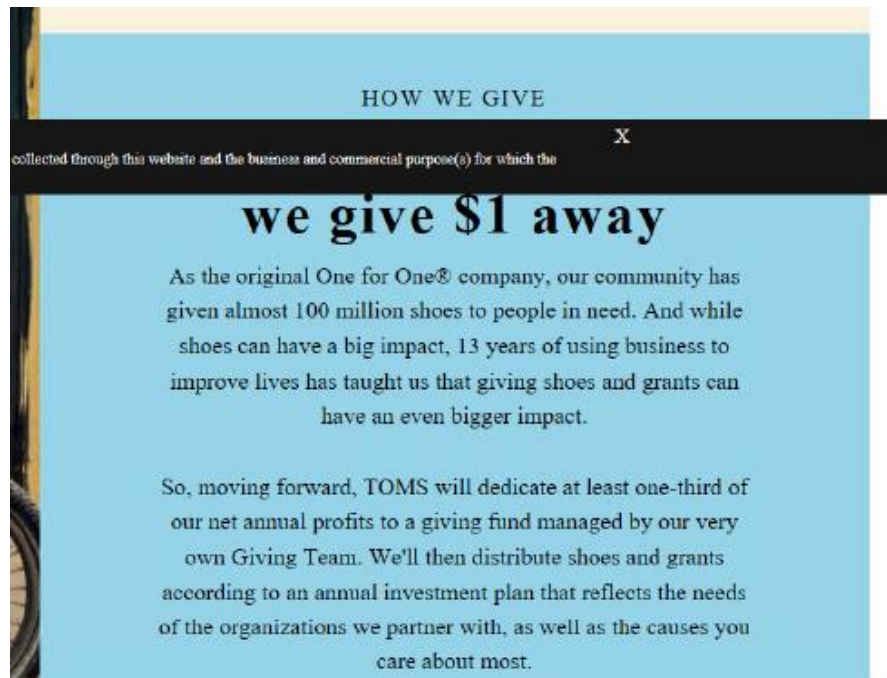
The website for the shoe manufacturer and retailer TOMS has an “Impact” webpage which shows the company also donates shoes to the needy:<sup>8</sup>

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<sup>6</sup> February 11, 2020 Office Action TSDR 14. We take judicial notice that the term “footwear” that appears in Applicant’s identification of goods is defined as “wearing apparel (such as shoes or boots) for the feet,” and so includes socks. *Merriam-Webster.com Dictionary*, <https://www.merriam-webster.com/dictionary/footwear>. Accessed 26 Sep. 2021. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).

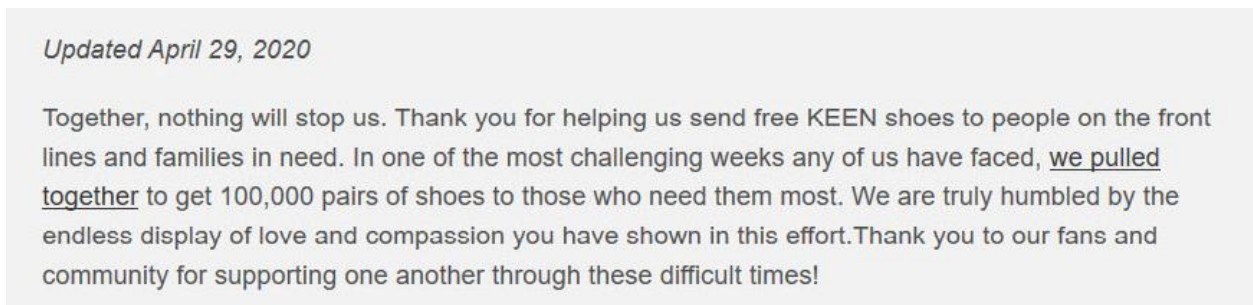
<sup>7</sup> September 8, 2020 Office Action TSDR 10-12.

<sup>8</sup> February 11, 2020 Office Action TSDR 29.



Excerpts from TOMS Giving back webpage

The website for the shoe manufacturer and retailer Keen Footwear has a “Taking Action” webpage which shows the company also donates shoes to the needy:<sup>9</sup>



The website for the shoe manufacturer and retailer Skechers has a “Community” webpage which shows the company also donates shoes to the needy:<sup>10</sup>

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<sup>9</sup> September 8, 2020 Office Action TSDR 7.

<sup>10</sup> September 8, 2020 Office Action TSDR 18-19.



Since 2012, Skechers has donated more than 15.8 million pairs of new shoes to children in need worldwide through its BOBS charity program. The shoes support Head Start programs, education foundations, homeless shelters, disaster relief and 501(c)(3) nonprofit organizations.

Shop BOBS



*Excerpt from Skechers Community webpage*

While this shows several shoe (or sock) companies involved in the donation of their goods, either directly or through a program, it fails to show the necessary relationship between Applicant's footwear and the registered charitable services.

If the registered services were identified as collecting and distributing footwear to the needy, this evidence of shoe manufacturers donating footwear to the needy might well be sufficient to show the necessary relationship to footwear. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (confusion likely because "the Detroit Athletic Club's clothing goods are 'very general' in nature and cover 'all types of clothing,' including the clothing sold through DACo's sports apparel retail services."). However, Registrant's charitable services are much more broadly worded, and encompass the collection and distribution to the needy of a host of goods,

namely “clothing and other usable goods.” While “usable goods” may include footwear, we think this circumstance of charitable services donating a variety of goods is analogous to a supermarket or a department store selling a wide variety of goods, and every item sold or donated is not necessarily “related” to the charitable or supermarket service for the purposes of likelihood of confusion. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“A wide variety of products, not only from different manufacturers within an industry but also from diverse industries, have been brought together in the modern supermarket for the convenience of the customer. The mere existence of such an environment should not foreclose further inquiry into the likelihood of confusion arising from the use of similar marks on any goods so displayed.”).

More specifically, the record does not support a finding that the donor to, or beneficiary of, registrant’s charitable services providing clothing and “usable goods” who encounters Applicant’s footwear and insoles is likely to believe the charitable service and footwear emanate from the same source. *See In re St. Helena Hosp.*, 113 USPQ2d at 1087 (“the PTO has not shown that St. Helena’s [health care services, namely, evaluating weight and lifestyle health and implementing weight and lifestyle health improvement plans in a hospital-based residential program] and the ’657 Registration’s printed materials are generally recognized as being related, nor has it shown “something more” to establish relatedness in the circumstances of this case.”); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (“although a student of RHL’s cooking classes would undoubtedly use kitchen

textiles, it does not necessarily follow that the consuming public would understand those products to have originated from the same source.”).

We find that the evidence of record does not demonstrate a sufficient relationship between the goods and services, and this *DuPont* factor also weighs against finding a likelihood of confusion.

### C. Balancing the Factors

In conclusion, we have considered all of the arguments and evidence of record, and all relevant *DuPont* factors. While we recognize the common wording in the marks, we find that the addition of the prefatory stylized term R2G in Applicant’s mark



and the specific connotation of the words ROOM 2 GO when applied to footwear and insoles, is sufficiently different from that of ROOM TO GO for charitable services collecting and the collection and distribution to the needy of clothing and other usable good, that confusion is not likely.

### III. Decision



The refusal to register Applicant’s mark under Section 2(d) of the Act is reversed.