

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: December 5, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Boot Royalty Company, L.P.

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Application Serial No. 88787993

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

Breanna Freeman, Trademark Examining Attorney, Law Office 114
Nicole Nguyen, Acting Managing Attorney.

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Before Cataldo, Bergsman, and Dunn,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Boot Royalty Company, L.P. (“Applicant”) seeks registration on the Supplemental Register of the mark CUSHION COMFORT (in standard characters) for “footwear, headwear, clothing, namely, shirts, pants, shorts, jackets, skirts, dresses, belts, hats, gloves, tops, bottoms, underwear, sweaters, sweatshirts, vests, scarves, all of the foregoing excluding socks,” in International Class 25.¹

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¹ Application Serial No. 88787993 was filed on February 6, 2020, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s asserted bona fide intention to use the mark in commerce. On June 8, 2021, Applicant filed an Amendment to Allege Use claiming October 1996 as its dates of first use of its mark anywhere and in commerce. In a

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 DIAMOND CUSHION COMFORT, in standard characters, for "socks," in International Class 25, as to be likely to cause confusion.²

When we cite to the prosecution history record, we refer to the USPTO Trademark Status and Document Retrieval (TSDR) system in the downloadable .pdf format. When we cite to the briefs, we refer to TTABVUE, the Board's online docket system.

I. Evidentiary Issues

Before proceeding to the merits of the refusal, we address two evidentiary matters.

A. Illegible evidence

Applicant submitted illegible copies of third-party registrations purportedly of "Comfort" formative marks as Exhibit C to its October 13, 2020 Response to an Office Action (TSDR 26-126). Illegible evidence has no probative value. *See, e.g., In re GJ&AM, LLC*, 2021 USPQ2d 617, at *3-4 (TTAB 2021) ("It is the responsibility of the party making submissions to the Board and to the Trademark Examining Operation via the electronic database to ensure that the evidence has, in fact, been properly made of record."); *In re Virtual Independent Paralegals, LLC*, 2019 USPQ2d 111512, at *7 n. 23 (TTAB 2019) ("If evidence is not legible, we cannot consider it); *In re*

separate June 8, 2021 Response to an Office Action, Applicant amended the application to the Supplemental Register.

² Registration No. 5852797, registered September 3, 2019. Registrant disclaimed the exclusive right to use the term "Cushion Comfort."

Chengdu AOBI Info. Tech. Co., Ltd., 111 USPQ2d 2080, 2083 (TTAB 2011) (“[T]he text on the specimens is, for the most part, too small to make out any but the very largest words, and therefore are unacceptable as specimens.”). *Cf.* Trademark Rule 2.126(a)(2), 37 C.F.R. § 2.126(a)(2) (“Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible.”). It is incumbent upon applicants and examining attorneys to make sure the evidence they submit is complete and legible.³

Because applicants (and examining attorneys) are responsible for insuring their evidence is complete and legible and because Applicant’s 21 third-party registrations of purportedly “Comfort” formative marks attached as Exhibit C to its October 13, 2020 Response to an Office Action (TSDR 26-126) as described in that response to the Office Action (TSDR 129 were not legible, there is nothing for us to consider.

³ The better practice would have been for the Examining Attorney to advised Applicant in the subsequent December 8, 2020 Office Action that its evidence was illegible and suggest Applicant resubmit the evidence so that the Examining Attorney could consider it. *Cf.* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1208.02 (2022) (the Examining Attorney should instruct Applicant how to properly make third-party registrations of record); Trademark Manual of Examining Procedure (TMEP) § 710.01(b) (2022) (“The examining attorney must object to improperly submitted Internet evidence in the first Office action following the submission of the evidence and advise the applicant how to properly make the Internet evidence of record.”); *In re Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012) (finding that the examining attorney’s failure to advise applicant of the insufficiency of the list of registrations when it was proffered during examination constituted a waiver of any objection to consideration of that list); *In re 1st USA Realty Prof’ls*, 84 USPQ2d 1581, 1583 (TTAB 2007) (allowing evidence of a list of third-party registrations because the examining attorney did not advise applicant of the insufficiency of the list while there was still time to correct the mistake). This helps both applicants and the USPTO register marks that are entitled to registration and deny registration where necessary on the best records.

B. Late filed evidence

Applicant submitted the following evidentiary exhibits attached to its brief:

- A copy of the USPTO Trademark Electronic Search System (TESS) search results for marks that include the word “Comfort,” in International Class 25;⁴ and
- A copy of the TESS search results for marks the include the word “Cushion,” in International Class 25.⁵

The Examining Attorney, in her brief, objects to the TESS search results on the ground that they were not timely filed.⁶ Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), provides, so far as pertinent, that “[t]he record should be complete prior to the filing of an appeal.”⁷

We sustain the objection with respect to the TESS results for marks that include the word “Cushion” and “Comfort” attached to Applicant’s brief on the ground that they were not timely filed.⁸

II. Likelihood of Confusion

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits the registration of a mark that:

⁴ 6 TTABVUE 21-35.

⁵ 6 TTABVUE 36-37.

⁶ 8 TTABVUE 3.

⁷ The rule further provides that “if the appellant or the examining attorney desires to introduce additional evidence after an appeal is filed, the appellant or the examining attorney should submit a request to the Board to suspend the appeal and to remand the application for further examination.” Applicant did not submit such a request.

⁸ To the extent this attachment was an attempt to cure its timely submitted but illegible evidence, the proper procedure is the information included in FN 6.

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

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 issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “Whether a likelihood of confusion exists between an applicant’s mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018). “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) and *DuPont*, 177 USPQ at 567). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at *3 (Fed. Cir. 2020) (citing *Dixie Rests.*, 41 USPQ2d at 1533).

“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). “Two key factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because 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.” *In re Embiid*, 2021 USPQ2d 577, at *10 (TTAB 2021) (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). *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)); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004).

A. The similarity or dissimilarity and nature of the goods.

As noted above, Applicant is seeking to register its mark for “footwear, headwear, clothing, namely, shirts, pants, shorts, jackets, skirts, dresses, belts, hats, gloves, tops, bottoms, underwear, sweaters, sweatshirts, vests, scarves, all of the foregoing excluding socks,” while the cited mark is registered for socks. To prove that clothing, including footwear and excluding socks is related to socks, the Examining Attorney submitted the following evidence:⁹

⁹ The excerpts from the Nike, Gucci, and Vans websites the Examining Attorney submitted in the March 7, 2022 Denial of the Request for Reconsideration (TSDR 4-42) were cumulative inasmuch as the Examining Attorney previously submitted similar excerpts from those websites as discussed immediately below. The Examining Attorney’s time would have been better spent submitting non-cumulative website evidence or copies of use-based third-party

- Excerpts from the Nike website (nike.com) showing NIKE and the swoosh logo used to identify socks and footwear;¹⁰
- Excerpts from the Gucci website (gucci.com) showing the Gucci GG logo used to identify socks and footwear;¹¹
- Excerpts from the Vans website (vans.com) showing the mark VANS used to identify socks and footwear;¹²
- Excerpts from the Balenciaga.com website (Balenciaga.com/en-us/) showing the mark BALENCIAGA used to identify socks and clothing, including shoes;¹³ and
- Excerpts from the Under Armour website (underarmour.com) showing the stylized UA trademark used to identify socks and clothing, including shoes.¹⁴

Applicant does not directly address this *DuPont* factor, but rather contends that the differences between the marks “are so distinct as to mitigate the significance of this point.”¹⁵ In other words, the similarity or dissimilarity of the marks is the dispositive *DuPont* factor no matter how we resolve the other *DuPont* factors. *See*,

registrations for socks and clothing products, including footwear. Third-party registrations based on use in commerce that individually cover a number of different good may have probative value to the extent that they serve to suggest that the listed goods are of a type that may emanate from the same source. *In re Country Oven, Inc.*, 2019 USPQ2d 443903, *8 (TTAB 2019); *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1432 (TTAB 2013).

¹⁰ April 13, 2020 Office Action (TSDR 34-43).

¹¹ April 13, 2020 Office Action (TSDR 44-68).

¹² April 13, 2020 Office Action (TSDR 69-84).

¹³ March 7, 2022 Denial of the Request for Reconsideration (TSDR 43-49).

¹⁴ March 7, 2022 Denial of the Request for Reconsideration (TSDR 50-51).

¹⁵ Applicant’s Brief, p. 14 (6 TTABVUE 15) (citing the January 11, 2022 Request for Reconsideration (TSDR 9) (citing the October 13, 2020 Response to Office Action (TSDR 131)).

e.g., Kellogg Co. v. Pack-Em Enters. Inc., 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive. ... ‘each [of the thirteen elements] may from case to case play a dominant role.’”).

Nonetheless, we find that Applicant’s clothing products, including footwear are related to socks even though Applicant has excluded socks from its description of goods. In other words, consumers are likely to mistakenly believe that socks and other clothing products, including footwear, originate from or are in some way associated with the same source.

B. The strength of Registrant’s mark DIAMOND CUSHION COMFORT

The strength of Registrant’s mark affects the scope of protection to which it is entitled. Thus, we consider the inherent or conceptual strength of Registrant’s mark based on the nature of the mark itself and its commercial strength based on marketplace recognition of the marks. *See 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.”); *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017); *Top Tobacco, L.P. v. N. Atlantic Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (market strength is the extent to which the relevant public recognizes a mark as denoting a single source); 2 J. Thomas McCarthy, MCCARTHY

ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. September 2022 update) (“The first enquiry is for conceptual strength and focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”).

The commercial strength of the mark also is affected by the number and nature of third-party uses of similar marks for similar goods. *DuPont*, 177 USPQ at 567. Commercial strength may be measured indirectly, by volume of sales and advertising expenditures and factors such as length of use of the mark, widespread critical assessments, notice by independent sources of the goods or services identified by the mark, and general reputation of the goods or services. *Weider Publ’ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d at 1354. *See also In re FCA US LLC*, 126 USPQ2d 1214, 1224 (TTAB 2018) (“Evidence of third-party use may reflect commercial weakness.”).

“[T]hird-party registration evidence that does not equate to proof of third-party use may bear on conceptual weakness if a term is commonly registered for similar goods or services.” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017); *see also Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976) (third-party registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used.”).

Because neither Applicant, nor the Examining Attorney, submitted any evidence regarding the commercial strength of Registrant's mark DIAMOND CUSHION COMFORT, our analysis is limited to the inherent strength of Registrant's mark.¹⁶

We begin our analysis on the strength of Registrant's mark DIAMOND CUSHION COMFORT by focusing on the term "Cushion Comfort" because that is the common portion of Registrant's mark and Applicant's mark. We start by determining the definition of the words that comprise the term "Cushion Comfort."

The MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) defines "Cushion," *inter alia*, as "a padded insert in a shoe."¹⁷ The COLLINS DICTIONARY (collinsdictionary.com/us/dictionary/english/comfort) defines "Comfort" as "not feeling any pain or unpleasant sensations" and "to make physically comfortable."¹⁸ When used in connection with socks, "Cushion Comfort" means a sock with comfortable padding. Accordingly, in the cited registration for the mark DIAMOND CUSHION COMFORT, Registrant disclaimed the exclusive right to use the term "Cushion Comfort" because that term is merely descriptive.

We also note that Applicant disclaimed the exclusive right to use the term "Cushion Comfort" in its now cancelled Registration No. 2342545 for the mark

¹⁶ Furthermore, the owner of the cited registration is not a party to this proceeding and thus cannot introduce evidence regarding its use of the mark protected thereby. *See In re Thomas*, 79 USPQ2d 1021, 1027, n. 11 (TTAB 2006) ("Because this is an *ex parte* proceeding, we would not expect the examining attorney to submit evidence of fame of the cited mark"). As a result, the commercial strength of Registrant's mark simply is not at issue in this proceeding.

¹⁷ April 13, 2020 Office Action (TSDR 12).

¹⁸ April 13, 2020 Office Action (TSDR 22). The Collins Dictionary identifies "soothe" as a synonym for "Comfort," inasmuch as "soothe implies the calming or allaying of pain or distress." *Id.* at TSDR 25.

HEAVENLY SOFT, CUSHION COMFORT (stylized) for “footwear, namely, boots.”¹⁹ In addition, Applicant advertises that its TONY LAMA boots (tonylama.com) have a “Cushion Comfort Package” that “provides instant comfort and cushioning,”²⁰ thus, supporting the descriptive significance of the term “Cushion Comfort.”

Nike (nike.com) advertises a “Nike Everyday Cushion” and “Nike Everyday Plus Cushion” sock.²¹

When used in connection with socks, we find that the term “Cushion Comfort” is merely descriptive.

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

In re Hartz Hotel Servs., Inc., 102 USPQ2d 1150, 1154 (quoting *Sure-Fit Prods. Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958)). Under these circumstances, the term “Cushion Comfort” in connection with socks will be accorded a narrow scope of protection.

¹⁹ October 13, 2020 Response to an Office Action (TSDR 127). The Examining Attorney also cited the following registrations, now cancelled as bars to registration: (i) Registration No. 2097871 for the mark OOOH! AHH! CUSHION COMFORT for “men’s and women’s hosiery, namely, socks”; and (ii) Registration No. 2130927 for the mark SUPREME CUSHION COMFORT for “footwear.” In both registrations, the registrant disclaimed the exclusive right to use the term “Cushion Comfort.”

²⁰ April 13, 2020 Office Action (TSDR 86).

²¹ April 13, 2020 Office Action (TSDR 37 and 39).

We now turn to the strength of Registrant's mark DIAMOND CUSHION COMFORT in its entirety. The MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) (accessed November 10, 2022) defines "Diamond," inter alia, as "a native crystalline carbon that is the hardest known mineral, that is usually nearly colorless, that when transparent and free from flaws is highly valued as a precious stone, and that is used industrially especially as an abrasive" and "something that resembles a diamond (as in brilliance, value, or fine quality)." ²² The mark DIAMOND CUSHION COMFORT in its entirety suggests that Registrant's socks provide high quality cushioning and comfort and, therefore, it is inherently distinctive and entitled to the breadth of protection normally accorded an inherently distinctive mark.

C. The similarity or dissimilarity of the marks

We now turn to the *DuPont* 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 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is

²² The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *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); *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

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 “[t]he 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 v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012).

We keep in mind that “[s]imilarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)).

Applicant is seeking to register the mark CUSHION COMFORT and Registrant’s mark is DIAMOND CUSHION COMFORT. Given the preceding discussion regarding the strength of the term “Cushion Comfort,” including Registrant’s disclaimer of the exclusive right to use that term, the term “Cushion Comfort” is descriptive. Accordingly, we find that the word “Diamond” is the dominant part of Registrant’s mark. It is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations because consumers will tend to focus on the more distinctive parts of marks. *See In re Detroit Athletic Co.*, 903 F.3d 1297,

128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); *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.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

There is nothing improper in stating that, for rational reasons, more or less weight has been given 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.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Further reinforcing the importance of the word “Diamond” in Registrant’s mark is its position as the first word in the mark. The lead element in a mark has a position of prominence; it is likely to be noticed and remembered by consumers and so as to play 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., 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word).

As we have already found “Cushion Comfort” descriptive, therefore, the scope of protection to which that portion of the mark in the cited registration is entitled is quite limited. In this regard, the Board has made the following observation:

The question involved in this proceeding is what measure of protection should be afforded a mark like “ROYAL.” It is settled that, unlike in the case of arbitrary or unique designations, suggestive or highly suggestive terms, because of their obvious connotation and possible frequent employment in a particular trade as a part of trade designations, have been considered to fall within the category of “weak” marks, and the scope of protection afforded these marks have been so limited as to permit the use and/or registration of the same mark for different goods or of a composite mark comprising this term plus other matter, whether such matter be equally suggestive or even descriptive, for the same or similar goods. The term “ROYAL”, because of its obvious laudatory suggestive connotation, has been considered by various tribunals to be a “weak” mark entitled to a narrow orbit of protection in determining the question of the likelihood of confusion. [Internal citations omitted]. As stated in *Peerless Electric Company v. Peerless Electric, Inc.*, supra [103 USPQ 283 (NY Sup. Ct., 1954)].

“There are certain names which are given different tags- descriptive, laudatory, or the like- which are technically known as “weak,” meaning that an exclusive right in them is hard to obtain. Such names as “Superior,” “Majestic,” and “Royal” are so common that the use in and of itself imports nothing * * * .”

The character of the term “ROYAL” and the limited orbit of protection to be afforded such a term is clearly revealed by the third-party registrations made of record by applicant. That is, they are indicative that this Office has,

over the years, treated “ROYAL” as a “weak” mark that could not be exclusively appropriated in the food field thereby permitting the registration of “ROYAL”, per se, to different entities for different food products and composite marks containing this term for like goods on the basis that there is no likelihood of confusion as to source.

Standard Brands Inc. v. Peters, 191 USPQ 168, 172 (TTAB 1976). *See also Glamorene Products Corp. v. Earl Grissmer Co., Inc.*, 203 USPQ 1090, 1097 (TTAB 1978) (“Both marks [RINSENVAC and SPRAY “N VAC] are highly suggestive of their products and this only enhances the association of each mark with its own goods”).

Likewise, viewing the marks DIAMOND CUSHION COMFORT and CUSHION COMFORT in the context of the facts and circumstances presented by the record in this case, we find the addition of the word “Diamond” in Registrant’s mark DIAMOND CUSHION COMFORT is sufficient to render Applicant’s mark CUSHION COMFORT distinguishable from DIAMOND CUSHION COMFORT. In other words, the strength or weakness of the mark in the cited registration is the most important factor. *See, e.g., Kellogg Co. v. Pack-Em Enters. Inc.*, 21 USPQ2d2d at 1145 (“We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive. ... ‘each [of the thirteen elements] may from case to case play a dominant role.’”). Because of the descriptive nature of the term “Cushion Comfort,” the term “Cushion Comfort” is entitled to only a very narrow scope of protection or exclusivity of use. Accordingly, we find that Applicant’s mark CUSHION COMFORT is not similar to DIAMOND CUSHION COMFORT.

The Examining Attorney argues, to the contrary, that because both marks consist of the term “Cushion Comfort,” purchasers and prospective purchasers will perceive

Applicant's mark CUSHION COMFORT as a shortened form of Registrant's mark DIAMOND CUSION COMFORT.²³ However, there is no express rule that we must find marks similar where the Registrant's mark encompasses Applicant's entire mark although, under such circumstances, we often have found marks to be similar. *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at *6-7 (TTAB 2019) (quoting *Hunter Indus., Inc. v. Toro Corp.*, 110 USPQ2d 1651, 1660 (TTAB 2014)). As discussed above, Registrant's addition of the word "Diamond" to its mark DIAMOND CUSION COMFORT distinguishes the marks because consumers will not look to the term "Cushion Comfort" as indicating source; rather, consumers will look to the word "Diamond" as the indicator of source.

The Examining Attorney relies on *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) to support her contention that the marks are similar. In *Mighty Leaf Tea*, applicant filed an application to register the mark ML for "personal care products and skin care preparations, namely, skin soap, body wash, foam bath, body lotion, body scrub, bath salts and massage oil; potpourri; incense." The Examining Attorney cited the registered mark ML MARK LEES, reproduced below, for "skin care products, namely, skin cleanser, skin toner, skin cream, skin lotion, skin mask gel, make-up foundation, powder and blush."

²³ Examining Attorney's Brief (8 TTABVUE 5).



The court held that the presence of the name “Mark Lees” in the cited mark did not distinguish the marks.

In this case the Board found, similarly, that 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. The Board thus recognized that these initials comprise a dominant feature of the registered mark, and that a newcomer's use of the same initials, in connection with the same goods, would likely lead consumers to view the goods as coming from the same source. Avoidance of this kind of confusion about the provenance of goods is the very problem to which the Lanham Act was directed.

Id. at 94 USPQ2d 1260.

In *Mighty Tea Leaf*, the common portion of the marks is the arbitrary letters ML which in the case of the cited mark is the initials for the name Mark Lees. In the appeal before us, however, the common portion of the marks is the descriptive term “Cushion Comfort” which is entitled to only a narrow scope of protection. Because of the descriptive nature of the term “Cushion Comfort,” customers and prospective customers will perceive DIAMOND as the source indicating part of Registrant’s mark and, therefore, distinguish it from Applicant’s CUSHION COMFORT mark.

In comparing the marks in their entireties, CUSHION COMFORT versus DIAMOND CUSHION COMFORT, the common element is the descriptive term “Cushion Comfort.” We find that the presence of the additional word “Diamond” in the cited registration is enough to distinguish the marks. *See, e.g., Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004); *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1044-45 (TTAB 2010); *Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008).

D. Conclusion

Because the common portion of the marks “Cushion Comfort” is merely descriptive, it is entitled to only a narrow scope of protection. Accordingly, Applicant’s mark CUSHION COMFORT for clothing, including footwear, is sufficiently different from the mark in the cited registration DIAMOND CUSHION COMFORT for socks that there is no likelihood of confusion.

Decision: We reverse the Section 2(d) likelihood of confusion to register Applicant’s mark.