

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: April 27, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Marissa Paine

Serial No. 90039694

Aurelia Mitchell Durant of AMD Law, Inc.,
for Marissa Paine.

Douglas M. Lee, Trademark Examining Attorney, Law Office 129,
Pam Willis, Managing Attorney.

Before Kuhlke, Goodman, and Pologeorgis,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

Marissa Paine (“Applicant”) seeks registration on the Principal Register of the stylized mark MAKE SHIFT HAPPEN, as displayed below, for “Hats; Hoodies; Shirts and short-sleeved shirts; T-shirts; Graphic T-shirts” in International Class 25.¹

¹ Application Serial No. 90039694, filed on July 7, 2020, based on Applicant’s claim of use in commerce pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming February 1, 2019 as the date of first use and June 15, 2019 as the date of first use in commerce. The description of the mark reads as follows: “The mark consists of the stylized wording MAKE SHIFT HAPPEN with the word SHIFT in script font.” Color is not claimed as a feature of the mark.



The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of

likelihood of confusion with the composite mark **Shi^Ft Happens!** registered on the Principal Register for "Clothing; namely, bathrobes, hats, and t-shirts" in International Class 25.²

When the refusal was made final, Applicant appealed. Both Applicant and the Examining Attorney filed briefs. For the reasons explained below, we affirm the refusal to register.³

I. Preliminary Matter - Evidentiary Objection

We initially turn to an evidentiary objection lodged by the Examining Attorney regarding evidence presented by Applicant for the first time with her appeal brief.⁴ The Examining Attorney objects to Exhibits A, B, and C attached to Applicant's brief (with the exception of the copy of Registration No. 2711103 in Exhibit C that was previously submitted during prosecution) because this evidence was submitted for the first time as exhibits to Applicant's appeal brief.

² Registration No. 2558123 issued on April 9, 2002; renewed.

³ The TTABVUE and Trademark Status and Document Retrieval ("TSDR") citations refer to the docket and electronic file database for the involved application. All citations to the TSDR database are to the downloadable .PDF version of the documents.

⁴ Examining Attorney's Brief, pp. 2-3 (6 TTABVUE 3-4).

It is well-settled that the record in an ex parte proceeding should be complete prior to appeal. Trademark Rule 2.142(d); 37 CFR § 2.142(d). Exhibits that are attached to a brief but not made of record during examination are untimely, and will not be considered. *See In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1059 n.2 (TTAB 2002); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 1203.02(e) and 1207.01 (2021). To the extent Applicant wished to introduce additional evidence after her appeal had been filed, Applicant should have filed a written request with the Board to suspend the appeal and remand the application for further examination pursuant to Trademark Rule 2.142(d). Applicant did not do so. Accordingly, the Examining Attorney's evidentiary objection is sustained, and we give no consideration to the evidence submitted for the first time with Applicant's appeal brief.

II. 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 (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 that is relevant or 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."). Notwithstanding, "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) (internal citations removed).

A. Relatedness of the Goods

We first turn to the comparison of the goods, the second *DuPont* factor. In making our determination regarding the relatedness of the goods, we must look to the goods as identified in Applicant's application and the cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Hous. 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.")); *see also In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011).

Here, Applicant's identification of goods and the goods listed in the cited registration both include "hats" and "T-shirts." Moreover, the clothing item "T-shirts" listed in the cited registration is broadly worded to encompass Applicant's "Graphic T-shirts." Thus, Applicant's and Registrant's goods are legally identical in part.

Accordingly, the second *DuPont* factor heavily favors a finding of likelihood of confusion.

B. Similarity of Trade Channels

Next we consider established, likely-to-continue channels of trade, the third *DuPont* factor. Because the identifications of Applicant's and Registrant's goods have no restrictions as to channels of trade or classes of customers and since Applicant's goods and Registrant's goods are legally identical in part, we must presume that these legally identical in part goods travel through the same channels of trade and are offered to the same or overlapping classes of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion); *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).

Thus, the third *DuPont* factor also weighs strongly in favor of a finding of likelihood of confusion.

C. Strength of the Cited Mark

A mark's strength is measured both by its conceptual strength and its marketplace or commercial strength. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010). For likelihood of confusion purposes, "the strength of a mark is not a binary factor, but varies along a spectrum from very strong to very weak." *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003).

Applicant argues that the cited mark is weak.⁵ More specifically, Applicant

⁵ Applicant's Appeal Brief p. 9 (4 TTABVUE 15).

maintains that the cited mark should only be afforded a limited scope of protection because there are numerous marks similar to the cited mark for similar goods that are registered.⁶

Turning to Applicant's third-party registrations, we note that this evidence goes not to the commercial strength of the cited mark, but rather only to its conceptual strength. *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017) ("Use evidence may reflect commercial weakness, while third-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.") (citing *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976)); see also *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at *3 (TTAB 2020) ("[E]vidence of third-party registrations is relevant to 'show the sense in which . . . a mark is used in ordinary parlance.'"). Indeed, the Federal Circuit has held that if there is evidence that a mark, or an element of a mark, is commonly adopted by many different registrants, that may indicate that the common element has some non-source identifying significance that undermines its conceptual strength as an indicator of a single source. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) ("[E]vidence of third-party registrations is relevant to 'show the sense in which a mark is used in ordinary parlance,' ... that is, some segment that is common to both parties' marks may have 'a normally understood and well-recognized

⁶ *Id.* at pp. 9-15 (4 TTABVUE 16-21).

descriptive or suggestive meaning, leading to the conclusion that segment is relatively weak”) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)).

The third-party registrations submitted by Applicant are as follows:⁷

<u>Reg. No.</u>	<u>Mark</u>	<u>Relevant Goods/Services</u>
5456193	SHIFT HAPPENS	Providing online newsletters in the field of advertising, marketing and public relations, in Class 41.
2052916	SHIFT HAPPENS	Motivational and empowerment seminars, in Class 41.
2711103	SHIFT	Clothing, namely jackets, raincoats, sweatshirts, jerseys, shirts, blouses, pants, hats, caps, sweatbands, gloves, belts, shoes, socks, and polo shirts, in Class 25.

⁷ April 21, 2021 Response to Office Action (TSDR pp. 14-43). Applicant also submitted a copy of Registration No. 4639332 for the stylized mark SHIFT S for “Clothing, namely, jackets, jerseys, shirts, hats, caps” in Class 25. This third-party registration, however, has been cancelled. A cancelled registration is “not evidence of anything except that the registration issued; it is not evidence of any presently existing rights in the mark shown in the registration, or that the mark was ever used.” TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 704.03(b)(1)(A) (2021); *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1606 (TTAB 2018) (a cancelled registration is not evidence of use of the mark at any time); *In re Pedersen*, 109 USPQ2d 1185, 1197 (TTAB 2013) (citing *Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 1248, 178 USPQ 46, 47 (CCPA 1973) (statutory benefits of registration disappear when the registration is cancelled)). Thus, we give this third-party registration no consideration in our analysis regarding the strength of the cited mark.

<u>Reg. No.</u>	<u>Mark</u>	<u>Relevant Goods/Services</u>
5487512		Tank tops, T-shirts, shirts, sweatshirts, shorts, hats, caps, in Class 25.
5487484	SHIFT SHOP	Tank tops, T-shirts, shirts, sweatshirts, shorts, hats, caps, in Class 25.
5266179	SHIFT TEAM	Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms, in Class 25.

While there is no minimum number of third-party marks required to show weakness, six registrations owned by five registrants, coupled with no evidence of third-party uses of SHIFT HAPPEN(S) or SHIFT-formative marks, are a relatively small number compared to the number of such marks in cases that have found weakness based on those marks. *See, e.g., In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (2018) (four third-party registrations and no third-party uses were “a far cry from the large quantum of evidence of third-party use and third-party registrations that was held to be significant” in *Jack Wolfskin* and *Juice Generation*). *Cf. TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d 1409, 1427-28 n.92 (TTAB 2018) (67 third-party registrations and numerous uses of TRADER-formative marks showed that the formative was weak and could not form the basis of petitioner’s claimed family of marks); *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (where the conflicting marks were identical,

evidence of the coexistence of the cited registered mark with two third-party registrations of the same mark for the same or similar goods “falls short of the ‘ubiquitous’ or ‘considerable’ use of the mark components present in” *Jack Wolfskin* and *Juice Generation*). The Federal Circuit has held that “extensive evidence of third-party use and registration ‘is powerful on its face,’ even where the specific extent and impact of the usage has not been established,” *Jack Wolfskin*, 116 USPQ2d at 1136 (quoting *Juice Generation*, 115 USPQ2d at 1674-75), but because there is no such “extensive” evidence here, we must scrutinize the third-party registered marks carefully to determine whether they show that the term SHIFT or SHIFT HAPPENS for the goods listed in the cited registrations is weak. We find that they do not.

The third-party registrations submitted by Applicant have little, if any, probative value because (1) they are for marks that have differing connotations and overall commercial impressions when compared to the cited mark, i.e., SHIFT, SHIFT TEAM and SHIFT SHOP, or (2) they list goods or services that are sufficiently unrelated to the goods identified in the cited registration, i.e., SHIFT HAPPENS for “providing online newsletters in the field of advertising, marketing and public relations” and “motivational and empowerment seminars.” *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) (third-party registrations for goods or services that appear to be in fields which are far removed from the goods and services at issue are of limited probative value).

In view of the foregoing, we find that Applicant, based on the evidence of record, has not established that the cited mark as a whole, when used in connection with

goods identical or similar to those listed in the cited registration, has been so extensively adopted by third-party registrants to allow Applicant's proposed mark to register. In fact, we note that the cited registration for the mark

Shi^Ft Happens!

was issued on the Principal Register without a showing of acquired distinctiveness under Section 2(f) of the Trademark Act. Accordingly, the cited mark is presumed to be inherently distinctive and conceptually strong and, therefore, it should be entitled to the normal scope of protection accorded an inherently distinctive mark.

As to commercial weakness, the sixth *DuPont* factor "considers '[t]he number and nature of similar marks in use on similar goods.'" *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). Because there is no evidence of record showing third-party use of marks identical or similar to the cited mark for goods identical or similar to those listed in the cited registration, the sixth *DuPont* factor is neutral in our likelihood of confusion analysis.

D. Similarity of the Marks

We next consider the first *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). Similarity as to any one of these factors may be sufficient to support a finding that the marks are confusingly similar. See *Krim-Ko Corp. v. Coca-Cola 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.”); *In re Inn at St. John’s, LLC*, 126 USPQ2d at 1746 (“Similarity in any one of these elements may be sufficient to find the marks confusingly similar.”) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

“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.” *i.am.symbolic*, 123 USPQ2d at 1748 (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)) (internal quotation marks omitted). Furthermore, because Applicant’s goods are legally identical in part to Registrant’s goods, the degree of similarity between the marks that is required to support a finding of likelihood of confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Applicant’s mark is . The cited mark is

Shi^Ft Happens!

. When considered in their entireties, we find Applicant’s mark and Registrant’s mark to be similar in connotation and commercial impression not only because both marks are a play on the common and informal colloquial

expression “SHIT HAPPENS,”⁸ but also because the marks are visually and aurally similar in that they both include the terms SHIFT and HAPPEN(S). The fact that the cited mark employs the plural form of the word “happen” is virtually of no consequence. *Wilson v. Delauney*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) (“It is evident that there is no material difference, in a trademark sense, between the singular and plural forms of the word ‘Zombie’ and they will therefore be regarded here as the same mark.”). In addition, while the cited mark incorporates an exclamation point at the end of the mark, the inclusion of this punctuation does not alter the similarity of the marks. *See, e.g., In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (TAKE 10! found similar to TAKETEN despite exclamation point); *In re Burlington Industries, Inc.*, 196 USPQ 718 (TTAB 1977) (exclamation point in CHAMPAGNE! fails to impart meaning other than name of color to mark); *cf. In re Litehouse, Inc.*, 82 USPQ2d 1471, 1474 (TTAB 2007) (the presence of the exclamation points in the mark CAESAR!CAESAR! fails to negate the mere descriptiveness of the mark as a whole as applied to salad dressings). Such is the case here, where the exclamation point in Registrant’s mark at the end of the wording does not alter the meaning of the literal terms.

⁸ We take judicial notice of the definition of the phrase “shit happens,” which is defined as “used to say that bad things happen as part of life and cannot be prevented.” *See* www.merriam-webster.com (accessed April 25, 2022). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *See Performance Open Wheel Racing, Inc. v. U. S. Auto Club Inc.*, 2019 USPQ2d 208901, at *4 n.34 (TTAB 2019); *see also 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).

Moreover, while we recognize that the term SHIFT in each mark appears in different stylizations, it is the literal portion of a mark, rather than any design or stylization feature, which is more likely to be remembered and relied upon by customers in calling for the goods. *See Viterra*, 101 USPQ2d at 1911; *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) (“[I]n a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.”); *Ceccato v. Manifattura Lane Gaetano Marzotto & Fugli S.p.A.*, 32 USPQ2d 1192 (TTAB 1994). This principle applies here, where the superscript letter “F” in the cited mark and the script stylization of the word SHIFT in Applicant’s involved mark would not be spoken.

Further, even if potential purchasers realize the apparent differences between the marks, they could still reasonably assume, due to the overall similarities in sound, appearance, connotation, and commercial impression in the respective marks, that Applicant’s goods sold under the proposed mark constitute a new or additional product line from the same source as the goods sold under the registered mark with which they are acquainted or familiar, and that Applicant’s mark is merely a variation of, or derivative of, Registrant’s mark. *See, e.g., In re Comexa Ltda.*, 60 USPQ2d 1118 (TTAB 2001) (applicant’s use of term “AMAZON” and parrot design for chili sauce and pepper sauce is likely to cause confusion with registrant’s “AMAZON” mark for restaurant services); *SMS, Inc. v. Byn-Mar Inc.* 228 USPQ 219, 220 (TTAB 1985) (applicant’s marks ALSO ANDREA and ANDREA SPORT were “likely to evoke an association by consumers with opposer’s preexisting mark [ANDREA SIMONE]

for its established line of clothing.”); *In re Collegian Sportswear, Inc.*, 224 USPQ 174 (TTAB 1984).

Lastly, there is no evidence that the cited mark **Shi^Ft Happens!** has any meaning or significance when applied to Registrant’s listed goods. And as noted above, there is no evidence of use by third parties of similar marks on similar goods


that might dilute the source-identifying capacity of **Shi^Ft Happens!** for those goods. Moreover, to the extent the term SHIFT HAPPENS has any meaning with regard to the involved goods, there is no evidence of record to support a finding that the term would have a different meaning as applied to Applicant’s goods than it would when applied to the goods listed in the cited registration.


In sum, while there are some specific differences between Applicant’s and Registrant’s marks, i.e., the inclusion of the word MAKE in Applicant’s mark, the different stylizations of the term SHIFT in each mark, and the presence of an exclamation point at the end of the cited mark, we nonetheless find that, in their entirety, the marks are more similar than dissimilar in appearance, sound, and connotation due to the common presence of the virtually identical term SHIFT HAPPEN(S). The first *DuPont* factor thus favors a finding of likelihood of confusion.

III. Conclusion

We have considered all of the arguments and evidence of record and all relevant *DuPont* factors. We find that (1) the marks at issue are similar, (2) Applicant’s goods and Registrant’s goods are legally identical in part, and (3) the legally identical in

Serial No. 90039694

part goods are presumed to travel in identical trade channels and offered to identical classes of purchasers. As such, we conclude that Applicant's  mark, as used in connection with "Hats; Hoodies; Shirts and short-sleeved shirts; T-shirts; Graphic T-shirts," so resembles the cited mark **ShiFt Happens!** for "Clothing; namely, bathrobes, hats, and t-shirts" as to be likely to cause confusion or mistake, or to deceive under Section 2(d) of the Trademark Act.

Decision: The refusal to register Applicant's  mark under Section 2(d) of the Trademark Act is affirmed.