

This Opinion is not a
Precedent of the TTAB

Mailed: June 7, 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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Serial No. 90069720
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David Chen and John Keller of IP Attorneys Group LLC,
for Boot Royalty Company, L.P.

Patrick Carr, Trademark Examining Attorney, Law Office 125,
Heather Biddulph, Managing Attorney.


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Before Wellington, Goodman and Hudis,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Boot Royalty Company, L.P. (“Applicant”) seeks registration on the Principal Register of the mark RESISTOR (in standard characters) for “boots” in International Class 25.¹

¹ Application Serial No. 90069720 was filed on July 23, 2020 based upon Applicant’s assertion of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Page references to the application record refer to the online database of the USPTO’s Trademark Status & Document Retrieval (TSDR) system. References to the briefs on appeal refer to the Board’s TTABVUE docket system.

The Trademark Examining Attorney refused registration of Applicant's mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on likelihood of confusion with the registered mark, *resister* for "Hoodies; T-shirts; Tank-tops"² in International Class 25 and the registered mark  for use with "Clothing, namely t-shirts, sweaters, sweat-shirts, shirts, pants, jeans, skirts, vests, jackets, belts, hats" in International Class 25, owned by different individuals.³

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. Applicant and the Examining Attorney filed briefs.⁴

We affirm the refusal to register.

² Registration No. 5323587 issued on October 31, 2017. The description of the mark in the registration certificate states: "the mark consists of the word 'resister,' with 're' in lowercase and 'sister' in script." Color is not claimed as a feature of the mark.

³ Registration No. 3351078 issued on December 11, 2007; renewed. The description of the mark in the registration certificate states: "The mark consists of a backward 'R' and a backward 'S' and no 'E.'" Color is not claimed as a feature of the mark. This registration also covers Class 16 goods, which have not been cited by the Examining Attorney.

⁴ Applicant's brief is at 7 TTABVUE; the Examining Attorney's brief is at 9 TTABVUE. Applicant submitted with its appeal brief evidence that it earlier provided with its request for reconsideration. Although this evidence was provided during prosecution and is thus of record, the Board discourages this practice. *In re Lorillard Licensing Co.*, 99 USPQ2d 1312, 1315 (TTAB 2011) ("[T]he Board discourages attaching such material to briefs. ... [I]t is far more helpful to identify, by the date of submission and the page numbers in the Office's [TSDR] database, the material which is referred to in a brief."); *In re Thor Tech Inc.*, 85 USPQ2d 1474, 1475 n.3 (TTAB 2007) (attaching evidence from the record to a brief is duplicative and unnecessary).

I. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark 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. 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). We consider each *DuPont* factor for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).


In every Section 2(d) case, two key factors are the similarity or dissimilarity of the marks and the goods. *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.”). These factors and others are discussed below.

A. Similarity or Dissimilarity of the Marks

We turn to the first *DuPont* factor, which requires us to determine the similarity or dissimilarity of the marks when viewed in their entirety in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée 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. John’s, LLC*, 126 USPQ2d 1742, 1746

(TTAB 2018) *aff'd*, 777 F. App'x 516 (Fed. Cir. 2019) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

Under the first *DuPont* factor, “[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.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). Moreover, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *In re Cynosure, Inc.*, 90 USPQ2d 1644, 1645 (TTAB 2009), (citing *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975)).

The cited marks are *re sister* and . Applicant's mark is RESISTOR.

The cited marks are stylized, while Applicant's mark is in standard characters. Because Applicant's mark is in standard characters, it is not limited to any particular font, size, style, or color and could appear in the same font and stylization as the cited marks. Trademark Rule 2.52(a), 37 CFR § 2.52(a). *See Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1823 (TTAB 2015) (a standard character mark “could be used in any typeface, color, or size, including the same stylization actually used ... [in the cited mark], or one that minimizes the differences or emphasizes the similarities between the marks.”). Moreover, the design or stylization elements of the cited marks do not distinguish them from Applicant's mark for

likelihood of confusion purposes. *See Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (“the argument concerning a difference in type style is not viable where one party asserts rights in no particular display”).



Applicant argues that the cited mark differs in appearance, sound and commercial impression from Applicant’s mark.

Applicant submits that the “commercial impression and sound [of Registrant’s mark] is not at all apparent, because the English language does not contain backwards” letters. 7 TTABVUE 16. Applicant asserts that even if the backwards letters (which it identifies as “r” “e” and “z”) were read as facing forwards, the term “REZIZTR is purely fictional with no dictionary or slang meaning.” 7 TTABVUE 16. Applicant argues that “it is not readily apparent how one would pronounce the mark,” and points out that the mark does not contain the letter “O.” 7 TTABVUE 16.

As to its mark RESISTOR, Applicant points to the dictionary definition of “resistor”: “a device that has electrical resistance and that is used in an electric circuit for protection, operation, or current control” and points to the pronunciation displayed with the word and dictionary definition: “ri-'zi-stər.” 7 TTABVUE 16. October 27, 2021 Request for Reconsideration at TSDR 33. Applicant asserts that as “used in connection with boots, the commercial impression of RESISTOR thus gives rise to a boot that will give resistance and provide protection and control to the wearer.” 7 TTABVUE 17.

Although the first three stylized letters⁵ “R” “E” and “S” (i.e., RES) are facing



backwards in the cited mark, they are not so highly stylized that they are not recognized as letters. The use of the letters “R,” “E,” and “S” in this fashion “does not change the essential character of the initial portion of the mark [as constituting the letters] “RES”. See *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530, 532 n.9 (TTAB 1986) (unique lettering



style allowing the mark to be read as “BB” even when upside down does not change the essential character of a portion of the mark constituting the letters “EB”) (citing *Helena Rubenstein, Inc. v. Hudnut*, 193 F.2d 207, 92 USPQ 147, 148 (CCPA



1951)). Thus, Applicant’s mark and the cited mark are highly similar in that they both contain “RESIST” and end with the letter “R.” Even without the vowel between the letters “T” and “R” in the cited mark, consumers likely would perceive the mark as a novel spelling or misspelling of “resistor,” or its phonetic equivalent, and to the extent consumers consider Registrant’s mark a misspelling or the phonetic equivalent of resistor, they would attribute the same meaning to it. While there is no correct pronunciation of a trademark that is not a normal English word, even without



a vowel between the letters “T” and “R,” could be accorded a similar sound and cadence.

⁵ As indicated by the description of the mark statement provided by Registrant.



We find Applicant's RESISTOR mark and the cited mark are similar.

As to the cited mark *re sister*, Applicant argues that this mark and Applicant's mark have "entirely different sounds, meanings and commercial impressions." 7 TTABVUE 17. Applicant further argues that "the different and much smaller typeface used for the 're' compared with the highly stylized and bold typefaced wording 'sister' in the mark indicates that the mark is 're' as in to do again, 'sister', with a meaning 'to sister again,' or 'born again sister.'"⁶ 7 TTABVUE 17.

Applicant additionally argues that "in terms of sound and appearance, the term 'sister,' which is the dominant portion of the cited *re sister* mark, is nowhere to be found in Applicant's mark phonetically or visually." 7 TTABVUE 17. As to its mark's meaning, Applicant again points to the dictionary definition of resistor "as a device that has electrical resistance" and repeats its argument that the commercial impression of RESISTOR in connection with boots is that the boot that will "give resistance and provide protection and control to the wearer." 7 TTABVUE 17.

⁶ We take judicial notice that the prefix "re" means "1: again : anew retell." MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) <https://www.merriam-webster.com/dictionary/re> (accessed May 25, 2022). 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); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

Although the stylized *re sister* mark is a combination of non-cursive and cursive type, with the prefix “re” in slightly smaller font, all portions of the mark are in bold black lowercase letters. We find it more likely that the public will view the mark as a unitary term, “resister,” rather than as having a dominant feature in the suffix portion of the mark. *See e.g. Ford Motor Co. v. Vauxhall Motors Ltd.*, 133 USPQ 45, 46 (TTAB 1962) (rejecting Opposer’s position that the suffix portion “ford,” is the dominant syllable of BEDFORD finding it “not likely [for the public] to regard the suffix portion as the dominating or characterizing feature but will consider the specific term as a unitary term without any emphasis on any one portion thereof”). As the Examining Attorney points out, the emphasis on a portion of the Registrant’s mark is “unwarranted,” and “even if a subset ... read the mark as ‘re-sister,’ many others would be likely to read the word as simply “resister” – which already has a recognized meaning, namely, ‘one that resists.’”⁷ 9 TTABVUE 9.

We find that the RESISTOR and *re sister* marks are visually similar in that the only difference between the marks is the final vowel, where Applicant’s mark uses the letter “O” and Registrant’s mark uses the letter “E.” We also find these marks are phonetic equivalents as the dictionary shows that “resister” is pronounced as “ri-'zi-stər,” the same pronunciation as the word “resistor.”⁸

⁷ “Resister” is “: one that resists especially : one who actively opposes the policies of a government.” Its pronunciation is shown as “ri-'zi-stər.” MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) April 30, 2020 Office Action at TSDR 2.

⁸ See n.7 and supra p.5.

As to connotation, because of only the slight difference in the last vowel in the marks, and given the identical pronunciation and nearly identical visual appearance, consumers would be equally likely to ascribe the same meaning to Applicant's and Registrant's marks (i.e., attributing to both the same meaning of either resistor or resister), resulting in similar commercial impressions. We find any difference in meaning is overshadowed by the visual and phonetic similarities between the marks.

On balance, the similarities in appearance, sound and commercial impression of Applicant's RESISTOR mark and the cited *re sister* mark outweigh any dissimilarity in meaning particularly because "the average customer ... retains a general rather than specific impression of marks." *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018) (citations omitted). *See e.g., Breon Lab'y. Inc. v. Vargas*, 170 USPQ 532, 536 (TTAB 1971) (BRONCO-FEDRIN and BRONKEPHRINE considered confusingly similar, because even though they may possess different suggestive connotations, they are susceptible of a strikingly similar pronunciation and are not unlike in appearance). As the Examining Attorney points out, "the marks are essentially all slight variations of the same wording." 9 TTABVUE 9.

We find Applicant's mark and the cited marks similar. The first *DuPont* factor weighs in favor of a finding of likelihood of confusion.

B. Similarity or Dissimilarity of the Goods

We next consider the second *DuPont* factor, "[t]he similarity or dissimilarity and nature of the goods ... as described in an application or registration." *DuPont*, 177


USPQ at 567. *See also Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-63 (Fed. Cir. 2014). The goods need not be identical or even competitive to find a likelihood of confusion. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). They 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 the goods emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

Applicant’s goods are boots. The goods in Registration No. 3351078 are clothing, namely t-shirts, sweaters, sweat-shirts, shirts, pants, jeans, skirts, vests, jackets, belts, hats; the goods in Registration No. 5323587 are hoodies; T-shirts; tank-tops.


The Examining Attorney provided website evidence of third-party clothing retailers and boot retailers offering various clothing items and boots: Timberland (timberland.com), All Saints (us.allsaints.com), Hunter Boots (hunterboots.com), Ralph Lauren (ralphlauren.com), H&M (2.hm.com), Gap (gap.com), Justin (justinboots.com), Ariat (ariat.com), and Dayton (Daytonboots.com). April 30, 2021 Office Action at TSDR 2-114; October 2, 2020 Office Action at TSDR 7-149; November 19, 2021 Denial of Reconsideration at TSDR 2-35. Some of these retailers are clothing retailers that offer footwear including boots, while other retailers are boot retailers that offer clothing and clothing accessories such as belts. Internet evidence may be used by the Examining Attorney to show relatedness of the goods. *See In re Davey*

Products Pty Ltd., 92 USPQ2d 1198, 1202-03 (TTAB 2009) (accepting Internet evidence to show relatedness of goods in a likelihood of confusion determination).

The Examining Attorney also provided evidence of third-party registrations, many of which are owned by individuals, showing clothing and boots registered under the same mark. AKA ACTIVE (Reg. No. 6104731), SINFAMOUS (Reg. No. 5957353), SUB 420 (Reg. No. 5902232), MISS COCOLI (Reg. No. 6045877), SHOP SO REAL

(Reg. No. 6046096),  (Reg. No. 6020839), SAMMY SAM (Reg. No. 6183160),



(Reg. No. 6202344), NVRCRY (Reg. No. 6288471), and  (Reg. No. 6334239). April 30, 2021 Office Action at TSDR 115-150.

A third-party registration that individually covers a number of different goods and is based on use in commerce is probative to the extent that it serves to suggest that the listed goods are of a type which may emanate from the same source. *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

Applicant argues the Examining Attorney's evidence is less probative because the evidence consists of house marks. 7 TTABVUE 9. Specifically, Applicant argues that “[t]hough different goods may be offered in the same store, [such as department stores and similar establishments] this fact alone does not yield the conclusion that said goods are therefore related” and “while a few large companies may produce an array of goods, this does not mean that such goods should be considered related for purposes of determining a likelihood of confusion.” 7 TTABVUE 10-11.

Applicant also argues that “Applicant’s boots and Registrants’ clothing are used for completely and entirely different purposes, and clearly the respective goods of the Applicant and the Registrants would not constitute substitutes for one another,” noting that hoodies, shirts or tank-tops cannot be worn on the feet, and that boots cannot be worn on the upper body. 7 TTABVUE 12. Applicant further argues these goods “have no relationship to one another whatsoever nor are they complimentary in nature,” and submits that the goods are “non-competitive,” with “significant differences in utility and essential characteristics.” 7 TTABVUE 12.

As Applicant points out, in past decisions the Board has stated that there is no per se rule governing likelihood of confusion in cases involving clothing items. *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984). *See also In re Joel Embiid*, 2021 USPQ2d 577, at *26 (TTAB 2021) (there has been no per se rule regarding relatedness of clothing for 40 years). “By the same token, the fact that particular clothing items were found not to be related in past decisions involving different marks and records does not compel such a finding today if the evidence in a particular case shows otherwise.” *In re Joel Embiid*, 2021 USPQ2d 577 at *26. Thus, we must examine the record in this case to determine whether the particular clothing items at issue are related. *Id.*

House marks and designer name marks may be less persuasive on the issue of relatedness when such marks are used to identify a broad range of products in different fields. *In re Donnay Int’l, Societe Anonyme*, 31 USPQ2d 1953, 1954 n.3 (TTAB 1994) (minimizing the significance of two third-party registrations for house

marks “since house marks can be used to identify a broad range of products”). Here, however, only one designer name mark was made of record, RALPH LAUREN, and the website evidence submitted by the Examining Attorney does not reflect that this mark is used with a broad range of goods, although this website and the H&M website also offer home goods in addition to clothing. The website evidence of the other marks appear to be limited to clothing (including clothing accessories such as hats and belts) and footwear, as opposed to a broad range of goods. Similarly, the third-party registration evidence provided by the Examining Attorney shows third-party registrants offering only clothing goods in International Class 25.

The evidence of third-party use and third-party registrations supports a finding that Applicant’s boots and the Registrants’ clothing goods are related. *See, e.g., In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir 2018) (evidence that third-party retailers “sell clothing bearing their own marks in addition to clothing bearing sports team names and logos” is relevant evidence of relatedness); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (evidence that “a single company sells the goods ... of both parties, if presented, is relevant to a relatedness analysis”). As shown by the third-party registration and website evidence, consumers are accustomed to seeing boots, footwear and clothes sold under the same mark, which in turn increases the likelihood of confusion.

“Indeed, as early as 60 years ago the Federal Circuit’s predecessor court noted that commercial diversification had led to companies offering footwear and clothing

items under the same mark.” *In re Joel Embiid*, 2021 USPQ2d 577, at *29 (citing *Gen. Shoe Corp. v. Hollywood-Maxwell Co.*, 277 F.2d 169, 125 USPQ 443, 444-45 (CCPA 1960); see also *In re Keller, Heumann & Thompson Co.*, 81 F.2d 399, 28 USPQ 221, 223 (CCPA 1936)). In addition, there are photographs on some of the third-party websites showing boots worn with clothing (e.g., jeans, t-shirts, hoodies, jackets, shirts, vests) indicating that the goods are complimentary. October 2, 2020 Office Action at TSDR 12, 62, 67, 75, 108, 110, 122, 125.

Thus, contrary to Applicant’s arguments, the evidence provided by the Examining Attorney is probative as to the relatedness of the respective goods as it shows the offering of boots and clothing under one mark by a variety of companies.⁹ Accordingly, we find the record as a whole is more than sufficient to convince us that Applicant’s “boots” and Registrants’ clothing goods are related, particularly given the reduced degree of similarity between the goods that is necessary for confusion to be likely since the goods would be offered under nearly identical marks. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) (“[E]ven when goods ... are not competitive or intrinsically related, the use of [nearly] identical marks can lead to the assumption that there is a common source.”)

The second *DuPont* factor, relatedness of the goods, supports a finding of a likelihood of confusion.

⁹ Applicant references *In Marko Schuhfabrik*, Serial No. 79040612 (TTAB December 3, 2009) a non-binding non-precedential decision. In that case there was evidence from the Examining Attorney of four large retailers offering a wide variety of goods under house marks. Here, in contrast, we have website evidence of nine different retailers as well as ten third-party registrants offering clothing and boots and footwear under the same mark, but not offering a wide variety of goods under their marks.

C. Similarity or Dissimilarity of Trade Channels

The third *DuPont* factor considers “the similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567. Because there are no limitations as to trade channels or classes of purchasers in the description of goods in the application or either of the cited registrations, we must presume that the respective goods travel through all usual trade channels for such goods and are offered and sold to all of the usual customers for those goods. *See In re Joel Embiid*, 2021 USPQ2d 577, at *31 (citations omitted).

By their nature, boots, t-shirts, sweaters, sweat-shirts, shirts, pants, jeans, skirts, vests, jackets, belts, hats, and hoodies and tank-tops are “general consumer goods that are marketed to the general population and that are purchased or used in some form by virtually everyone.” *Id.* (internal quotations omitted).

Applicant submits that “outside of the large companies with house marks covering a broad variety of goods, boots and clothing are rarely sold together via the same channels of trade.” 7 TTABVUE 12. Applicant points out that boots and clothing are sold in different departments in brick and mortar and online stores arguing that “[t]he fact that goods may travel through the same general industry” does not establish relatedness. 7 TTABVUE 15. Applicant argues “the channels of trade and ultimate customer bases are also inherently distinct, and there is no overlap in these spheres.” 7 TTABVUE 12. In particular, Applicant argues that boots and clothing “are sold in separate and distinct retail settings and constitute entirely different purchasing decisions.” 7 TTABVUE 15.

However, the record shows that boots and clothing are sold together on the websites of clothing companies, and have been registered under a single mark by numerous apparel businesses, supporting a finding of overlapping trade channels. *See e.g., In re Joel Embiid*, 2021 USPQ2d 577, at *31 (finding overlapping trade channels based on record showing shoes and shirts are sold together on the websites of clothing companies, and have been registered under a single mark by numerous apparel businesses).

We find the channels of trade and classes of customers plainly overlap for Applicant's and Registrants' goods, which supports a finding of a likelihood of confusion.

II. Conclusion

We find Applicant's mark and the cited marks are similar, the respective goods are related, and the trade channels overlap. Therefore, confusion is likely.

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