

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: April 23, 2026

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Runnin' Behind, Inc.*  
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Serial No. 97603035  
—

Joel R. Feldman of Greenberg Traurig, LLP,  
for Runnin' Behind, Inc.

Shaila Settles Lewis,<sup>1</sup> Trademark Examining Attorney, Law Office 114,  
Nicole Nguyen, Managing Attorney.

—  
Before Wellington, Cohen and Brock,  
Administrative Trademark Judges.

Opinion by Cohen, Administrative Trademark Judge:

Runnin' Behind, Inc. ("Applicant") seeks registration on the Principal Register of the standard character mark FAMOUS FRIENDS for "shirts; t-shirts" in International Class 25.<sup>2</sup>

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<sup>1</sup> The Application was originally assigned to Examining Attorney Brian Pino and re-assigned to Examining Attorney Shaila Settles Lewis. We refer to both attorneys generally as the "Examining Attorney."

<sup>2</sup> Application Serial No. 97603035 (the "Application") was filed on September 22, 2022 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a) based upon Applicant's allegation of use in commerce and anywhere of March 25, 2021.

The Trademark Examining Attorney has finally refused registration of the Application under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that, when used in connection with these goods, Applicant's mark is likely to cause confusion, to cause mistake, or to deceive because it resembles the registration for standard character mark FAMOUS FRIEND for "entertainment services by a musical artist and producer, namely, musical composition for others and production of musical sound recordings"<sup>3</sup> in International Class 41; and based on issues with Applicant's specimen of use under Sections 1, 2 and 45 of the Trademark Act.<sup>4</sup>

When the refusals were made final, Applicant filed a request for reconsideration. After the Examining Attorney denied the request for reconsideration, Applicant appealed. The appeal is fully briefed. We affirm the Section 2(d) refusal and reverse the specimen refusal.

## **I. Specimen Refusal**

### **a. Ornamental**

In the first Office Action, under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051, 1052, 1127, the Examining Attorney refused registration on the ground that the mark, as used by Applicant on the specimen of record, is merely a decorative or ornamental feature of the goods and fails to function as a trademark to identify and

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The TTABVUE and TRADEMARK STATUS AND DOCUMENT RETRIEVAL (TSDR) citations in this opinion 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.

<sup>3</sup> Registration No. 6345537 (the "Cited Registration" or the "Cited Mark") issued May 11, 2021.

<sup>4</sup> See, e.g., December 12, 2024 Final Office Action at TSDR 5.

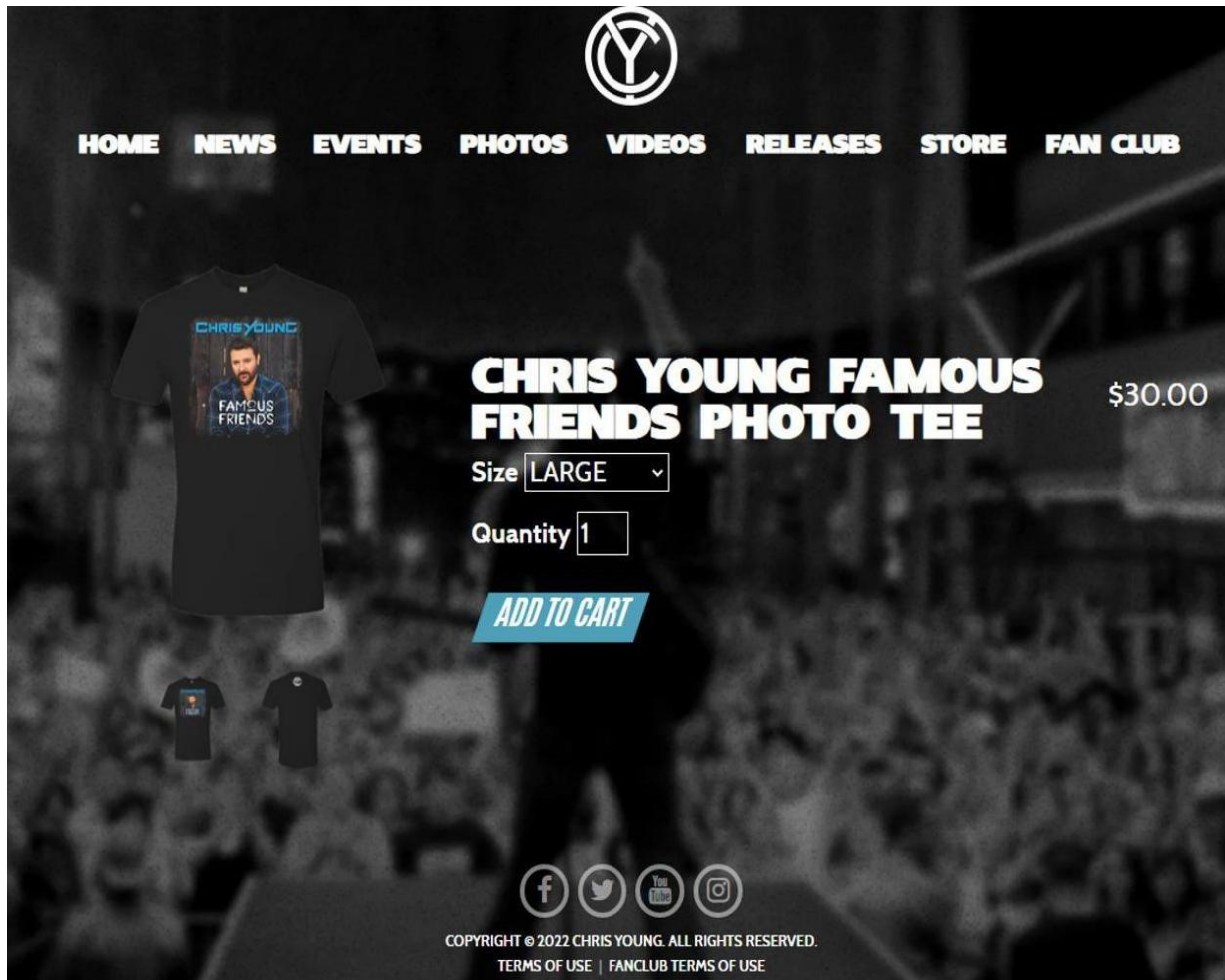
distinguish Applicant's goods from those of others and to indicate the source of Applicant's goods.<sup>5</sup> See TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPE) §§ 904.07(b), 1202.03 et seq. (November 2025). Specifically, the Examining Attorney points to the large size of the mark on the specimen (shown below) on the "upper-center area of the front of the shirt where ornamental elements often appear,"<sup>6</sup> as indicating that the mark is used in a merely decorative manner that would be perceived by consumers as having little or no particular source-identifying significance.

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<sup>5</sup> July 11, 2023 Office Action at TSDR 5-6. The final Office Action did not include the ornamental refusal. In view of our decision herein and inasmuch as Applicant addresses this basis for refusal in its Request for Reconsideration and appeal briefs and the Examining Attorney addresses the evidence of secondary source in her appeal brief, we have considered the arguments and evidence regarding this basis for refusal. See March 12, 2025 Request for Reconsideration at TSDR 11-12; 10 TTABVUE 13-14.

The Examining Attorney also refused registration asserting that the specimen and drawing in the Application do not match. *Id.* at 7-8. However, Applicant did not respond to the basis for refusal in its January 11, 2024 Response to Office Action and the Examining Attorney did not continue to raise this basis for refusal until Applicant's Request for Reconsideration was denied. June 5, 2025 Request for Reconsideration Denied at TSDR 3. We address this basis for refusal later in this decision.

<sup>6</sup> July 11, 2023 Office Action at TSDR 5.



Applicant argues that the ornamentation refusal is improper because FAMOUS FRIENDS is recognized as an indicator of secondary source for the goods because of the “extensive use of FAMOUS FRIENDS in connection with Chris Young’s song, album, tour, and fan club services, rendering it easily recognizable by consumers as Applicant’s distinctive brand extendable to souvenir merchandise (bearing his image)”;<sup>8</sup> and that its “use of the FAMOUS FRIENDS mark for goods and services

<sup>7</sup> September 22, 2022 Application at TSDR 8, [HTTPS://STORE.CHRISYOUNGCOUNTRY.COM/PRODUCTS/CHRIS-YOUNG-FAMOUS-FRIENDS-PHOTO-TEE](https://store.chrisyoungcountry.com/products/chris-young-famous-friends-photo-tee) (accessed September 22, 2022).

<sup>8</sup> 10 TTABVUE 13.

other than shirts demonstrates that the FAMOUS FRIENDS mark qualifies for protection as a secondary source indicator.”<sup>9</sup>

“It is well settled that matter which serves as part of the aesthetic ornamentation of goods, such as T-shirts, sweatshirts and shirts, may nevertheless be registered as a trademark for such goods if it also serves a source-indicating function.” *Major League Baseball Players Ass’n v. Chisena*, No. 91240180, 2023 WL 2986321, at \*19 (TTAB 2023), *aff’d Chisena v. Major League Baseball Players Ass’n*, 2026 WL 60319 (Fed. Cir. 2026) (quoting *In re Pro-Line Corp.*, No. 74174721, 1993 WL 398575, at \*1 (TTAB 1993)). As explained in *Major League Baseball Players*:

[O]rnamental matter that serves as an identifier of a “secondary source” is registrable on the Principal Register. For example, ornamental matter on a T-shirt ... can convey to the purchasing public the “secondary source” of the T-shirt (rather than the manufacturing source). Thus, even where the T-shirt is distributed by a party other than that identified by the designation, sponsorship or authorization by the identified party is indicated.

*Id.* at \*19 (citing TMEP § 1202.03(c) (2022)).

Applicant submitted a copy of its registration for FAMOUS FRIENDS in standard characters for “drinking glasses, namely, tumblers; foam drink holders being sleeves,”<sup>10</sup> and evidence of its uses of FAMOUS FRIENDS on other goods and services in an effort to prove that the mark is not merely ornamental but rather, “identifies

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<sup>9</sup> *Id.* at 15.

<sup>10</sup> March 12, 2025 Request for Reconsideration at TSDR 63-64. Registration No. 7707054 issued February 25, 2025. The Examining Attorney incorrectly argues that “Applicant did not present evidence of ownership of a U.S. Registration on the Principal Register or a pending use-based application.” 12 TTABVUE 12.

Applicant as the secondary source of the shirts ....”<sup>11</sup> See, e.g., *In re Watkins Glen Int’l, Inc.*, 1985 WL 71939, at \*2 (TTAB 1985) (reversing the refusal and finding stylized checkered flag design registrable for patches and clothing items, where applicant had previously registered WATKINS GLEN and checkered flag design (with "WATKINS GLEN" disclaimed) for services); TMEP § 1202.03(c) (“To show that a proposed mark that is used on the goods in a decorative or ornamental manner also serves a source-indicating function, the applicant may submit evidence that the proposed mark would be recognized as a mark through its use with goods or services other than those being refused as ornamental); cf. *In re Astro-Gods Inc.*, 1984 WL 63582, at \*3 (TTAB 1984) (affirming the refusal to register ASTRO GODS and design for T-shirts, despite applicant’s ornamental use of the proposed mark on other goods and appearance of applicant’s trade name “Astro Gods Inc.” on the T-shirt as part of a copyright notice). For example, Applicant submitted uses of FAMOUS FRIENDS in connection with a musical tour, as a song title, on packaging, and record albums.<sup>12</sup>

Examples are displayed below:

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<sup>11</sup> January 11, 2024 Response to Office Action at TSDR 18. In response to the evidence submitted by the Applicant, the Examining Attorney issued a subsequent Office Action asserting that the Applicant’s required substitute specimen was not verified. March 1, 2024 Office Action at TSDR 5-6. However, Applicant did not submit a substitute specimen and the July 11, 2023 Office Action did not require a substitute specimen but instead, provided a variety of options to Applicant to respond to the original ornamental refusal including that Applicant could submit evidence that Applicant’s mark is an indicator of secondary source. July 11, 2023 Office Action at TSDR 6. The Examining Attorney did not address the secondary source argument and evidence (although later addressed the secondary source argument and evidence in the appeal brief) but instead issued a Final Office Action maintaining the requirement to verify the nonexistent substitute specimen. December 12, 2024 Final Office Action at TSDR 5; see 12 TTABVUE 12-13.

<sup>12</sup> January 11, 2024 Response to Office Action at TSDR 180-89.

1/9/24, 10:01 AM

Chris Young Famous Friends Tour Dates: See Cities, Venues

RollingStone



HONDA  
The Power of Dreams

HONDA  
2024  
PASSPORT

Part of our most rugged TrailSport lineup yet.

LEARN MORE

COUNTRY

### Chris Young Announces Famous Friends Headlining Tour

Mitchell Tenpenny, Callista Clark will join Young on the fall trek, which kicks off October 21st in Little Rock, Arkansas

BY JOSEPH HUDAK  
AUGUST 2, 2021



Chris Young will launch a fall tour in support of his new album 'Famous Friends.' JASON KEMPH/GETTY IMAGES

Chris Young has announced a fall headlining tour in support of his new album *Famous Friends*. Titled after the LP, the Famous Friends Tour launches October 21st in Little Rock, Arkansas, and plays 13 shows into early December. Mitchell Tenpenny and Callista Clark will open the majority of dates.

"Touring this summer and playing fairs and festivals is fantastic and I've loved every minute of it. But being able to announce your

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<sup>13</sup> *Id.* at 165.

Top Country Albums

**2**  
No. 1 Hits

**8**  
Top 10 Hits

**8**  
Songs

**TOP COUNTRY ALBUMS**

	DEBUT DATE	PEAK POS.	PEAK DATE	WKS ON CHART
<b>Neon</b> Chris Young	<a href="#">07.30.11</a>	<b>2</b>	<a href="#">07.30.11</a>	95
<b>A.M.</b> Chris Young				

<https://www.billboard.com/artist/chris-young/chart-history/csa/>

1/9/24, 9:46 AM

Chris Young | Biography, Music & News | Billboard

**billboard**

Chris Young

	<a href="#">09.19.09</a>	<b>6</b>	<a href="#">09.19.09</a>	78
<b>I'm Comin' Over</b> Chris Young	<a href="#">12.05.15</a>	<b>1</b> 1 WKS	<a href="#">12.05.15</a>	77
<b>Losing Sleep</b> Chris Young	<a href="#">11.11.17</a>	<b>1</b> 1 WKS	<a href="#">11.11.17</a>	37
<b>Famous Friends</b> Chris Young	<a href="#">08.21.21</a>	<b>3</b>	<a href="#">08.21.21</a>	28

<sup>14</sup> *Id.* at 160.



The poster features a large image of Chris Young on the left. To his right, the text 'CHRIS YOUNG' is written in large white letters, with 'FAMOUS FRIENDS' in blue and 'TOUR' in white below it. Below the main title, there are two smaller images: one of Mitchell Tenpenny with the text 'WITH SPECIAL GUESTS MITCHELL TENPENNY' and one of Callista Clark with the text 'AND CALLISTA CLARK'. At the bottom, a list of tour dates and locations is provided.

OCT. 21 LITTLE ROCK, AR	NOV. 6 BEMIDJI, MN	
OCT. 22 NEW BRAUNFELS, TX	NOV. 11 SUGAR LAND, TX	
OCT. 23 GRAND PRAIRIE, TX	NOV. 12 BATON ROUGE, LA	NOV. 19 CORALVILLE, IA
NOV. 4 RAPID CITY, SD	NOV. 13 CORPUS CHRISTI, TX	NOV. 20 DEKALB, IL
NOV. 5 ROCHESTER, MN	NOV. 18 GREEN BAY, WI	DEC. 5 UNCASVILLE, CT

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<sup>15</sup> *Id.* at 167.

**BOX SET 3 :**

7 ITEMS \$99.99  
LIMITED EDITION COLOR PACKAGE, EXCLUSIVE TO BOX SETS ONLY

- AUTOGRAPHED FAMOUS FRIENDS ALBUM
- ARTWORK TEE
- HAT
- KOOZIE
- SHOT GLASS
- SPEAKER
- DECAL

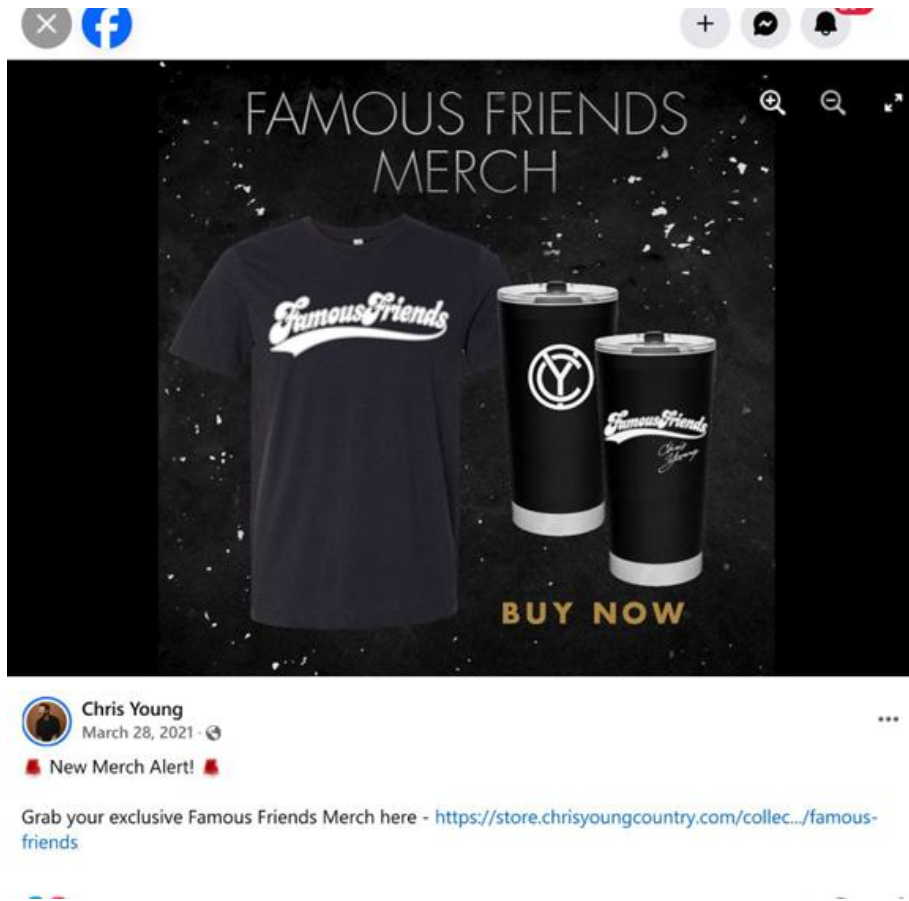
ALL PRODUCTS WILL BE WRAPPED AND PACKAGED ACCORDINGLY FOR PROTECTION. FOR DISTRIBUTION IN USA. PRODUCT AND BOX IMAGES ARE DIGITAL RENDERING AND NOT REAL.

**GET YOURS HERE**

16

and

<sup>16</sup> *Id.* at 182.



It is well settled that matter which serves as part of the aesthetic ornamentation of goods, such as T-shirts, may nevertheless be registered as a trademark for such goods, if it also serves a source-indicating function. *Pro-Line Corp.*, 1993 WL 398575; *In re Dimitri's Inc.*, No. 565815, 1988 WL 252334 (TTAB 1988). We are not persuaded by the Examining Attorney's argument that the size and prominence of the mark are such that consumers would not perceive it as a source identifier.<sup>18</sup> Although "[i]t may have once been the practice in the clothing industry to limit logos to small sizes in discrete areas rather than to have them 'emblazoned' across a garment ... such is no

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<sup>17</sup> *Id.* at 189.

<sup>18</sup> 12 TTABVUE 11.

longer the industry practice, or at least no longer the only one.” *In re Lululemon Athletica Canada Inc.*, No. 77455710, 2013 WL 326567, at \*4 (TTAB 2013) (rejecting a per se rule based on the size of a mark on clothing but instead considering size among other factors in assessing the commercial impression and registrability of marks of this nature); *Pro-Line Corp.*, 1993 WL 398575, at \*1 (“The ‘ornamentation’ of a T-shirt can be of a special nature which inherently tells the purchasing public the source of the T-shirt, not the source of manufacture but the secondary source. Thus, the name ‘New York University’ and an illustration of the Hall of Fame, albeit it will serve as ornamentation on a T-shirt will also advise the purchaser that the university is the secondary source of that shirt.”).

Here, contrary to the Examining Attorney’s arguments,<sup>19</sup> we have convincing evidence that FAMOUS FRIENDS tells the public the secondary source of the applied-for goods. We reverse the refusal to register the Application on the basis that the mark is merely a decorative or ornamental feature of the goods and fails to function as a trademark to identify and distinguish Applicant’s goods from those of others and to indicate the source of Applicant’s goods.

**b. Failure to Verify the Specimen**

The Examining Attorney asserts that Applicant has failed to verify its substitute specimen pursuant to Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), 2.63(b).<sup>20</sup> The Examining Attorney asserts that

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<sup>19</sup> *Id.* at 12-13.

<sup>20</sup> December 12, 2024 Final Office Action at TSDR 5.

Applicant’s “evidence was treated as a substitute specimen”;<sup>21</sup> however, Applicant repeatedly asserts<sup>22</sup> that no substitute specimen was ever submitted making it clear Applicant did not intend its evidence of secondary source to be treated as a substitute specimen. The only specimen submitted by Applicant is the specimen submitted with the Application which, the Examining Attorney does not dispute, was verified.<sup>23</sup>

Accordingly, this basis for refusal is moot.

**c. The Mark does not Match the Drawing**

In the denial of the Request for Reconsideration, the Trademark Examining Attorney also refused registration of the Application on the bases that under Trademark Act Sections 1 and 45, 15 U.S.C. §§ 1051, 1127: (1) the mark on the specimen does not match the mark in the drawing; and (2) the specimen appears to consist of a digitally created or altered image or mockup of a depiction of the mark on the goods.<sup>24</sup>

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<sup>21</sup> 12 TTABVUE 13.

<sup>22</sup> See, e.g., March 12, 2025 Request for Reconsideration at TSDR 11 (“Applicant did not provide a substitute specimen, although Applicant did provide further evidence of use of the Mark in connection with the goods.”).

<sup>23</sup> September 22, 2022 Application at TSDR 1-8.

<sup>24</sup> Applicant asserts that the Examining Attorney, for the first time in the denial of the Request for Reconsideration, improperly raised that the specimen was digitally created and that the mark on the specimen and drawing do not match. 10 TTABVUE 12; 15. Applicant argues that because its Request for Reconsideration resulted in two new bases for the specimen refusal, the “bases for refusal must be asserted in *at least* a subsequent final action” and thus, these bases for refusal should be disregarded. *Id.* at 16. We note, however, that the Examining Attorney raised the issue of the specimen differing from the drawing in the July 11, 2024 Office Action at TSDR 7-8. Nonetheless, in view of our decision herein and because the Examining Attorney and Applicant both address the merits of these bases for refusal, we find it appropriate to consider the merits of the drawing and digitally created refusals.

June 5, 2025 Request for Reconsideration Denial at TSDR 3.

Every use-based trademark application must include a drawing of the applied-for mark and a specimen, showing actual use of the mark in commerce. 15 U.S.C. § 1051(a)(1), (2); *see* Trademark Rule 2.51, 37 C.F.R. § 2.51 (drawing requirement); Trademark Rule 2.56(a), 37 C.F.R. § 2.56(a) (“An application under section 1(a) of the Act ... must include one specimen per class showing the mark as actually used in commerce on or in connection with the goods or services identified.”). The “drawing depicts the mark sought to be registered,” Trademark Rule 2.52, 37 C.F.R. § 2.52, and “must be a substantially exact representation of the mark as used on or in connection with the goods and/or services,” Trademark Rule 2.51(a), 37 C.F.R. § 2.51(a). Failure to comply with these requirements warrants refusal of the application. *See, e.g., In re Guitar Straps Online, LLC*, No. 85047191, 2012 WL 3561627, at \*8-9 (TTAB 2012) (affirming refusal where drawing was not a substantially exact representation of the mark as used in commerce); *In re Thomas White Int’l, Ltd.*, No. 77080379, 2013 WL 2951787, at \*6 (TTAB 2013) (affirming refusal where specimen was unacceptable to support registration of the mark for the identified goods).

The drawing shows FAMOUS FRIENDS in standard characters. The specimen, as argued by the Examining Attorney, shows the mark as CHRIS YOUNG FAMOUS FRIENDS PHOTO TEE. We agree that the section in which the t-shirt available for purchase describes the t-shirt as CHRIS YOUNG FAMOUS FRIENDS PHOTO TEE.<sup>25</sup> However, we note that multiple marks may appear on or in connection with a product (i.e., “CHRIS YOUNG” “FAMOUS FRIENDS” photo tee) and if they create a

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<sup>25</sup> *See* July 11, 2023 Office Action at TSDR 8; 12 TTABVUE 11.

distinct impression, each mark may be registered. *See Amica Mutual Ins. Co. v. R. H. Cosmetics Corp.*, 1979 WL 24882, at \*5 (TTAB 1979) (“It is well established that a product can bear more than one trademark, that each trademark may perform a different function for consumers and recipients of the product, and that each can be registered providing the mark as used, creates a separate and distinct impression in and of itself and serves to identify and distinguish the product as it is encountered by consumers in the normal marketing milieu for such goods.”). We also note that the t-shirt displayed shows the mark as follows:



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<sup>26</sup> September 22, 2022 Specimen at TSDR 1.

FAMOUS FRIENDS is in a different size, style and color as well as being set apart spatially from CHRIS YOUNG, separated by a picture of Chris Young. FAMOUS FRIENDS appears as a separate mark on the t-shirt further suggesting that the description of the t-shirt includes multiple marks used together, i.e., CHRIS YOUNG, FAMOUS FRIENDS and the descriptor, “photo tee.” Therefore, we conclude that the mark in the drawing is supported by the specimen of use on record.

Because we find the specimen of record and the drawing are the same and match, this basis for refusal under Sections 1 and 45 is reversed.

**d. The Specimen is Digitally Created or Altered**

With respect to the Examining Attorney’s refusal that the specimen is digitally created/altered, raised for the first time in the Request for Reconsideration Denial, the Examining Attorney argues that the “specimen consists of a web page with a digitally-created t-shirt bearing the mark ....”<sup>27</sup> An image of a product or packaging that has been digitally created or altered to include the mark is not a proper specimen for goods because it does not show actual use of the mark in commerce. *See* 15 U.S.C. § 1127; TMEP § 904.04(a)(i). An examining attorney that refuses a specimen as digitally created/altered “must include an explanation of the reasons the specimen appears to be digitally created or altered.” TMEP § 904.04(a)(iii). Here, the Examining Attorney did not articulate the reasons the specimen is believed to be digitally created or altered.

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<sup>27</sup> June 5, 2025 Request for Reconsideration Denied at TSDR 3.

Additionally, Applicant argues that this basis for refusal is not accompanied by a request for information as required by TMEP § 904.04(a)(iii).<sup>28</sup> When evaluating whether a specimen is digitally created or altered, the Office considers the totality of the record, not any single factor in isolation. “Both precedent and examination guidance make clear that in assessing the specimens, consideration must be given not only to the information provided by the specimen itself, but also to any explanations offered by Applicant clarifying the nature, content, or context of use of the specimen that are consistent with what the specimen itself shows.” *In re Pitney Bowes, Inc.*, No. 86502157, 2018 WL 360241, at \*3 (TTAB 2018); *see In Re Bulletproof Property Mgmt., LLC*, 2024 WL 4298602, at \*7 (TTAB 2024) (“consideration must be given not only to the information provided by the specimen itself, but also to any explanations offered by Applicant clarifying the nature, content, or context of use of the specimen that are consistent with what the specimen itself shows.”). Indeed, “[w]hen issuing a refusal based on the specimen not appearing to show actual use of the mark in commerce, the examining attorney must also issue a request for information under 37 C.F.R. § 2.61(b) requiring the applicant to provide detailed information about the submitted specimen and other information and documents relevant to aiding a determination as to whether the mark is actually in use in

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<sup>28</sup> 10 TTABVUE 16. The specimen is described in the Applicant as a “printout of a point of sale page on the applicant’s website.” September 22, 2022 Application at TSDR 1.

commerce.” TMEP § 904.04(a)(iii). However, the Examining Attorney did not request additional information about the specimen.<sup>29</sup>

Because the Examining Attorney did not request additional information from the Applicant regarding the specimen and the Examining Attorney provides no support or explanation regarding the digitally created/alterd basis for refusal, the Examining Attorney’s arguments lack evidentiary support. *See* TMEP § 904.04(a)(iii). As a result, on this record we are constrained to accept Applicant’s specimen of use<sup>30</sup> and this basis for refusal is reversed.

## **II. Section 2(d) Refusal**

“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 or services of the applicant, to cause confusion [or] mistake, or to deceive.” *In re Charger Ventures LLC*, 64 F.4th 1375, 1379 (Fed. Cir. 2023). Our determination of the likelihood of confusion under Section 2(d) of the Trademark Act 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, 1361 (CCPA 1973) (“*DuPont*”); *Charger Ventures*, 64 F.4th at 1379. We consider each

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<sup>29</sup> While the displayed shirt arguably appears to be a rendering of a t-shirt and not an actual t-shirt, because it is in black on a black background, it is difficult to see on the webpage and thus, it is equally arguable that the t-shirt is the actual shirt available for purchase.

<sup>30</sup> As already noted, the specimen shows use of FAMOUS FRIENDS not only on the t-shirt itself but also in connection with what appears to be multiple marks, i.e., CHRIS YOUNG, FAMOUS FRIENDS, and the descriptor, “photo tee.”

*DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019).

In any likelihood of confusion analysis, different *DuPont* factors may play a dominant role and some factors may not be relevant. *Naterra Int’l, Inc. v. Bensalem*, 92 F.4th 1113, 1116 (Fed. Cir. 2024) (citing *Tiger Lily Ventures Ltd. v. Barclays Cap. Inc.*, 35 F.4th 1352, 1362 (Fed. Cir. 2022)). In addition, varying weight may be assigned to each factor depending on the evidence presented, and “any one of the factors may control a particular case.” *Id.*; *see also Charger Ventures*, 64 F.4th at 1381. Two key considerations are the similarities between the marks and the similarities between the goods or services. *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65 (Fed. Cir. 2002)). These factors are discussed below.<sup>31</sup>

### **A. The Marks**

“Under the first *DuPont* factor, we consider ‘the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.’” *Sabhnani v. Mirage Brands, LLC*, No. 92068086, 2021 WL 6072822, at \*13 (TTAB 2021) (quoting *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.2d 1369, 1371 (Fed. Cir. 2005)).

The test under the first *DuPont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the

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<sup>31</sup> Applicant asserts that the only factors relevant to the Section 2(d) analysis are “whether shirts are related to musical composition” and “the minor (but meaningful) difference between FAMOUS FRIEND and FAMOUS FRIENDS.”<sup>10</sup> TTABVUE 3.

marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). Further, the marks “must be considered ... in light of the fallibility of memory ...” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quotation omitted).

The mark in the Application and the Cite Mark are nearly identical in appearance and sound, differing in one letter – FAMOUS FRIENDS v. FAMOUS FRIEND. This difference between the singular form depicted in the Cited Mark and the plural form depicted in the mark in the Applicant is not meaningful.<sup>32</sup> See *Fleetwood Co. v. Mende*, 298 F.2d 797, 799 (CCPA 1962) (TINTZ is a phonetic spelling of “tints”; likelihood of confusion found between TINTZ and TINT ‘N SET); *Wilson v. Delauney*, 245 F.2d 877, 878 (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 re Peace Love World Live, LLC*, No. 86705287, 2018 WL 3570240, at \*8 (TTAB 2018) (“Slight differences in marks do not normally create dissimilar marks.”); *Swiss Grill Ltd., v. Wolf Steel Ltd.*, No. 91206859, 2015 WL 5675642, at \*11 n.17 (TTAB 2015) (SWISS GRILL and SWISS GRILLS are virtually identical marks and confusingly similar); cf. *Weiss*

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<sup>32</sup> Applicant essentially agrees asserting that its mark is “similar (but different).” 10 TTABVUE 11.

*Assocs. v. HRL Assocs.*, 902 F.2d 1546, 1548 (Fed. Cir. 1990) (“It is especially hard to distinguish between TMS and TMM when the marks only differ by the last letter.”).

Regarding connotation and commercial impression, Applicant argues that its mark is associated with Chris Young but that even if the consumer is unaware of “the verbal irony of Chris Young’s use of ‘Famous Friends’ for non-famous hometown heroes, the marks ... create distinct commercial impression on their faces.”<sup>33</sup>

Applicant further argues that:

Although they share the same root wording, the addition of the plural “S” materially changes how consumers perceive the mark. FAMOUS FRIEND (singular) connotes one particular individual and conveys a sense of exclusivity or personal connection. By contrast, FAMOUS FRIENDS (plural) evokes a collective or group of individuals and conveys a social or community-oriented meaning. The singular and plural forms at issue here are not identical. And the difference between the marks is enough to ensure they would not be perceived as the same source indicator for unrelated goods and services.

Applicant’s arguments fail to persuade us.

We are constrained to base our analysis on the applied-for mark and identification of goods. While Applicant has submitted evidence of its use of FAMOUS FRIENDS in connection with Chris Young and his song, we cannot consider alleged marketplace realities not reflected in the identifications of goods and services. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, (Fed. Cir. 2000) (affirming Board finding that where the identification is unrestricted, “we must deem the goods to travel in all appropriate trade channels to all potential purchasers of such goods”).

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<sup>33</sup> 10 TTABVUE 10.

The mark in the Application is not depicted to include the name CHRIS YOUNG nor is there any reference to Chris Young in the identification of goods. Applicant's assertion that consumers will associate the mark with Chris Young is based on attorney argument and we are not convinced that the addition of the letter "S" in Applicant's mark significantly changes the overall commercial impression or connotation imparted by FAMOUS FRIENDS. Applicant's mark is merely the plural of the Cited Mark. Applicant's argument that the singular v. plural versions are of differing connotations is unpersuasive and there is nothing of record to support a finding that consumers would attribute different connotations to FAMOUS FRIENDS or FAMOUS FRIEND. Any consumers who do notice the slight difference in the marks may consider Applicant's mark a variation of the Cited Mark covering companion product lines. *See In re Great Lakes Canning, Inc.*, 1985 WL 71929, at \*3 (TTAB 1985) ("Even those purchasers who are fully aware of the specific differences between the marks may well believe, because of the similarities between them, that the two marks are simply variants of one another, used by a single producer to identify and distinguish companion lines of goods.").

Keeping in mind the fallibility of average consumers' memories, while slight differences exist between the respective marks, we find that in their entireties, the marks are substantially similar in appearance, sound and connotation, and convey very similar commercial impressions. *See, e.g., Spoons Rests. Inc. v. Morrison Inc.*, No. 73718933, 1991 WL 355249, at \*4-5 (TTAB 1991), *aff'd mem.*, 972 F.2d 1353 (Fed. Cir. 1992) (The fallibility of human memory is a factor when comparing marks, given

that a side-by-side comparison is not the ordinary way that a prospective consumer would be exposed to marks.).

Given the near identical similarity of the marks, this first *DuPont* factor weighs strongly in favor of a finding of likelihood of confusion.

### **B. Similarity or Dissimilarity of the Goods and Services**

“The second *DuPont* factor ‘considers [t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration.’” *In re Embiid*, No. 88202890, 2021 WL 2285576, at \*10 (TTAB 2021) (quoting *In re Detroit Athletic Co.*, 903 F.3d 1297, 1306 (Fed. Cir. 2018) (quoting *DuPont*, 476 F.2d at 1361)).

“In analyzing the [goods], the Board considers [t]he similarity or dissimilarity and nature of the [goods] as described in an application or registration.” *In re OSF Healthcare Sys.*, No. 88706809, 2023 WL 6140427, at \*4 (TTAB 2023) (quoting *Embiid*, 2021 WL 2285576, at \*10) (quotation omitted). The “Examining Attorney need not prove, and we need not find, similarity as to each product listed in the description of [services]” to affirm the refusal. *In re St. Julian Wine Co.*, No. 87834973, 2020 WL 2788005, at \*5 (TTAB 2020). “[I]t is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of [services] within a particular class in the application.” *In re Aquamar, Inc.*, No. 85861533, 2015 WL 4269973, at \*4 n.5 (TTAB 2015).

Applicant’s shirts and t-shirts, and Registrant’s entertainment services by a musical artist and producer, namely, musical composition for others and production of musical sound recordings are obviously not directly competitive or overlapping

goods and services. However, because names of music producers and composers can be used as trademarks for merchandising products, the goods and services may be related for purposes of a likelihood of confusion analysis. As noted in a case involving a television show, “[i]t is common knowledge ... that video games, t-shirts, beach towels, caps and other logo-imprinted products are used as promotional items for a diverse range of goods and services...” *Turner Entertainment Co. v. Nelson*, No. 94200, 1996 WL 335214, at \*4 (TTAB 1996).

The Examining Attorney relies on twenty use-based third-party registrations to support the assertion that the goods identified in the Application and Cited Registration are similar and offered under the same mark, including:

- AUSTIN CITY LIMITS (Reg. No. 4559061) for a variety of goods and services including t-shirts and Entertainment services by a musical artist and producer, namely, musical composition for others and production of musical sound recordings;<sup>34</sup>
- KELLY CLARKSON (Reg. No. 3275995) for a variety of goods and services including shirts; t-shirts; production of musical audio recordings and musical video recordings; music publishing services;<sup>35</sup>
- ROOTS OF ROYALTY (Reg. No. 6628050) for a variety of goods and services including shirts; t-shirts; Entertainment services by a musical artist and producer, namely, musical composition for others and production of musical sound recordings; Music publishing services;<sup>36</sup>
- BARRY MANILOW (Reg. No. 6040100) for a variety of goods and services including shirts; audio recording and production; record and music production services;<sup>37</sup>

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<sup>34</sup> July 11, 2023 Office Action at TSDR 13.

<sup>35</sup> *Id.* at 19-20.

<sup>36</sup> *Id.* at 22.

<sup>37</sup> *Id.* at 28-29.

- THERE IS A LIGHT (Reg. No. 20230613) for a variety of goods and services including t-shirts; shirts; Music composition services; Music production services;<sup>38</sup>
- PLANTWAVE (Reg. No. 6863016) for a variety of goods and services including shirts; t-shirts; Music composition for others; Music composition services; Music production services; Entertainment services by a musical artist and producer, namely, musical composition for others and production of musical sound recordings;<sup>39</sup>
- 808 MAFIA (Reg. No. 7078374) for a variety of goods and services including shirts; Music composition services; Music production services; Composition of music for others; Production of musical sound recordings;<sup>40</sup>
- ENUMCLAW (Reg. No. 7014328) for a variety of goods and services including t-shirts; shirts; Music composition services; Music production services; Entertainment services in the nature of recording, production and post-production services in the field of music;<sup>41</sup>
- THE BAR-KAYS (Reg. No. 7022132) for a variety of goods and services including shirts; tee shirts; Entertainment services by a musical artist and producer, namely, musical composition for others and production of musical sound recordings;<sup>42</sup>
- JACOB FOREVER (Reg. No. 7040705) for a variety of goods and services including long sleeves tee shirts; Entertainment services by a musical artist and producer, namely, musical composition for others and production of musical sound recordings;<sup>43</sup> and
- QUASIMOTO (Reg. No. 7042471) for a variety of goods and services including shirts; t-shirts; Music production services; Music composition services; Production of sound and music video recordings; Entertainment services by a musical artist and producer, namely, musical composition for others and production of musical sound recordings.<sup>44</sup>

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<sup>38</sup> *Id.* at 30-31.

<sup>39</sup> *Id.* at 34-35.

<sup>40</sup> *Id.* at 38.

<sup>41</sup> *Id.* at 40.

<sup>42</sup> *Id.* at 44.

<sup>43</sup> *Id.* at 48.

<sup>44</sup> *Id.* at 50.

The Examining Attorney also submitted third-party internet uses of a variety of music producers<sup>45</sup> who also sell t-shirts using the same names including the RED HOT CHILI PEPPERS,<sup>46</sup> PETE ROCK,<sup>47</sup> MARK RONSON,<sup>48</sup> TIMBALAND,<sup>49</sup> PRINCE,<sup>50</sup> GEORGE CLINTON,<sup>51</sup> and BABYFACE.<sup>52</sup> The Examining Attorney asserts that these registrations and uses indicate that the goods and services “are commercially related.”<sup>53</sup>

Applicant also submits its own set of third-party registrations, contending that there are twenty-two pairs where the identical mark registered by different entities for songwriting or music production and for shirts and t-shirts.<sup>54</sup> However, the fact that different third-parties may own these registrations does not negate those

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<sup>45</sup> The Examining Attorney also submitted additional evidence of third-party internet uses arguing that those uses show “clothing that bear the name of the most popular music producers and composers ... Bob Marley, Outkast, Kiss, Fleetwood Mac, Guns N Roses, and others who are or were music producers and composers have t-shirts available for sale....” 12 TTABVUE 6; March 1, 2024 Final Office Action at TSDR 8-151; December 12, 2024 Final Office Action at TSDR 7-23. Although this evidence indicates that musical performers often sell t-shirts that display their names, there is no evidence (except for a few examples discussed more thoroughly later in this decision) that those performers also offer “entertainment services by a musical artist and producer, namely, musical composition for others and production of musical sound recordings,” or what mark is used in connection with those services.

<sup>46</sup> March 1, 2024 Final Office Action at TSDR 40-42; 71-93.

<sup>47</sup> June 5, 2025 Request for Reconsideration Denied at TSDR 79, 102.

<sup>48</sup> *Id.* at 83, 125.

<sup>49</sup> *Id.* at 92, 141.

<sup>50</sup> *Id.* at 83, 117.

<sup>51</sup> *Id.* at 78-79; 99-100.

<sup>52</sup> *Id.* at 89, 131.

<sup>53</sup> 12 TTABVUE. 6.

<sup>54</sup> *Id.* at 9; January 11, 2025 Response to Office Action at TSDR 43-157.

examples of common ownership submitted by the Examining Attorney and what that may suggest as to consumer perception in the marketplace. *See Made in Nature*, No. 91223352, 2022 WL 2188890, at \*25 (TTAB 2022) (“For Applicant’s and Registrant’s identified goods to be related, it is not necessary that they always emanate from the same source under the same mark.”); *see also In re Ala. Tourism Dep’t*, 2020 WL 2301221, at \*13 (TTAB 2020) (“Applicant’s evidentiary submission almost certainly presents an incomplete picture of USPTO practice, as it omits marks in applications that were refused registration ... in a manner likely to be highly consistent with the action in this case.”).

Applicant argues that its shirts are not related to the musical composition and production services identified in the Cited Registration; and that the evidence of third-party registrations relied upon by the Examining Attorney is “fatally flawed because all but two of the 20 third-party registrations identify multiple types of services ....”<sup>55</sup> Applicant describes the services identified in the third-party registrations as “business-to-consumer (B2C) services”<sup>56</sup> and attempts to distinguish the third-party services from those services identified in the Cited Registration arguing that the third-party services are broader and include “multiple types of services.”<sup>57</sup> This argument ignores the fact that the third-party registrations relied upon by the Examining Attorney clearly show that the same goods identified in the

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<sup>55</sup> 10 TTABVUE 4.

<sup>56</sup> *Id.*

<sup>57</sup> *Id.* at 6.

Application and same services identified in the Cited Registration are also identified in the third-party registrations. *DeVivo v. Ortiz*, No. 91242863, 2020 WL 1227592, at \*14 (TTAB 2020) (“While not evidence of use of the marks therein, third-party registrations may serve to suggest that the parties’ goods ... are of a type which may emanate from a single source.”); *In re Country Oven, Inc.*, No. 87354443, 2019 WL 6170483, at \*5 (TTAB 2019) (as a general proposition, third-party registrations that cover goods from both the cited registration and an applicant’s application are relevant to show that the goods are of a type that may emanate from a single source under one mark).

Contrary to Applicant’s arguments<sup>58</sup> that “it is not common for music composers or producers to sell merchandise like shirts under the same mark,”<sup>59</sup> the Examining Attorney’s evidence of third-party registrations and internet uses indicates that music composers and producers do indeed offer shirts for sale under the same names and marks. Thus, Applicant’s shirts and t-shirts are related to Registrant’s entertainment services by a musical artist and producer, namely, musical composition for others and production of musical sound recordings.

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<sup>58</sup> For the first time in its reply brief, Applicant asserts that the Examining Attorney has failed to prove “something more.” 13 TTABVUE 4. Proof of “something more” is required only when “the relatedness of the goods and services is not evident, well-known or generally recognized.” *In re St. Helena Hosp.*, 774 F.3d 747, 754 (Fed. Cir. 2014). That additional proof is not necessary here. It is “well established that ‘confusion may be likely to occur from the use of the same or similar marks for goods, on the one hand, and for services involving those goods, on the other.’” *In re Detroit Ath. Co.*, 903 F.3d 1297, 1307 (Fed. Cir. 2018) (citing TMEP § 1207.01(a)(ii)). Here, as already noted, “[i]t is common knowledge ... that video games, t-shirts, beach towels, caps and other logo-imprinted products are used as promotional items for a diverse range of goods and services...” *Turner Entertainment Co.*, 1996 WL 335214, at \*4.

<sup>59</sup> 13 TTABVUE 3.

This factor weighs in favor of finding of likelihood of confusion.

### **C. Summary**

The near identity of the marks weighs strongly in favor of a likelihood of confusion and the relatedness of the goods and services identified in the Application and the Cited Registration weighs in favor of likelihood of confusion. No factor weighs against a finding of likelihood of confusion.

**Decision:** The refusal to register Applicant's FAMOUS FRIENDS mark under Section 2(d) of the Trademark Act is affirmed; the refusals that the specimen is ornamental, does not match the drawing and is digitally created/altered are reversed; and the refusal that a substitute specimen was not verified is moot.