Paper No. 12
BAC

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB DEC 30 ,98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re No Fear, Inc.

Serial No. 74/598,109

Kit M. Stetina of Stetina Brunda Garred & Brucker for No Fear, Inc.

Kim Saito, Trademark Examining Attorney, Law Office 109 (Deborah S. Cohn, Managing Attorney)

Before Sams, Simms and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

No Fear, Inc. has filed an intent-to-use application to register the mark ONLY THE BRAVE for "wearing apparel, namely, t-shirts, shirts, shorts, pants, sweat shirts, sweat pants, hats, visors, shoes, sandals, and belts."[1]

---

[1] Ser. No. 74/598,109, filed November 14, 1994. The application is based on applicant's bona fide intention to use the mark in commerce.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, if applied to its identified goods, would so resemble the registered mark owned by Diesel, S.A. (a corporation of Italy) and shown below for "trousers, pants, jeans, shorts, skirts, overcoats, raincoats, jackets, windresistant jackets, cabans, blazers, sweaters, jerseys, vests, cardigans, shirts, t-shirts, blouses, dresses, suits, tracksuits, sweatshirts, pullovers, overalls"[2]; and for "footwear, namely, shoes, boots and slippers, belts,"[3] as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

---

[2] Reg. No. 1,605,656, issued July 10, 1990, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed dates of first use and first use in commerce are February 2, 1982 and July 31, 1982, respectively.

[3] Reg. No. 1,939,141, issued December 5, 1995. The registration is based on Sections 44(d) and (e) of the Trademark Act. The

The Examining Attorney essentially takes the position that the word portion of the cited registered mark is the dominant portion of said mark; that applicant has adopted a portion of the registrant's mark as applicant's entire mark; that the respective goods are identical in part and are otherwise all related clothing items; and that the goods are sold to the same general purchasers through the same channels of trade. The Examining Attorney submitted Webster's II New Riverside University Dictionary definition of the term "brave--n. 1. A North American Indian warrior".

Applicant essentially contends that the dominant portion of the cited mark is the "Mohawk Indian head", while the words DIESEL-ONLY-THE-BRAVE-DIESEL are in small print and must be read in a different manner because they appear in a circle around the design portion of the mark; that the purchasing public would remember the picture of the Mohawk Indian as the overall impression of the registrant's mark; and that the word DIESEL, which is the registrant's "company trademark", is also more likely to be remembered by purchasers.

Turning first to a consideration of the respective goods, both applicant's and the cited registrant's goods

---

registration issued in six classes. The Examining Attorney cited only the Class 25 goods referred to above.

are various clothing items. In fact, several of the clothing items listed in applicant's identification of goods are precisely the same as certain of the registrant's goods, e.g., t-shirts, shirts, shorts, pants, sweat shirts, shoes and belts[4]. Thus, the involved goods are virtually identical.[5]

The Examining Attorney has made of record copies of several third-party registrations, all but two of which issued on the basis of use in commerce, to demonstrate that "shirts, shorts, pants, hats, belts and footwear are found under the same mark." (Final Office action, p. 2.)

Third-party registrations are not evidence of commercial use of the marks shown therein, or that the public is familiar with them. Nevertheless, third-party registrations which individually cover a number of

---

[4] In footnote 1, page 6 of applicant's December 20, 1996 response to an Office action, applicant argued that if the Examining Attorney maintained that "the slight overlap in goods precludes registration", then applicant agreed to amend the identification of goods to read "wearing apparel, namely, T-shirts, shirts, shorts, pants, sweatshirts, sweat pants, hats and visors, sold solely through retail clothing stores". The Examining Attorney did not comment on applicant's proffered amendment; and applicant never referred to this proposed amendment again. As applicant did not press this matter, the proffered amendment to applicant's identification of goods will not be considered by the Board. Due to the similar goods of both applicant and registrant, even if entered, applicant's proposed amendment to its identification of goods would not change the result we reach in this case.

[5] Applicant acknowledged that "many of the goods sold by Registrant are the same as those sold by Applicant." (Applicant's brief, p. 12).

different items and which are based on use in commerce have some probative value to the extent they suggest that the listed goods emanate from a single source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785 (TTAB 1993); and In re Mucky Duck Mustard Co., Inc., 6 USPQ2d 1467 (TTAB 1988).

Regarding the respective trade channels and purchasers, clearly the respective goods (including several identical clothing items) could be offered and sold to the same class of purchasers through the same stores and other channels of trade for clothing.

Turning next to a consideration of the respective marks, generally the word portion of a mark, i.e., the portion utilized in calling for the goods, is most likely to be impressed in the purchaser’s memory and to serve as the indicium of origin. See Consumers Building Marts, Inc. v. Mr. Panel, Inc., 196 USPQ 510 (TTAB 1977). In this case, both applicant’s mark, and registrant’s mark include the identical wording, ONLY THE BRAVE. The only spoken portion of the marks are ONLY THE BRAVE and DIESEL ONLY THE BRAVE DIESEL. A purchaser familiar with registrant’s goods sold under the registered mark with three prominent components (namely, the corporate name-DIESEL, the words ONLY THE BRAVE, and the Indian-head design) would, upon

seeing applicant's mark on identical or closely related goods, assume that applicant's goods come from the same source as registrant's goods. This is so because applicant's mark consists solely of a prominent component of registrant's compound mark. That is, applicant's mark has nothing to distinguish it from registrant's mark. Moreover, the differences are not likely to be recalled by purchasers seeing the marks at separate times. The emphasis in determining likelihood of confusion is not on a side-by-side comparison of the marks, but rather must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of the many trademarks encountered; the purchaser's fallibility of memory over a period of time must also be kept in mind. See Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); Mucky Duck Mustard Co., supra; and Edison Brothers Stores v. Brutting E.B. Sport-International, 230 USPQ 530 (TTAB 1986).

Even if purchasers realize that applicant's mark is different from registrant's mark, they may believe that applicant's mark is a revised version of registrant's mark. Thus, the marks are similar.

Any doubt on the question of likelihood of confusion must be resolved against the newcomer as the newcomer has

the opportunity of avoiding confusion, and is obligated to do so. See In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423, at 1440 (TTAB 1993).

Based on the identity of the wording ONLY THE BRAVE, the identity and/or close relationship of the goods, and the identity of the trade channels, we find that there is a likelihood that the purchasing public would be confused if applicant were to use ONLY THE BRAVE as a mark for various clothing items. See In re E. I. duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Decision: The refusal to register under Section 2(d) is affirmed.

J. D. Sams

R. L. Simms

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board