

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE
TTAB

SEPT 30, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Big Entertainment, Inc.

Serial No. 75/009,259

Edward H. Rosenthal and Lawrence R. Miller of Frankfurt,
Garbus, Klein & Seltz for applicant.

Charles T. J. Weigell, Trademark Examining Attorney, Law
Office 109 (Deborah S. Cohn, Managing Attorney).

Before Simms, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Big Entertainment, Inc. has filed a trademark
application to register the mark ACORNA for "T-shirts,
sweatshirts, sweat pants, pants, shorts, tank tops, shirts,
vests, blouses, nightshirts, pajamas, boxer shorts, under
garments, infant wear, bathing suits, rain coats and rain
wear, bathrobes, aprons, jackets, scarves, sweaters, wrist
bands, head bands, bow ties, neck ties, belts, sneakers,

shoes, skirts, socks, hats, caps, masquerade costumes and masks sold in connection therewith."¹

The Trademark Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark shown below, previously registered for "footwear made at least in part of leather or sheepskin, namely boots, shoes and slippers,"² that, if used on or in connection with applicant's goods, it would be likely to



cause confusion or mistake or to deceive.

Applicant has appealed. Both the applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

In the analysis of likelihood of confusion in this case, two key considerations are the similarities between the marks and the similarities between the goods. *Federated*

¹ Serial No. 75/009,259, in International Class 25, filed October 23, 1995, based on a bona fide intention to use the mark in commerce.

² Registration No. 1,442,169, issued June 9, 1987, to Acorn Products Co., Inc., in International Class 25. [Sections 8 and 15 affidavits accepted and acknowledged, respectively.]

Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Considering, first, the goods, we note that registrant's identified boots, shoes and slippers are limited to products made at least in part of leather or sheepskin. Applicant's recitation of goods includes a wide variety of clothing including "shoes"; and, as the entry for "shoes" contains no limitations, it would encompass registrant's shoes. As such, applicant's recited "shoes" are legally identical to registrant's recited shoes. The fact that only one of the items identified in applicant's list of goods is identical to one of registrant's goods is sufficient to find that confusion would be likely if applicant was to use a mark that is confusingly similar to registrant's mark.

Turning to the marks, we note that, in determining likelihood of confusion, a lesser degree of similarity between two parties' marks is required when the marks are applied to identical goods or services. *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989). Further, as the Board stated in *In re J.M. Originals*, 6 USPQ2d 1393 (1987):

A finding of likelihood of confusion need not necessarily be premised on a finding that prospective purchasers would not be able to

distinguish the two marks when used on identical or closely related goods. Even if prospective purchasers could distinguish the two marks, a finding of likelihood of confusion may nevertheless be premised on a finding that these prospective consumers would erroneously believe, because of the similarities in the marks, that goods bearing the two marks emanate from the same, albeit perhaps anonymous, source.

Although the marks must be compared in their entireties, there is nothing improper in giving more weight to a particular portion of a mark if it would be remembered and relied upon to identify the goods and/or services. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Thus, if a mark comprises both words and a design, then the words are normally accorded greater weight because the words are likely to make an impression upon purchasers that would be remembered by them and would be used by purchasers to request the goods and/or services. *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); and *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985). See also: *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).

In this case, registrant's mark consists of the word ACORN appearing above a simple design of an acorn enclosed in a circle. The design of the acorn reinforces the dominant impression of the word ACORN. Applicant's

mark consists of the word ACORNA, which applicant describes as "a fanciful word that does not exist in the English language." While the word ACORNA as a whole may be "fanciful," it is our view that the mark will be perceived as the word ACORN with an "A" added at the end. Thus, we conclude that the overall commercial impression of the two marks is substantially similar. We note the general principle that the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The issue is whether the marks create the same overall commercial impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). Due to the consuming public's fallibility of memory, the emphasis is on the recollection of the average customer, who normally retains a general rather than a specific impression of trademarks or service marks. *Spoons Restaurants, Inc. v. Morrison, Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd*. No. 92-1086 (Fed. Cir. June 5, 1992); and *In re Steury Corporation*, 189 USPQ 353 (TTAB 1975).

In this case, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, ACORNA, and registrant's mark, ACORN and acorn design, their contemporaneous use on the legally

Serial No. 75/009,259

identical goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

Decision: The refusal under Section 2(d) of the Act is affirmed.

R. L. Simms

P. T. Hairston

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board