

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

In re San Antonio Shoe, Inc.

---

Serial No. 75/079,940

---

**Daniel D. Chapman** of Miller, Sisson, Chapman & Nash P.C.  
for San Antonio Shoe, Inc.

**Chrisie Brightmire King**, Trademark Examining Attorney, Law  
Office 109 (Deborah S. Cohn, Managing Attorney).

---

Before Hanak, Chapman and Wendel, Administrative Trademark  
Judges.

Opinion by Wendel, Administrative Trademark Judge:

San Antonio Shoe, Inc. filed an application to  
register the mark TUFF TEXAS for shoes.<sup>1</sup>

Registration has been finally refused under Section  
2(d) on the ground of likelihood of confusion with the  
registered mark TEXAS TUFF (stylized) for clothing, namely,  
jeans, and sportswear, namely, jogging suits, shorts, T-

---

<sup>1</sup> Serial No. 75/079,940, filed March 28, 1996, based on a bona  
fide intention to use the mark in commerce.

shirts, sweatshirts, and jackets.<sup>2</sup> Applicant and the Examining Attorney have filed briefs, but no oral hearing was requested.

Looking first to the goods involved, we concur with the Examining Attorney that these are closely related or complementary clothing items which may be purchased by the same purchaser on a single shopping expedition. See *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984), and the several cases cited therein, with respect to the close relationship between shoes and other specific items of clothing. While applicant argues that there is usually a difference between the manufacturers of footwear and clothing, and that such goods travel in different channels of trade, the Examining Attorney has introduced evidence to demonstrate that, more often than not, this is not the case. Several third-party registrations have been introduced showing use by a single entity of the same mark for both types of apparel. Thus, purchasers might well assume, if highly similar marks are used on both shoes and jeans or other sportswear, that the goods emanate from the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co.*,

---

<sup>2</sup> Reg. No. 1,467,435, issued December 1, 1987, combined Section 8 & 15 filed and accepted. A disclaimer has been made with respect

Inc., 6 USPQ2d 1467 (TTAB 1988). Catalogs have been made of record, showing the availability of both shoes and clothing items to purchasers from a single source, and, thus, that the goods travel through the same channel of trade.

The real issue here is the similarity or dissimilarity of the marks TEXAS TUFF and TUFF TEXAS. The marks are obviously mere reversals of each other. Both share the same words, the same spelling, the same alliteration. The question is whether, taking into consideration the goods upon which the marks are used, the transposition of these two words creates distinctively different commercial impressions for the respective marks. See *In re Nationwide Industries*, 6 USPQ2d 1882 (TTAB 1988); and *Bank of America National Trust and Savings Association v. American National Bank of St. Joseph*, 201 USPQ 842 (TTAB 1978) and the cases cited therein.

Applicant argues that our analysis should be made under the premise that the registered mark is a weak mark and entitled to only a narrow scope of protection. However, the third-party registrations for marks containing either the word "Texas" or "Tuff" (or a phonetic

---

to the word "Texas."

Ser No. 75/079,940

equivalent) which applicant attached to its brief as support for its position, and which were objected to by the Examining Attorney, were not properly made of record and have been given no consideration. See Trademark Rule 2.142(d). While applicant timely submitted the Internet evidence upon which it relies to show use of the term "tough" or its equivalent in connection the description of, or as part of marks for, various types of clothing, we find such evidence to be of little significance. Whether or not the word TUFF (or "tough") is frequently used is not the question, but rather whether or not the same combination of words TEXAS and TUFF has been used by anyone else in the clothing field. None of the evidence which applicant has submitted, or attempted to submit, touches this question. See *Bank of America National Trust and Savings Ass'n v. American National Bank of St. Joseph*, *supra* at 845 [although the words AMERICAN and BANK commonly appear in names of banks, the record fails to show use by anyone in the banking field, other than opposer (BANKAMERICA) and applicant (AMERIBANC), of a mark combining the two terms BANK and AMERI (or AMERICA) in a single word]. We are left with the conclusion that TEXAS TUFF is a combination unique to registrant, when used as a mark for wearing apparel.

Thus, the likelihood of confusion turns on whether applicant's reversal of the registered mark TEXAS TUFF to TUFF TEXAS results in a distinctly different commercial impression. Applicant contends that TEXAS TUFF suggests "just how 'tough' the goods are," or that the clothing is "'tough' like the State of Texas is 'tough'." On the other hand, applicant's transposed mark, TUFF TEXAS, is said to convey the impression of a geographic location in Texas, albeit a fictitious region or one of which the purchaser is unaware.<sup>3</sup> Applicant argues that this difference in commercial impression, coupled with the differences in the goods, obviates any likelihood of confusion.

We do not agree with the quality (TEXAS TUFF) vs. geographic location (TUFF TEXAS) distinction being advanced by applicant. Both registrant's jeans and sportswear and applicant's shoes are items which would aptly be referred to in terms of being "tough." The correlation of the word TUFF with a desirable quality of the goods would be the same for each mark. See *In re Nationwide Industries, Inc.*, *supra* at 1884 [both RUST BUSTER and BUST RUST are likely to be viewed as signifying that the product breaks up rust]. Moreover, we believe the commercial impression created by

---

<sup>3</sup> Although applicant submitted evidence that there was a small town named Tuff, Texas until about 1926, applicant did not argue

Ser No. 75/079,940

the term TEXAS as meaning "just how tough" or "as tough as Texas" would be the same, whether TEXAS proceeds or follows TUFF. We do not believe that a meaningful distinction can be drawn between the commercial impression created when purchasers view a TEXAS TUFF pair of jeans, as opposed to a TUFF TEXAS boot. The term TUFF has too much significance as a indication of ruggedness or durability to be interpreted as anything else.

Furthermore, we cannot ignore the fact that the average person is not infallible in his recollection of trademarks and may well transpose the two elements of these marks in his mind, particularly if not viewing the marks side-by-side. See In re Wm. E. Wright Co., 185 USPQ 445 (TTAB 1975)[FLEXI-LACE for garment findings, seam bindings, and hem tapes and LACE-FLEX for laces in the piece not only engender the same connotation but the resemblances in sound and appearance are significant because average purchaser is not infallible in recollection of marks and is prone to transpose them].

Contrary to applicant's arguments, the situation here is not similar to that in In re Mavest, Inc., 130 USPQ 40 (TTAB 1961). There the Board found the mark SQUIRETOWN

---

that purchasers would make this association.

when used for men's sports coats created a distinctly different impression from TOWN SQUIRES as used for men's shoes. The distinction in meaning was clear. Furthermore, the appearance of the two marks was markedly different. Such is not the case here.

Nor can we find a parallel in *Murphy, Brill & Sahner, Inc. v. New Jersey Rubber Co.*, 102 USPQ 420 (Comm. 1954), wherein the mark TOPFLITE was found to have a definite meaning when used for shoe soles, but FLITE TOP was considered to have little meaning as applied to hosiery. As stated earlier, we do not agree with applicant's reasoning that while TEXAS TUFF would denote ruggedness or durability, the reverse TUFF TEXAS would not. Moreover, the marks TOPFLITE and FLITE TOP are also quite different in appearance, whereas TEXAS TUFF and TUFF TEXAS are highly similar.

Finally, in *In re Akzona, Inc.*, 219 USPQ 94 (TTAB 1983), the Board found the marks SILKY TOUCH for synthetic yarns and TOUCH O' SILK for men's dress shirts to each have a distinct meaning, the first a feel of silk, the second a small amount of silk. And once again, the Board pointed to the differences in the sound and appearance of the marks, a factor clearly missing in the instant case.

**Ser No.** 75/079,940

Accordingly, we find that applicant's mark TUFF TEXAS for shoes would be likely to cause confusion on the part of the purchasing public, in view of registrant's mark TEXAS TUFF (stylized) for various clothing items.

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

B. A. Chapman

H. R. Wendel  
Trademark Administrative Judges,  
Trademark Trial and Appeal Board

**Ser No.** 75/079,940