

THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re PRL USA Holdings, Inc.

Serial No. 75/351,364

Nancy M. Dodderidge of Amster, Rothstein & Ebenstein for
applicant.

Katherine Stoides, Trademark Examining Attorney, Law Office
109 (Ronald Sussman, Managing Attorney).

Before Quinn, Rogers and McLeod, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by PRL USA Holdings,
Inc. to register the mark CARBONITE for "wearing apparel,
namely, pants, shorts, jackets, coats, woven shirts, t-
shirts, knit shirts, sweaters, sweatshirts, blouses,
skirts, dresses, hats, footwear, socks, hosiery and
gloves."¹

¹ Application Serial No. 75/351,364, filed September 3, 1997,
alleging a bona fide intention to use the mark in commerce.

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, if applied to applicant's goods, would so resemble the previously registered mark CARBONITE for "sporting goods, namely, golf clubs, golf club shafts/fishing rods and tennis rackets" as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

Applicant concedes that the marks are identical in sound and appearance, but argues that they convey different commercial impressions. Applicant refers to the dictionary listing of "carbonyl" which shows the term to mean "a metal compound." Applicant then goes on to conclude that the cited mark "is descriptive of the metallic nature and components of golf clubs, golf club shafts, fishing rods and tennis rackets and the mark calls to mind this aspect of the goods," while, "[i]n stark contrast, the mark CARBONITE as applied to [applicant's] goods, namely, clothing, is purely arbitrary, and carries no connotation of metal or metallic compounds." (brief, pp. 2-3)

Applicant also points to the coexistence of at least three third-party registrations of marks which comprise, in whole

or in part, the term "CARBONITE."² Thus, according to applicant, the cited mark is entitled to a narrow scope of protection. With respect to the goods, applicant contends that the Examining Attorney has improperly applied a *per se* rule in comparing them, and that, in any event, the goods are not related. In this connection, applicant asserts that its "goods are for general wear and have no special utility for golf, tennis or fishing." (brief, p. 5)

The Examining Attorney maintains that the marks are identical and that applicant's argument pertaining to the perceived differences in commercial impressions is not persuasive. The Examining Attorney also contends that it is common in the marketplace for sporting goods trademarks to be used on collateral goods such as clothing. In connection with this contention, the Examining Attorney submitted third-party registrations to show that the types of goods involved herein may be sold by the same party under the same mark. The Examining Attorney further states that these types of goods move through the same trade channels, namely pro-shops and sporting goods stores.

² Applicant merely referred to these registrations without providing copies of the registrations. See, e. g.: *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). In the present case, however, the Examining Attorney did not object, but rather considered the registrations as if properly made of record. Accordingly, this evidence is deemed to be of record.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. Federated Food, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

With respect to the involved marks, they are identical in sound and appearance. To the extent that there is any difference in meaning when the identical mark is applied to the respective goods, we find that the difference is subtle and would be, for the most part, lost on the consuming public.

The three third-party registrations are of little moment here. The registrations do not establish that the marks shown therein are in use, much less that consumers are so familiar with them that they are able to distinguish among such marks. See, e. g.: AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). Moreover, in the present case, none of the registrations covers goods of the specific types involved herein.

The essential identity between the marks makes it likely that, if the marks were used in connection with related goods, purchasers would be confused. In this connection, the Board has stated that "[i]f the marks are the same or almost so, it is only necessary that there be a viable relationship between the goods or services in order to support a holding of likelihood of confusion." In re Concordia International Forwarding Corp., 222 USPQ 355, 356 (TTAB 1983).

Turning now to a comparison between applicant's clothing and registrant's sporting goods, we find that they are sufficiently related that, if sold under the identical mark CARBONITE, confusion is likely to occur in the marketplace. The issue of likelihood of confusion between marks must be determined on the basis of the goods as they are identified in the respective application and registration. Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); and In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). Thus, although applicant asserts that its wearing apparel "has no special utility for golf, tennis or fishing," its identification of goods has no restrictions or limitations. Applicant's broadly worded identification of goods must be read to encompass all types of pants, shirts, sweaters and hats,

including those that would be worn while engaging in a sports activity such as golf or tennis.

We find that the Examining Attorney has not applied any *per se* rule in considering the relatedness of the goods, but rather considered the issue in light of the evidence of record. The Examining Attorney submitted several third-party registrations to support her contention that the same entities sell both types of goods involved in this appeal under the same mark. We find that these registrations have probative value to the extent that they suggest that the listed goods (sporting goods and clothing) are of a type which may emanate from a single source under the same mark. In re Albert Trostel & Co., 29 USPQ2d 1783, 1786 (TTAB 1993). We agree with the Examining Attorney's contention that the goods would move through the same channels of trade and be purchased by the same classes of purchasers.

In comparing the goods, we also take note of common knowledge that items of logo-imprinted clothing are widely used as promotional items for a diverse range of products and services. The licensing of trademarks for use on collateral products, especially in the sporting goods and clothing fields, is a commercial reality. See: Turner

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Entertainment Co. v. Nelson, 38 USPQ2d 1942, 1945-46 (TTAB 1996) and cases cited thereat.

Lastly, to the extent that any of the points argued by applicant cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.

T. J. Quinn

G. F. Rogers

L. K. McLeod
Administrative Trademark
Judges, Trademark Trial
and Appeal Board