

12/29/00

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 12
TEH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **NBA Properties, Inc.**

Serial No. 75/377,561

Kathryn Barrett Park for NBA Properties, Inc.

Nicholas K. D. Altree, Trademark Examining Attorney, Law Office
109 (Ronald R. Sussman, Managing Attorney).

Before Hohein, Holtzman and Rogers, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

NBA Properties, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register the mark shown below for "clothing, namely, hosiery, footwear, t-shirts, sweatshirts, sweatpants, pants, tank tops, jerseys, shorts, pajamas, sport shirts, rugby shirts, sweaters, belts, ties, nightshirts, hats, warm-up suits, parkas, coats, cloth bibs, head bands, wrist bands, aprons, boxer shorts, slacks, caps, ear muffs and gloves,

all sold only in promotion of and in connection with a professional basketball team."¹



Registration has been refused under Section 2(d) of the Trademark Act on the ground that applicant's mark so resembles the typed mark **KAPS** shown in Registration No. 966,558 for "men's and boys' clothing - namely, suits, jackets, slacks, shirts, ties, and socks"² as to be likely to cause confusion.³

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

In any likelihood of confusion analysis, we look to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476

¹ Application Serial No. 75/377,561, filed October 22, 1997 based on an allegation of a bona fide intention to use the mark in commerce.

² Issued August 21, 1973; renewed.

³ Applicant comments on the inconsistent treatment of its present application, pointing out that its prior (now abandoned) application for the same mark and nearly identical goods had been approved for publication by a different Examining Attorney. The prior application has no bearing on our decision herein. We have no way of knowing the basis for the Examining Attorney's approval of that application, nor are we bound by his or her action on that application. Each case must be decided on its own merits. *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984) and cases cited therein.

F.2d 1357, 177 USPQ 563 (CCPA 1973), giving particular attention to the factors most relevant to the case at hand, including the similarity of the marks and the relatedness of the goods or services.

We turn first to a consideration of the goods. Applicant attempts to distinguish the respective goods arguing that registrant's goods "appear to be formal clothing" targeted to the general consumer market while its own clothing (presumably informal) would be sold in promotion of a particular sport, through "specialized consumer market[s]" and such "discrete NBA venues" as the NBA's store, web site, catalogs, team stores or team arenas. Applicant maintains that the purchasers of its clothing will be fans of professional basketball or collectors of sports memorabilia, that these purchasers have a "sophisticated knowledge" about sports team names, sports marks and the different sources of the relevant goods, and that they would recognize that the clothing is collateral to applicant's primary services of sports entertainment.

We are not persuaded by applicant's arguments. The question of likelihood of confusion is based on the goods as identified in the application and registration rather than on any restrictions

or limitations reflected in actual (or intended) use.⁴ See *J & J Snack Foods Corp. v. McDonalds' Corp.*, 932 F.2d 1460, 1464, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991) and *Saks & Co. v. Snack Food Association*, 12 USPQ2d 1833 (TTAB 1989). The clothing items covered by the cited registration are, for the most part, identical to those in the application. The language in applicant's identification, "sold only in promotion of and in connection with a professional basketball team" does not effectively limit those goods. The articles of clothing are still the same, the goods are still sold in the same channels of trade, including all the usual retail outlets for clothing, and there is nothing which would limit the classes of purchasers to those "who have a sophisticated knowledge about Applicant's goods and marks." It must therefore be presumed that while fans and sports memorabilia collectors may be among the intended purchasers of applicant's goods, applicant's clothing, as identified, could be purchased by customers of all types, including ordinary consumers. Moreover, we believe it generally known and not subject to reasonable dispute that fans of professional sports, including the NBA, include consumers of all types. Finally, there is no restriction in the registration as

⁴ Thus, the fact that applicant's clothing may bear identifying matter such as "NBA Licensed Product" hang tags or that it may be displayed next to other goods bearing NBA trademarks is not relevant. See, e.g., *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992).

to use, channels of trade or classes of customers for registrant's clothing. We must therefore presume that registrant's clothing reaches all classes of customers including applicant's customers and that such clothing may also be sold in promotion of an underlying sports activity.

We turn then to the marks. In this regard, the Examining Attorney argues that the marks are phonetically identical, that the word in applicant's mark is more significant than the design element in determining likelihood of confusion, and that because registrant's mark is displayed in typed form "there is nothing to prevent the registrant from using a design of the U.S. Capitol building partially obscured by the stylized word KAPS." (p.8 brief).

The marks are identical in sound. However, we agree with applicant that when considered in their entirety, the marks differ in appearance and create distinctly different commercial impressions.⁵ Registrant's mark consists simply of the word

⁵ Contrary to applicant's claim, however, any asserted "integral" association of applicant's mark with professional basketball or the NBA has no bearing on this analysis. The commercial impression of a mark is not determined by extrinsic evidence as to its affiliation with a particular entity. The question is whether purchasers will believe that the products offered under the respective marks come from the same source, not whether purchasers can identify the source for the products. See, e.g., *Tone Brothers Inc. v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321 (Fed. Cir. 1994) and *Blue Cross and Blue Shield Association v. Harvard Community Health Plan Inc.*, 17 USPQ2d 1075 (TTAB 1990).

KAPS, which in relation to clothing appears to be a mere misspelling of the word "caps" for headwear. Applicant's mark, however, is a composite consisting a word and a design, both of which must be considered in determining the overall commercial impression the mark conveys. The word portion of applicant's mark is CAPS, but the design itself suggests the U.S. Capitol building, or perhaps capital cities in general. One definition of "caps" is, of course, headwear, and this is likely to be the meaning one would ordinarily attach to the word in applicant's mark in relation to applicant's identified goods. However, the dictionary definition of "caps" submitted by applicant shows that it is also an abbreviated form of the word "capitals."⁶ Thus, when CAPS is viewed in the context of the mark as a whole, the design reinforces its alternative meaning as the shortened word for "capitals" rather than, as in registrant's mark, the generic

⁶ The Examining Attorney (in a footnote to his brief on page 6), relying on a definition from *Cassell's German-English English-German Dictionary* (1978), argues as follows: "One might just as easily, and just as randomly, argue that the word KAPS is a play on the German word "kapital," which means "capital" in English." This proposition is unsupported. The registered mark is KAPS, not KAPITALS. There is no evidence that KAPS would be recognized by those who are knowledgeable in German as the equivalent of KAPITALS. There is no evidence to show that KAPS is likely to be perceived as anything other than a misspelled version of the word "caps."

word for headwear.⁷

The Examining Attorney's statement regarding the scope of protection accorded a typed mark is incorrect. A typed drawing allows protection for all *reasonable* manners of presentation. See *Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971) and *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585, 1588 (TTAB 1992). This is so because rights in the typed word reside in the word itself not in any particular display of the term. Thus, rights in the term would not be extended to include protection for that word combined with, for example, other words or a design element. See *Fossil Inc. v.*

⁷ Applicant also argues that the registered word KAPS, as meaning headwear, is weak in the clothing field. To support this claim, applicant submitted, with its response to the first Office action, a search report from a private company identifying close to 100 third-party applications and registrations for marks incorporating the word "cap" or "kap" for headwear and various items of clothing. The Examining Attorney did not object to this evidence or even acknowledge it. Applicant then (for reasons unknown) appended what appears to be the identical evidence to its appeal brief together with copies of sixteen of those registrations. The Examining Attorney, in his appeal brief, objected to these sixteen registrations as untimely. It seems clear that these registrations formed part of the original search report which was never objected to by the Examining Attorney. Thus, the objection to any of the evidence is deemed to have been waived, and we have considered the evidence as properly of record. Having said that, however, in view of our finding that the respective marks have different connotations and create different commercial impressions, the relevance of these third-party applications and registrations is minimal. Moreover, we note that the identifications of goods in the vast majority of those applications and registrations consist solely of caps, hats or some kind of headwear. While third-party registrations may be used to show the dictionary meaning of a term, we do not need third-party registrations to tell us the meaning of "caps" in relation to headwear.

Fossil Group, 49 USPQ2d 1451 (TTAB 1998) and In re Pollio Dairy Products Corp., Inc., 8 USPQ2d 2012 (TTAB 1988). Consequently, it would not be reasonable to assume that registrant's mark KAPS would be presented with the design element appearing in applicant's mark.

In view of the foregoing, notwithstanding the identity of the goods in this case, we conclude that the differences in **the respective marks makes confusion unlikely.**⁸

Decision: The refusal to register is reversed.

⁸ In a footnote to his appeal brief, the Examining Attorney for the first time raises the issue of the potential discriptiveness/genericness of the word CAPS in relation to some of applicant's identified goods, i.e., headwear. Without commenting on the propriety of that claim, if the Examining Attorney believed an additional issue needed to be addressed prior to appeal, he should have filed the appropriate request for remand of the application as set forth in Trademark Rule 2.142(f)(6).