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Paper No. 20  
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gary D. Garbrecht

Serial No. 74/715,526

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Moriarity & McNett for Gary D. Garbrecht.

Melvin T. Axilbund, Trademark Examining Attorney, Law  
Office 113 (Meryl Hershkowitz, Managing Attorney).

Before Cissel, Hanak and Holtzman, Administrative Trademark  
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On August 14, 1995, applicant, a citizen of the United States, applied to register the mark "FORMULA ONE" on the Principal Register for "sportswear that promotes the sport of professional power boat racing, namely, pants, t-shirts, golf shirts and jackets," in Class 25. The application was based on Mr. Garbrecht's claim that he first used the mark as early as May 5, 1995 and first used it in commerce at least as early as June 8, 1995. Applicant claimed

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ownership of Reg. No. 1,581,929, which is for the same mark, "FORMULA ONE," for "entertainment services, namely organizing and promoting power boat races."

The Examining Attorney suspended Action on the application pending the disposition of a prior-filed application for registration. When that application matured into a registration, the registered mark was cited as a bar to registration of applicant's mark under Section 2(d) of the Lanham Act. The Examining Attorney held that applicant's mark, as applied to the goods set forth in the application, so resembles the mark shown below,

which is now registered<sup>1</sup> for "articles of clothing, sportswear, and leisure wear, namely, tee-shirts, sweat shirts, jackets, pants, headwear, caps, pants, footwear, pajamas, sweatbands and wristbands," in Class 25, that confusion is likely.

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<sup>1</sup> Reg. No. 2,133,606 issued on the Principal Register under Section 44 of the Lanham Act to Giss Licensing B.V., a corporation of the Netherlands, on February 3, 1998.

Applicant responded to the refusal to register by amending the identification-of-goods clause in the application to add the following language; "sold only through professional power boat race promoters." Applicant argued that the mark shown in the application drawing is "significantly different" from the cited registered mark. Applicant further contended that in view of his amendment to limit the channels of trade through which his goods move, his products and those sold by the owner of the registration "are not likely to ever be seen by a common set of consumers, and even if that became true, the clear differences in the commercial impressions created by the mark of the cited registration with its highly dominant stylized F1 and the applicant's word mark FORMULA ONE are sufficient so that confusion is not ever likely to occur." (Applicant's December 28, 1998 response).

The Examining Attorney was not persuaded by applicant's arguments, and the refusal to register under Section 2(d) was made final. Attached to the final refusal of registration were excerpts from articles retrieved from the Nexis® database of printed publications. These excerpts establish that "Formula One" is used in reference to a class of power boat racing.

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Applicant timely filed a Notice of Appeal, followed by applicant's appeal brief. In view of the fact that the Patent and Trademark Office had by then reassigned the application to a different Examining Attorney, the Board granted the new Examining Attorney's request for remand in order to require applicant to submit copies of the original specimens because they had been lost from the application file. The Examining Attorney required such copies to be submitted and applicant submitted a copy of the original specimen. The specimen is a photograph showing a t-shirt and a hat bearing the mark with two different designs, as shown below.

The Examining Attorney issued an Office Action in which he maintained the final refusal to register based on likelihood of confusion with the cited registered mark. He pointed out that in view of the fact that the application shows a typed drawing of the term "FORMULA ONE," applicant is not restricted to any particular presentation of the

term, and that in the forms in which the mark is actually used on the specimen, applicant's mark is even more similar to the registered mark than would be apparent from reference to the typed drawing. Action on the appeal was resumed, and the Examining Attorney timely submitted his brief on appeal.

The sole issue before the Board in this appeal is whether confusion is likely between applicant's mark, as applied to the items of apparel set forth in the application, and the registered mark, in connection with the items of apparel listed in the registration. Based on careful consideration of the record before us and the arguments of applicant and the Examining Attorney, we find that the refusal to register is well taken.

In the case of *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the predecessor of our primary reviewing court listed the principal factors to be considered in determining whether confusion is likely. Chief among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression and the relationship between the goods specified in the application and registration, respectively. All relevant facts pertaining to similarities in appearance, pronunciation and connotation must be considered, but

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similarity in any one of these factors can be sufficient to support a finding that the marks are similar and that confusion is likely when the goods are also closely related. *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523 (CCPA 1968). As to the goods, if they are closely related, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is not as great as it would be if the goods were not as similar. *ECI Division of E Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980). We must interpret the identification-of-goods clauses in the respective application and registration without limitations or restrictions which are not reflected therein. *Toys "R" Us, Inc., v. Lamps R Us*, 219 USPQ 340 (TTAB 1983). We must consider the listed goods as encompassing all products of the type described, and that they move in all of the normal channels of trade for such products and are available to all potential customers for such goods. *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

When the situation in the case at hand is considered in light of these legal principles, it is clear that confusion is likely. To begin with, applicant's mark is similar to the registered mark. Even if we do not adopt the Examining Attorney's argument that applicant's mark is

the equivalent of the dominant portion of the cited registered mark, the term "Formula 1" in the registered mark is undoubtedly a significant part of that mark, and applicant's mark is essentially the same term. Although registrant uses the numeral "1" instead of the word "ONE" which appears in applicant's mark, the word portion of the registered mark is pronounced the same as the mark applicant seeks to register and the mark in its entirety has the same connotation as applicant's mark has.

Applicant argues that the design component of the registered mark is the reason the marks are dissimilar. Although the design element, which features the interlocking letter "F" and numeral "1" is not present in applicant's mark, "F1," at least as it appears above the term "Formula 1," is likely to be understood as simply an abbreviation for "Formula 1," and as such, is just an amplification of this term which, as noted above, is the equivalent of applicant's entire mark. That these marks can be distinguished is not disputed, but the commercial impression created by applicant's mark is very similar to that engendered by the registered mark when it is considered in its entirety. Moreover, as noted above, similarity in pronunciation, connotation, and hence commercial impression, is a sufficient basis upon which to

conclude that the marks are similar in circumstances such as these, where the goods are identical.

Although applicant argues that his amendment to specify a restricted channel of trade for his products makes confusion unlikely, as noted above, in the absence of restrictions or limitations in the cited registration, we must consider applicant's shirts and jackets promoting professional power boat racing, sold only through professional power boat race promoters, to be encompassed within registrant's broad identification of its goods as "articles of clothing, ... namely, tee-shirts...[and] jackets..." Applicant strenuously argues that the trade channels specified in the application, as amended, cannot be considered a "normal" channel of trade for clothing items of the type specified in the registration, but this is plainly not case. Consumers have come to expect that promoters of sporting events such as races will offer people in attendance a variety of collateral merchandise, including t-shirts and jackets.

In summary, confusion is likely in the case at hand because the marks of applicant and registrant create similar commercial impressions and the products specified in the application are encompassed within the identification-of-goods clause in the cited registration.

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Any doubt as to whether confusion is likely must be resolved in favor of the registrant and against the applicant, who had a legal duty to select a mark which is totally dissimilar to trademarks already in use in his field of commerce. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 643, 6 USPQ2d 1025 (Fed. Cir. 1988).

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

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